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CL
ERH
XL
v. 21

Gr. Brit. Court
REPORTS

OF

**PATENT, DESIGN, TRADE MARK, AND
OTHER CASES.**

EDITOR: JOHN CUTLER, ONE OF HIS MAJESTY'S COUNSEL.

ASSISTANT EDITOR: FRANK G. UNDERHAY, BARRISTER-AT-LAW.

VOL. XXI.

TOGETHER WITH A

DIGEST OF THE CASES REPORTED IN 1904.

ILLUSTRATED OFFICIAL JOURNAL (PATENTS).



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NOTICE.

The London cases in this volume were (with a few exceptions) reported by FRANK G. UNDERHAY, and by JAMES ROBERTS, J. F. ISELIN, J. D. CHORLTON, W. H. DRAPER, and H. J. DOUGLAS, Barristers-at-Law. The Reporter for cases in the Palatine Court is A. GRANT, Barrister-at-Law; the Reporter for Scotch cases is J. CRABB WATT, K.C.; and the Reporter for Irish cases is HENRY HOLT, Barrister-at-Law.

The Judgments are taken from the shorthand notes of Messrs. MARTEN, MEREDITH, HENDERSON, and WHITE.

ERRATA IN VOL. XXI.

Page 19, line 27, for "135,045" read "153,045."

" 45 " 53 " "1885" " "1895."

" 49 " 19, after "dissolution" add "a covenant"

" 84 " 52, strike out K.C.

" 201 " 4, for "SOLBY" read "SOLLY."

" " " 9 " "1889" " "1899."

" 202 " 4 " "SOLBY" " "SOLLY."

" 205 " 41 " "1889" " "1899."

" 316 " 36 " "897" " "397."

" 352 " 17 " "57" " "47."

" 376, lines 4 to 7. The names of counsel and solicitors should run as follows: *Warrington*, K.C., *Dankwerts*, K.C. and *Rowlands* (instructed by *Lermite and Jerome*) appeared for the Plaintiff; *Dickens*, K.C., *P. O. Lawrence*, K.C., and *Jessel* (instructed by *Russell and Arnholtz*) appeared for the Defendants.

" 383 " 44 to 46. The names of the solicitors for the Appellants should be *Faithfull and Owen*: the name of the solicitor for the Respondents should be *Frank Evelyn Jones*, agent for *W. T. Hill*, of Manchester.

" 391, line 19, for "action" read "petition."

" 419, " 49, " "with" " "within."

" 548, " 24, " "215 and 220" read "315 and 320."

" 563, " 7, " "215" " "315."

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List of Abbreviations of Names of the Principal Reports other than the Law Reports.

- Bea.—Beavan's Reports.
 De G. J. & S.—De Gex, Jones and Smith.
 D. F. & J.—De Gex, Fisher and Jones.
 D. G. M. & G.—De Gex, Macnaghten and Gordon.
 Dr. and Sm.—Drewry and Smale.
 E. & B.—Ellis and Blackburn.
 F.—Faculty Collection (Scotch).
 H. L. C.—House of Lords Cases.
 H. & M.—Hemming and Miller.
 K. & J.—Kay and Johnson.
 L. J.—Law Journal.
 L. T., N. S.—Law Times, New Series.
 Macrory P. C.—Macrory's Patent Cases.
 R.—Rettie (Scotch).
 S. J.—Solicitors' Journal.
 S. L. T.—Scotch Law Times.
 T. L. R.—Times Law Reports.
 T. R.—Term Reports.
 Ves.—Vesey.
 Webs.—Webster's Patent Cases.
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DIGEST
OF THE
PATENT, TRADE MARK, AND OTHER
CASES
REPORTED IN
VOL. XXI. OF THE REPORTS OF PATENT, &c. CASES,
COMPILED BY
FRANK G. UNDERHAY, M.A., BARRISTER-AT-LAW, ASSISTANT EDITOR.

DIGEST OF PATENT CASES.

AGREEMENT. *See* CONTRACT; LICENCE.

AMENDMENT OF SPECIFICATION.

1. Application in infringement action in Scotland for liberty to apply at the Patent Office for leave to amend refused and action dismissed, the Patent being admittedly bad, and it not appearing that the necessary amendment of the record would be competent.—*Action for infringement of Patent.—Specification admittedly bad.—Application by Pursuers for liberty to apply at the Patent Office for leave to amend the Specification by way of disclaimer and to sist procedure in the meantime.—Application refused.—Action dismissed.—Appeal dismissed.—Patents, &c. Act, 1883, section 19.—Costs of Public Authority.* The N. C. Co., who were the owners of Patent for improvements in charging inclined gas retorts, raised an action against the Edinburgh Gas Commissioners for infringement of the same. After the pleadings had been closed and a proof allowed, the N. C. Co. admitted that the Specification was bad, and that, if its defects were cured, the Summons would have to be correspondingly amended. Under the 19th section of the Patents, &c. Act, 1883, they moved for an Order authorising them to apply at the Patent Office for leave to amend their Specification by way of disclaimer, and to sist

AMENDMENT OF SPECIFICATION—*continued.*

procedure in the action until such application had been disposed of by the Patent Office. The motion was refused, and the action thrown out. The Pursuers reclaimed.—*Held*, that the Lord Ordinary had taken the proper course, and that his discretion ought not under the circumstances to be interfered with. Expenses as between agent and client refused. *NEW CONVEYOR CO., LD. v. EDINBURGH AND LEITH GAS COMMISSIONERS*, pp. 1 and 147.

2. **Terms on which leave granted to apply for.**—*Action for infringement.*—*Practice.*—*Motion by Plaintiffs for liberty to apply for leave to amend Specifications.*—*Terms.*—*Patents, &c. Act, 1888, sections 18, 19, 20.* The Plaintiffs in an action for infringement of two Patents after the delivery of the Defence applied to the Court for liberty to apply at the Patent Office for leave to amend their Specifications.—*Held*, that the Order made in *Ludington Cigarette Machine Company, Ltd. v. Baron Cigarette Machine Company, Ltd.* (17 R.P.C. 745) was appropriate, which imposed on the Plaintiffs (among others) a term that no action should be brought or maintained for infringement of the Patent in respect of any goods made prior to the date of the Order. An Order giving liberty to apply to the Patent Office for leave to amend was made accordingly. *JANDUS ARC LAMP AND ELECTRIC CO., LD. v. ARC LAMP CO.*, p. 115.
3. **Proposed amendment held to make the invention substantially different from that originally claimed.**—Application for leave to amend Specification. Opposition thereto on the ground that the amendment proposed would make the Specification, as amended, claim an invention substantially larger than or different from the invention originally claimed. Amendment allowed by Chief Examiner, acting on behalf of Comptroller.—*Held*, on appeal, by the Law Officer, that the amendment would make the Specification claim an invention substantially different from that originally claimed, there being no claim to the combination asked for on amendment, all reference to one part of the combination having been omitted by an amendment already made. The decision of the Chief Examiner was reversed and the application was refused. *IN THE MATTER OF HATTERSLEY AND JACKSON'S PATENT*, p. 233.
4. **An amendment of a Specification made on an application to the Patent Office without the leave of the Court at a time when an action was pending held invalid.**—*Action for infringement.*—*Amendment of Specification whilst a previous action was pending, without leave of the Court.*—*Amendment held to be invalid.*—*Leave granted to Plaintiffs to apply at the Patent Office for amendment and trial adjourned.*—*Patents, &c. Act, 1888, sections 18 & 19.*—*Patents, &c. Act, 1888, section 5.* In an action for infringement of a Patent, the Specification of which had been amended, the Defendants pleaded that the amendment was invalid, because at the time when it was applied for, a previous action for infringement was pending, and the leave of the Court to apply at the Patent Office for leave to amend had not been obtained. It appeared that owing to an agreement for settlement, which shortly after fell through, the first action had more than two years before the amendment been marked to stand out of the list generally with liberty to either party to apply to restore it. After the amendment had been made, the Defendants to the action obtained leave to restore it, and an Order was subsequently made giving leave

AMENDMENT OF SPECIFICATION—*continued.*

to the Plaintiffs to discontinue it without costs to either party, it being held that there had been a tacit agreement to abandon it.—*Held*, that the action in question was “pending” at the date of the application at the Patent Office for leave to amend, and that by reason of subsection (10) of section 18 of the Patents, &c. Act, 1883, the amendment was invalid. On the Plaintiffs applying under section (19) for liberty to apply at the Patent Office for leave to amend, such liberty was given to them, the action to stand over in the meantime, and the costs and the question of terms were reserved. *J. B. BROOKS & Co., LD. v. LYCETT’S SADDLE AND MOTOR ACCESSORIES Co., LD., and E. LYCETT*, p. 651.

5. The terms on which liberty should be given to apply at the Patent Office for leave to amend a Specification are in the discretion of the Judge giving such liberty. *IN THE MATTER OF GEIPEL’S PATENT*, p. 379. *See* *VARIANCE*.

ANTICIPATION. *See* *NOVELTY (WANT OF)*.

APPENDANT CLAIM. *See* *SUBJECT-MATTER*, No. 6, and *INFRINGEMENT*, No. 15.

CERTIFICATE AS TO PARTICULARS OF BREACHES. *See also* *PRACTICE*, No. 18.

1. Certificate granted (after the Judge had looked at the Particulars) as to breaches admitted by Defendant by not putting in Defence.—*Action for infringement.—Defence struck out.—Motion for judgment.—Certificate that the Particulars of Breaches were reasonable and proper given as to part of the same.—Patents, &c. Act, 1883, section 29.* *BROOKS v. HALL*, p. 29.
2. Certificate granted (after the Judge had looked at the Particulars) as to breaches admitted by the Defendant by default of entering appearance.—*Action for infringement.—Judgment on default of appearance.—Certificate given that certain of the Particulars of Breaches were reasonable and proper.—Patents, &c. Act, 1883, section 29.* *SACCHARIN CORPORATION, LD. v. SKIDMORE*, p. 31.

CERTIFICATE AS TO PARTICULARS OF OBJECTIONS.

1. *Action for infringement stayed by consent pending judgment of House of Lords in another action on the same Patent.—Judgment of House of Lords.—Discontinuance of action by Plaintiff after Defence.—Costs of Particulars of Objections.—Certificate that Particulars were reasonable and proper applied for and refused on the ground of absence of materials for a decision.* *ASHWORTH v. HORSFALL AND BICKHAM*, p. 47.
2. When an Appellant succeeded on non-infringement, the Court of Appeal refused to certify as to the Particulars of Objections. *PETER PILKINGTON, LD. v. B. AND S. MASSEY*, p. 712.

CERTIFICATE OF VALIDITY HAVING COME IN QUESTION.

1. **Certificate refused where Defendant consented to judgment on terms.**—*Action for infringement.*—*Validity.*—*Infringement.*—*Judgment by consent for injunction on terms.*—*Certificate of validity refused.*—*Patents, &c. Act, 1883, section 31.* The owner of a Patent for improvements in siphons for cisterns for water closets, having brought an action for infringement, the Defendant pleaded non-infringement and invalidity, but during the trial he consented to an injunction on certain terms, including the grant to him of a licence on a royalty, and judgment was given accordingly. *BYRNE, J.*, refused to grant a Certificate that the validity of the Patent came in question. *CLAUGHTEN v. FOSTER*, p. 17.
2. Certificate given by the Court of Appeal where Plaintiffs' appeal allowed. *GEORGE HATTERSLEY & SONS, LD. v. GEORGE HODGSON, LD.*, p. 532.
3. Certificate given to a Plaintiff who failed on the ground of non-infringement. *MORRISON v. ASPLEN*, p. 557.

COMBINATION.

1. **The Patentee of a combination need not point out wherein the novelty of it consists.**—"The Respondents' Patent is for a combination in a new manner of the well-known elements already mentioned. "In such a Patent there is no room for the common objection that the Patentee has not sufficiently distinguished the old from the new, for, as Lord Cairns pointed out in *Harrison v. Anderston Foundry Company* (1 App. Cas. 574, at page 578), the combination itself constitutes the novelty and merit of the invention. It is sufficient for the validity of the Patent if the combination, being the result of thought or experience, is new, and produces some new result or an old result in a more useful and beneficial way." Per Lord DAVEY in *PATENT EXPLOITATION, LD. v. SIEMENS BROTHERS & CO., LD.*, p. 547.
2. Selling one element of a patented combination held not to be an infringement. *DUNLOP TYRE CO., LD. v. DAVID MOSELEY & SONS, LD.*, pp. 53 and 274. See *INFRINGEMENT*, No. 4.

COMMITTAL. See CONTEMPT OF COURT.

CONSTRUCTION. See SPECIFICATION (CONSTRUCTION OF).

CONTEMPT OF COURT.

1. **Alleged contempt by the issue of circulars suggesting that the Plaintiffs knew of the invalidity of their Patent.**—*Action for infringement against several Defendants.*—*Motion to commit one Defendant for contempt by issuing circulars.*—*Motion for interlocutory injunction.*—*Motion to commit refused, having regard to all the circumstances of the case.* *BRITISH VACUUM CLEANER CO., LD. v. SUCTION CLEANERS, LD.*, p. 300.

CONTEMPT OF COURT—*continued.*

2. **Second motion to commit for same alleged breach of interlocutory injunction as first motion.**—*Motion dismissed with costs.—Leave to appeal refused by Judge and Court of Appeal.* BADISCHE ANILIN UND SODA FABRIK v. W. G. THOMPSON & Co., LD., AND OTHERS, p. 469.
3. An advertisement by a Patentee as to infringements of his Patent held not to be a contempt of Court. HASKELL GOLF BALL CO. v. HUTCHISON, p. 497.

CONTRACT. *See also* LICENCE.

1. **Articles held not to be covered by Agreement and to be in consequence infringements.**—*Construction.—Infringement by making goods outside the Agreement.—Judgment for Plaintiff.* R. being the owner of a Patent relating to revolving heel pads, and G. having filed a Provisional Specification relating to the same subject, R. and G. entered into an Agreement by way of compromise in an action as follows:—that R., admitting G.'s right to manufacture and sell his heel pads in accordance with his Provisional Specification, would undertake not to interfere with such rights, and would not, further, allege that G.'s heel pads were an infringement of any of R.'s Patents or repeat threats to G. or his customers; and that neither party should be at liberty to question the validity of the other's Patents for revolving heels or heel pads. R. subsequently brought an action against G., alleging that G. was selling heel pads not protected by the Agreement, and claiming a declaration to that effect and an injunction against infringement.—*Held*, that the Defendant was selling certain heel pads not in accordance with his Provisional Specification as construed by the parties in the Agreement. A declaration was made and an injunction was granted accordingly. ROBERTS v. GRAYDON, p. 194.
2. **Purchaser of Patent and business with warranty of validity of the Patent awarded damages on account of its invalidity.**—*Agreement for sale.—Warranty of validity.—Condition.—Patent held invalid.—Judgment for Defendant.* The owner of a Patent for automatic drain valves for use in steam engines entered into an agreement to sell it. The vendor in the Agreement guaranteed the Patent to be valid and in full force. The Patent was to be sold, together with the rights, privileges, and benefits appertaining thereto, further improvements, and the full and unrestricted use of the vendor's name in connection therewith for the sum of 500*l.*, one moiety of which was to be paid at once and the other some months afterwards. The vendor was not to part absolutely with his Patent until the whole of the price had been paid. The vendor also undertook to give all possible assistance to the purchaser in his business for a certain time. The purchaser paid 250*l.* and took over the business, letter books, and books of orders. He carried on the business for some months, but on discovering that other similar valves had been previously in the market repudiated the Agreement. In an action by the Patentee for 250*l.*, the balance of the 500*l.*, the Defendant alleged that there was a breach of warranty as to the validity of the Patent, which was invalid for want of novelty, utility, and subject-matter, and also that the Agreement applied only to the Patent rights. He counterclaimed for a declaration that the Agreement

CONTRACT—*continued*.

was not binding on him, and for a return of the 250*l.*, or, in the alternative, damages.—*Held*, at the trial, that the Patent was invalid and that the Plaintiff could not recover the 250*l.*; that the Defendant was not entitled to rescission of the contract, but, that as the business was only worth 240*l.*, he was entitled to 10*l.* damages with costs. *BERCHEM v. WREN*, p. 683.

COSTS. *See also* CERTIFICATE AS TO PARTICULARS OF OBJECTIONS.

1. **Action for infringement.** Costs of preliminary inspection of certain machinery by agreement of parties without Order allowed. Cost of erection of machinery at time of trial without Order disallowed.—*Rules of the Supreme Court, Order L., r. 6.* In an unsuccessful action for infringement of a Patent, where a mutual inspection by Counsel and experts of elaborate and heavy machinery was arranged between the solicitors without the expense of obtaining an Order for the purpose, under Rule 3 of Order 50 of the Rules of the Supreme Court, the costs of such inspection were allowed, but not the Defendants' costs of erecting machinery in London at the time of the trial, when it was not seen by either the Judge or the Plaintiff. *ASHWORTH v. ENGLISH CARD CLOTHING CO., LD. (A.)*, p. 353.
2. **Action for infringement.** Litigant held entitled to interest on the costs paid by him when unsuccessful in the Court of Appeal but repaid to him when successful in the House of Lords.—*Satisfaction of judgment debt.—Judgments Act, 1838 (1 & 2 Vict. c. 110), section 17.* Action for an infringement of a Patent was dismissed with costs, and the Plaintiff paid the Defendants' costs with interest to date. Upon the Plaintiff successfully appealing to the Court of Appeal, the Defendants repaid the amount so received with interest to date. The House of Lords restored the original Order, and the Plaintiff repaid the original amount of costs and interest, but refused to satisfy the Defendants' claim for interest at 4 per cent. on the amount from the date of the repayment after the Court of Appeal decision to the date of the return after the House of Lords decision.—*Held*, that the Defendants were entitled to this further sum in respect of interest. *ASHWORTH v. ENGLISH CARD CLOTHING CO., LD. (B.)*, p. 355.
3. Certificate depriving Plaintiffs of solicitor and client costs refused where a certificate of validity had been previously granted. *PETER PILKINGTON, LD. v. B. AND S. MASSEY*, p. 421. *Also* *BADISCHE ANILIN UND SODA FABRIK v. W. G. THOMPSON AND CO., LD.*, p. 473.
4. Where Appellant succeeded on non-infringement, the Court of Appeal refused to certify as to the Particulars of Objections. *PETER PILKINGTON, LD. v. B. AND S. MASSEY*, p. 712.
5. Expenses as between agent and client refused to a public authority defenders and successful in an action for infringement of Patent, it not being a matter arising out of the exercise of public duties. *NEW CONVEYOR CO., LD. v. EDINBURGH AND LEITH GAS COMMISSIONERS*, p. 147.
6. Where on appeal a portion of the costs below had to be returned to the Appellant, the Court of Appeal by consent fixed the exact amount to be returned. *IN THE MATTER OF GEIPEL'S PATENT*, p. 391.

DAMAGES.

Loss of market for machines fitted with the patented invention is an element to be taken into consideration in assessing damages for infringement of the Patent. *BROWN v. JOHN HASTIE & Co., LD.*, p. 445.

DISCOVERY. See *PRACTICE*, No. 7.

DRAWINGS. See *SPECIFICATION (CONSTRUCTION OF)*, No. 2.

EVIDENCE.

Observations on the evidence required in support of an application to discharge an Order for service out of the jurisdiction. *CHEMISCHE FABRIK VORMALS SANDOZ v. BADISCHE ANILIN UND SODA FABRIK*, p. 533.

INFRINGEMENT. See also *CONTRACT*, No. 1; *NOVELTY (WANT OF)*, Nos. 1, 2, and 4; *SUBJECT-MATTER*, Nos. 1, 2, 4, 5, and 6.

1. Infringement found.—Issue of infringement.—Judgment for Plaintiffs.

The owners of the *Welch* Patent for "Improvements in rubber tyres" and metal rims or felloes of wheels for cycles and other light "vehicles," having brought an action for infringement, the Defendant denied infringement. The fourth claim of the Plaintiffs' Specification was for "a rubber or elastic tyre having the form of a saddle or arch" in section lined with canvas in combination with two wires or sufficiently inelastic cores for securing the same to the rims or tyres, "substantially as herein described." The Defendant had an arrangement partly of string and partly of wire in the edges of his tyre, which he contended was not the equivalent of and did not perform the functions of the Plaintiffs' wires or inelastic cores, and did not in use lie in the same position in the rim.—*Held*, that the Defendant had infringed. Judgment was given for the Plaintiffs. *DUNLOP PNEUMATIC TYRE CO., LD. v. HYDE RUBBER CO.*, p. 208.

2. Patent held to be a simple combination Patent. Alleged novel feature in invention not referred to in the Specification.—

Action for infringement.—Construction of Specification.—Infringement not found.—Judgment for Defendants.—Appeal by Plaintiffs dismissed. The owners of Letters Patent for "Improvements in the process of and apparatus for reproducing phonographic records" brought an action for infringement, in which the Defendants contended that they did not infringe, and, alternatively, that, if the claims included what they did, then the Patent was invalid. The first claim of the Specification was for "the process of reproducing copies of phonographic records by forcing a blank of suitable material, softening when heated, against the record surface of an indented matrix by heated fluid, as steam or the like, under pressure, until the blank is softened and an impression has been taken, and then continuing the pressure by means of a cooling fluid, as air, until the blank hardens and the impression is fixed, as herein described with reference to the drawings." The Plaintiffs alleged that one of the chief features of the apparatus shown in the drawings was that it allowed of the exit of air from between the matrix and the celluloid blank. The Defendants' apparatus differed from that of the Plaintiffs

INFRINGEMENT—*continued*.

in several respects, including the escape of the air and the closing of the chamber from inside instead of externally; they used in their process steam under pressure, and subsequently air under pressure, but they cooled by insertion of the apparatus into cold water. It was held at the trial (20 R.P.C. 705), that the claims in the Plaintiffs' Specification were limited by the particular combination therein described, and that the Defendants had not infringed. The action was dismissed with costs. The Plaintiffs appealed. The appeal was dismissed with costs. *LAMBERT CO. v. INTERNATIONAL PHONOGRAPH INDESTRUCTIBLE RECORD CO., LD.*, p. 247.

3. **Form of Order on Motion for Judgment in default of Defence where several Patents are alleged to be infringed.**—*Action for infringement.*—*Infringement of several Patents alleged.*—*Motion for Judgment in default of Defence.*—*Judgment for Plaintiffs.* *SACCHARIN CORPORATION, LD. v. HOPKINSON*, p. 272.

4. **Selling one element of a patented combination held not to be an infringement.** The selling of an article intended to be used for the purpose of being used for infringing a Patent is not an infringement of such Patent.—*Action for alleged infringement.*—*Right to manufacture and sell one element (not separately claimed) of a combination.*—*Alleged intent by several persons to sell separately the elements for the purpose of infringement.*—*Action dismissed.*—*Appeal dismissed.* A Company, the owners of two Patents—(1) (*Bartlett*), for "Improvements in tyres or rims for cycles and other vehicles," and (2) (*Welch*), for "Improvements in rubber tyres and metal rims or 'felloes of wheels for cycles and other light vehicles,'" brought two actions against the Defendants for infringement. The Patents were for combinations. The Complete Specification of *Bartlett* claimed:—
 "(1) The combination of a grooved rim or metal tyre, and an arched "tyre of india-rubber or other flexible material held in the groove by the pressure of an inflated tube within the arch, which forces its "edges against the sides of the groove, substantially as described.
 "(2) Tyres or rims for cycles and other vehicles consisting of the "parts *a, b, c*, combined and arranged substantially as described and "shown in the drawings." The Complete Specification of *Welch* claimed by the fourth and ninth claims respectively:—
 "(4) A rubber "or elastic tyre having the form of a saddle or arch in section "lined with canvas, in combination with two wires or sufficiently "inelastic cores for securing the same to the rims or tyres, substantially "as herein described. (9) A rubber or elastic tyre having the form of "a saddle or arch in section, provided with endless wires or cores "fitted or vulcanised within each side for the purpose of securing the "same to the rims in combination with an inflatable inner tyre or "tube, substantially as described and shewn with reference to Figs. 15 "and 18 of the drawings." The Company alleged that the Defendants had infringed by selling tyres or parts thereof, and pleaded at the Bar and sought to prove that the Defendants had manufactured and sold the outer tyre or cover (one of the elements of the combinations) with the intent that it should be used by the purchaser (not being a licensee of the Company) for the purpose of making one or other of the combinations. The Defendants denied infringement, and claimed that they were lawfully entitled to sell the cover; that they had done so *bona fide* and in the ordinary course of trade, and they contended that intent was immaterial. At the trial it was held by *Swinfen Eady, J.*, that

INFRINGEMENT—*continued.*

(the Patents having previously been held to be for combinations) the cover was not new, and was not separately claimed; that the Defendants respectively were lawfully entitled to make and sell or sell the cover; that consequently intent was immaterial; and that the Defendants had not infringed. The Plaintiffs appealed. The Court of Appeal affirmed the decision of *Swinfen Eady, J.*, and dismissed the Appeal with costs. *DUNLOP PNEUMATIC TYRE CO., LD., and PNEUMATIC TYRE CO., LD. v. DAVID MOSELEY & SONS, LD., and INDIA-RUBBER AND TYRE REPAIRING CO.*, pp. 53 and 274.

5. "If you are in substance selling the whole of the patented machine, I do not think that you save yourself from infringement because you sell it in parts which are so manufactured as to be adapted to be put together. . . . Here, what is complained of is merely the sale of some one or other of the parts of one or other of the patented 'tyres.' Per *VAUGHAN WILLIAMS, L.J.*, in *DUNLOP PNEUMATIC TYRE CO., LD. v. DAVID MOSELEY & SONS, LD.*, p. 280. See No. 4.
6. A person lawfully selling one element of a patented combination held not bound to ascertain whether the purchasers of it intended to use it lawfully.—"I agree with the Judgment of Mr. Justice *Swinfen Eady*, and in particular I desire to adopt this portion of it as my own: 'Selling these covers to licensees of the Plaintiffs is a lawful trade; selling them for export is a lawful trade, but the purchasers, nevertheless, might not export them; and to make the Defendants, Messrs. *Moseley*,'—those are the manufacturers—responsible for the ultimate use of the covers, so as to put upon them the burden of ascertaining whether the purchasers intended to use, and to use them lawfully, would be imposing upon them a burden, which, in my opinion, the law does not impose.'" Per *STIRLING, L.J.*, in *DUNLOP PNEUMATIC TYRE CO., LD. v. DAVID MOSELEY & SONS, LD.*, p. 281. See No. 4.
7. Construction of Specification. The omission from a Complete Specification of an alternative mentioned in the Provisional Specification is a notification that the inventor abandons it.—*No new result.*—*Mechanical equivalent.*—*Injunction granted in respect of one Patent sued on.*—*Appeal.*—*Patent held not to be infringed.*—*Appeal allowed.* *S., LD.*, who were the proprietors of a Patent granted to *J. R.*, for "Improvements in dumb-bells for physical culture exercises," brought an action for infringement of the same and of another Patent not relied on at the trial. The invention consisted in a dumb-bell formed in two parts divided longitudinally with springs between them. In the Provisional Specification the Patentee expressly mentioned compressed air springs. The Complete Specification omitted any mention of them, but the second claim mentioned resilient means of expansion generally. The Defendant's dumb-bell had inflated india-rubber balls between the halves of the dumb-bell at each end. The Defendant attacked the validity of the Patent on various grounds, and denied infringement. It was held at the trial that the Specification claimed a combination; that it was not a claim for the invention of mere details, but that it embodied a new principle or idea; that the Patent was valid, and that the Defendant had infringed, and judgment was given for the Plaintiffs on this Patent, a certificate of validity being granted. The Defendant appealed.—*Held* by the Court of Appeal (*Stirling, L.J.*,

INFRINGEMENT—*continued.*

doubting), that on the evidence as to the state of knowledge no new result was attained by the Patentee, and that the inference to be drawn from the omission of mention of air springs in the Complete Specification was that the Patentee did not intend to claim them, and on the construction of the Specification that they were not claimed and that under the circumstances an air spring could not be claimed as a mechanical equivalent for the springs described in the Complete Specification. The appeal was allowed, with costs. *SANDOW v. SZALAY*, pp. 33 and 333.

8. **Patent for particular combination not infringed.**—*Construction of Specification.*—*General principle.*—*Special combination to obtain special objects.*—*Infringement not found.*—*Judgment for Defendants at trial.*—*Appeal dismissed.* The owners of a Patent for improvements in miners' safety lamps, having brought an action for infringements, the Defendants denied infringement, and alleged the invalidity of the Patent, but at the trial relied principally on the contention that the Patent was for a particular combination, which they had not taken. The first claim of the Specification was as follows:—"In a miner's "safety lamp, the employment of a spring catch for locking the "bonnet, the said spring catch being brought into an acting position "on the closing of the lamp, substantially as set forth." The Plaintiffs alleged that the feature of the invention was an arrangement by which, when the bonnet was screwed on, it locked automatically, and could not be removed until the main lock of the lamp was undone, and that the Defendants had in substance taken the combination. At the trial it was held that the Patent did not involve any new principle, but was for the particular combination, and that the Defendants had not taken the patented spring catch or the substance of the invention. The action was dismissed with costs. The Plaintiffs appealed.—*Held*, that the Patent did not involve any new principle, but was for a particular combination, and that the Defendants had not infringed that combination. The appeal was dismissed with costs. Per COZENS-HARDY, L.J.—If a Patentee intends to claim a general principle, it is his duty to make that intention reasonably clear by his Specification. *ACKROYD AND BEST, LD. v. THOMAS AND WILLIAMS*, pp. 403 and 737.
9. The equitable owners of a Patent are not entitled to sue for infringement without joining as a party to the action the person who was the legal owner of the Patent at the date of the writ. *E. M. BOWDEN'S PATENTS SYNDICATE v. HERBERT SMITH & Co.*, p. 438. (*See PRACTICE*, No. 5.)
10. **Patent for a new and useful application of an old device held to be a pioneer Patent and to be infringed.**—*Construction of Specification.*—*Infringement.*—*Damages.*—*Loss of market.*—*Particulars of Patents referred to as prior knowledge.* Steam is admitted to steering engines by a controlling valve which is shut when the engine is at rest. Means had long been sought to prevent leakage through the controlling valve when shut. In 1897 a Patent was granted to B. the object of which he described as follows:—"To prevent or considerably diminish "the leakage of steam hereinbefore referred to. For this purpose I fit "in a passage or casing through which the steam enters the controlling "valve casing a double-beat valve which has formed or fixed on it "oppositely inclined surfaces which are acted upon by counterpart

INFRINGEMENT—*continued*.

"inclines fitted in connection with the controlling valve so that on the movement of the controlling valve it acts through the inclined surfaces to open the double-beat valve and admit steam." The Patentee added:—"Instead of the equilibrium valve *a* (the double-beat valve) any equivalent device may be used. For example, the inclines may be on the stem of a small valve which opening first admits the steam under a larger valve opened by the further motion of the small valve." He claimed:—"In connection with the valves of steering and like engines fitting in a passage or casing through which the steam enters the controlling valve casing a double-beat or equivalent valve having opposite inclines acted on by counterpart inclines moving with the controlling valve, the parts being arranged and operating substantially as and for the purposes hereinbefore described." The double-beat valve used as a cut-off valve was a well-known mechanical device. It had been employed in continuous engines to work automatically with the distributing valve so as to cut off the steam from the distributing valve casing during a part of each stroke. It had never been applied to the controlling valves of steering engines, nor had the leakiness of these valves been successfully remedied in any other way.—*Held*, that in construing the Specification it must be considered what, having regard to the state of prior knowledge, was the field open to the inventor; that in the circumstances the Patent was a pioneer Patent; that it was not to be construed as claiming only the double-beat valve actuated by inclined planes sliding on counterpart inclines, but as claiming in the application to steering and the like engines, for the purpose of preventing leakage of steam while the engine is not working, of a separate stop valve working in unison with the controlling valve. H. & Co. patented a cut-off valve in which, instead of the direct mechanical action of the controlling valve, they used a steam relay. They claimed their invention had advantages over that of B., but did not patent it as being an improvement on his invention. They claimed:—"A controlling valve for steering engines to which the steam supply is through a cut-off valve which is operated by exhaust of the steam which normally closes it, and wherein the said exhaust is controlled as described by a slide or equivalent valve operated from or by the spindle or lever which actuates the controlling valve."—*Held*, that this was an infringement of B.'s pioneer Patent. The Pursuers averred that through the Defendants supplying cut-off valves in infringement of their Patent they had lost orders, not only for those valves, but for the steering engines of which they formed part.—*Held*, that this was an element to be taken into consideration in fixing damages. When in a Scotch patent action it is desired to refer to prior Patents for the sake of proving the state of prior knowledge these Patents must be specified on record, but amendment of record by the specification of additional Patents will be allowed even during proof in terms of the Court of Session Act (Scotland) 1868, section 29. *BROWN v. JOHN HASTIE & CO., LD.*, p. 445.

11. Defendants held to have taken the pith and marrow of the invention.—*Infringement found.—Injunction granted at the trial.—Injunction dissolved by the Court of Appeal.—Appeal to the House of Lords allowed.—Judgment at the trial restored.* The owners of a Patent for "An improved boiler flue" sued the Defendant Company and its directors for infringement. The Patentee claimed: "A boiler flue or furnace consisting, as to the general form, of a series of annular or partially annular flutings connecting a corresponding series of sharp

INFRINGEMENT—*continued*.

“ridges.” The Defendants’ flue had corrugations, which the Plaintiffs contended were ridges, and also a subsidiary corrugation between these. It was contended by the Defendants that their corrugations were not similar to the sharp ridges claimed by the Patentee, and that this and the subsidiary corrugations so differentiated the Defendants’ flue as to take it outside the claims in the Plaintiffs’ Specification. At the trial it was held that the Defendants had infringed, and an injunction was granted. The injunction was suspended until the 1st of May 1901, to enable the Defendants to apply to the Court of Appeal. On such application the injunction was by consent stayed pending the appeal. On the appeal being heard, the Court of Appeal held that the Defendants had not infringed, and the appeal was allowed. The Plaintiffs appealed to the House of Lords.—*Held*, reversing the decision of the Court of Appeal, that the Defendants had infringed, and that the judgment of the Judge at the trial be restored with costs. LEEDS FORGE CO., LD. v. DEIGHTON’S PATENT FLUE AND TUBE CO., LD., p. 487.

12. **Infringement of Patent for the particular article described not avoided by immaterial differences.**—*Anticipation.*—*Differences between patented article and infringing article.*—*Sufficiency of Specification.*—*Judgment for Plaintiffs.* The owners of a Patent for a cigar piercer brought an action for infringement. The infringing cigar piercer differed in some details from the patented article. The Defendants relied mainly on anticipation, insufficiency of description in the Specification, and non-infringement.—*Held*, that the Patent was for a particular cigar piercer described in the Specification and delineated in the Drawings; that the Patent had not been anticipated and that the Specification was sufficient; and that, although the Patent was confined to the machine described, the Defendants had infringed, as they had taken the patented machine with immaterial differences. Judgment was given for the Plaintiffs for the relief claimed. L. AND C. HARDMUTH v. EDWARD BAKER & SON, p. 504.*
13. **Patent for a combination of known contrivances held to be valid, but not to be infringed by a combination not taking the essential feature of the patented combination.** In the case of a Defendant added by amendment the cause of action must have arisen at the date of the writ.—*Construction of Specification.*—*Infringement not found.*—*Judgment for Defendant.*—*Certificate of validity coming in question given to the Plaintiff.* M., the Patentee of a new and improved machine for breaking up the surfaces of roads, commenced an action for infringement, in which one Defendant denied infringement and the validity of the Patent, but at the trial relied principally on infringement, and only alleged that the Patent was invalid if it were so widely construed as to include what he did. The third claim of the Specification, which was chiefly relied on by the Plaintiff, was as follows:—“In a road breaking machine in combination with a pivoted tool holder, carrying tools at either side, a frame in “which said tool holder is pivoted arranged to slide vertically in “guides, substantially as described and illustrated herein.” The machine complained of had no pivot, the frame of the tool holder resting loosely on a washer above a nut; the frame was capable of

* The decision in this case has since been reversed on appeal.

INFRINGEMENT—*continued.*

being raised or lowered by means of a screw, and was also capable of being raised or canted by reason of its loose fitting, but that movement was controlled partly by springs and was limited by the outer side of the machine; subject to these the tool holder was during working free to swing, whereas in the Plaintiff's machine there was a locking lever to fix the angle of the tools to the ground; there were also differences in the arrangement for vertical adjustment. The second Defendant had been added as a Defendant by amendment, and at the trial no evidence was given of infringement by him before the date of the writ.—*Held*, that the Patentee claimed a combination, and that Claim 3 was a claim for the frame in combination with the pivoted tool holder, and that the machine complained of had no pivot or the mechanical equivalent of a pivot; and that the arrangement for vertical sliding was different from that described in the Specification; and that the machine complained of was not an infringement of the Patent, and that no evidence had been given against the second Defendant of any infringement or intention to infringe at the date of the writ. Judgment was given for the Defendants with costs, with a Certificate that certain of the Particulars of Objections were reasonable and proper; but a Certificate was given to the Plaintiff that the validity of the Patent came into question. *MORRISON v. ASPLEN*, p. 557.

14. **Defendant's article not within the claims of the Specification as expressly limited.**—*Action for infringement.*—*Construction of Specification.*—*Issue of infringement.*—*Judgment for the Plaintiff at the trial.*—*Appeal by Defendant allowed.*—The Specification of Letters Patent claimed "a clinical thermometer having two or more "chambers formed within the bore of the tube and a comparatively "open contraction within each chamber substantially as herein shown "and described, and for the purpose stated." The owner of the Patent brought an action for infringement of the same, in which the Defendant relied on non-infringement. In the Defendant's thermometer there were two contractions, but, at all events in its final state, only one chamber. The object of the two contractions was to overcome the difficulty which existed with one contraction only, in obtaining the return of the mercury after the temperature has been read; the chambers were necessary in manufacture for the purpose of obtaining the contractions. Each of the Plaintiff's chambers was formed in a manner previously well known, but the Defendant's chamber and contractions were made in a new way by one operation. It was held at the trial that the two contractions formed the pith and marrow of the invention; and that, notwithstanding the reference in the claim to two chambers, the Defendant had infringed. Judgment was given for the Plaintiff with costs. The Defendant appealed.—*Held*, that the claim was limited to a thermometer having two or more chambers with a comparatively open contraction within each chamber, and that the Defendant employed a new method and had not infringed. The appeal was allowed with costs. *HICKS v. SIMMONS*, pp. 413 and 632.
15. **Construction of Specification. The invention claimed not taken by the Defendants.**—*Issue of infringement.*—*Judgment for Plaintiffs.*—*Appeal by Defendants allowed.* The Specification of Letters Patent for "Improvements in atmospheric or power hammers" ended with five claims, the first of which was as follows:—"In an atmospheric hammer, arranging the closed ends of the hammer and air "pump cylinders in proximity to each other, and directly connecting

INFRINGEMENT—*continued*.

"them through short passages of small capacity controlled by one or more valves, the arrangement being such that air can be drawn direct from the hammer-head into the air pump cylinder, at each suction stroke of the pump, to cause the hammer-head to rise, and air can be forced direct from the said pump into the hammer cylinder at each compression stroke of the pump, to cause the hammer-head to descend, so that the hammer-head will work in unison with and will promptly respond to the movements of the pump piston substantially as herein described." Claims 2, 3, and 4 commenced with the words "an atmospheric hammer of the kind specified in 'Claim 1'"; Claim 5 was for the particular hammer described and shown. The hammer described in the Specification had the capacity of regulating the force of the blow, and of the hammer-head being held up or down whilst the air pump continued to work. The owners of the Patent, having commenced an action for infringement, the Defendants relied mainly on non-infringement, although they also contended that the hammer described and shown would not work practically. The Defendants' hammer had both ends of the cylinders closed, and a by-pass between the ends of the air cylinder, and the upper passage was free, and they contended that the Claims in the Specification only extended to hammers in which the pressure of the atmosphere was employed in raising them; also that Claim 1 did not include the holding up and down actions, and the parts relating thereto, or, if it did, it was for the specific hammer described, and that they had not got the patented devices; and that Claims 2, 3, and 4 were appendant claims, so that unless the alleged infringement was covered by Claim 1, there was no infringement. It was *held* at the trial, that the objection to validity failed; that the claims were not limited to hammers in which atmospheric pressure was used; that Claim 1 included the parts for holding up and holding down, and was for a specific hammer; that Claims 2, 3, and 4 were appendant claims; that the Defendants' by-pass was a convenient way of making the invention workable where both ends of the cylinders were closed; and that the Defendants had infringed. Judgment was given for the Plaintiffs, with costs. The Defendants appealed.—*Held*, by the Court of Appeal, that atmospheric hammers with both ends of the cylinders closed, as well as those with one end only of each cylinder closed, were known at the date of the Patent; that the Patentee was dealing only with those that had not both ends closed; that the problem in hammers with closed ends was different from that in hammers with open ends, and that the Patentee had limited his claims to the latter class in which there is a single action, and that the Defendants' hammer had not a mere duplication of that action; and that they had not infringed. The appeal was allowed with costs, but not including the costs of the Particulars of Objections to the validity of the Patent. *PETER PILKINGTON, LD. v. B. AND S. MASSEY*, pp. 421 and 696.

16. Judgment by consent for an injunction, the Plaintiffs agreeing to grant a licence upon terms agreed between the parties. *MOFFATS, LD. v. J. AND W. B. SMITH*, p. 751.

INQUIRY AS TO DAMAGES. *See PRACTICE*, No. 14.

INSPECTION. *See COSTS*, No. 1.

INSUFFICIENCY. *See SPECIFICATION (INSUFFICIENCY OF)*.

INTEREST ON COSTS. *See* COSTS, No. 2.

INTERLOCUTORY INJUNCTION.

1. Defence of accidental infringement not established.—*Action for Infringement of Patent and for Passing-off.—Motion for Interlocutory Injunction.—Injunction granted.* POULTON AND SON *v.* KELLEY AND SON, p. 393.
2. Where a certificate of validity has been granted an interlocutory injunction will be granted if there is a *prima facie* case of infringement.—*Action for Infringement.—Motion for Interlocutory Injunction.—Effect of Certificate as to validity granted in previous action.—Interlocutory Injunction granted.* HEINE, SOLLY & CO. *v.* JULIUS NORDEN & CO., p. 513.

INTERROGATORIES. *See* PRACTICE, No. 1.

INVENTION. *See* SUBJECT-MATTER.

LICENCE.

1. The assignor of a licence under a Patent is not entitled against his assignee to dispute the validity of the Patent.—*Licence belonging to partnership.—Dissolution of partnership.—Arbitration award.—Whether partner assigning his share in licence should covenant not to manufacture under the Patent.—Whether question within Arbitrator's jurisdiction.—Construction of terms of submission.—Motion to set aside award dismissed.* The owner of a licence under a Patent executed a declaration of trust of it in favour of a firm of which he was a member. A partnership action was commenced by G., one of the partners, and an Order was made for a stay of proceedings on certain terms, including an assignment by G. to his partners of his share in the partnership at a price to be fixed by arbitration, and a term that the form of deed of dissolution and assignment and any other question arising in respect thereof should be referred to the Arbitrator. On a motion by G. to set aside the Arbitrator's award.—*Held*, that on the construction of the submission to arbitration the Arbitrator had not exceeded his jurisdiction in inserting in the deed of dissolution a covenant prohibiting G. from manufacturing according to the Letters Patent. The assignor of a licence under a Patent is not entitled as against his assignee to dispute the validity of the Patent. *Chambers v. Crichley* (33 Beav. 374) followed. *GONVILLE v. HAY*, p. 49.
2. Construction of Licence. Full words of grant held not to be limited by subsequent clauses.—*Action for infringement.—Licence.—Construction.—“Use and exercise.”—Licence whether full or limited.—Whether acts complained of were covered by the licence.—Goods made abroad by third persons on behalf of Defendants.—Counterclaim for breach by Plaintiffs of agreement contained in licence limiting the number of licences.—Plaintiffs settling with infringers whether a breach of agreement.—Action dismissed.—Counterclaim dismissed.—Appeal by Plaintiffs in the action dismissed.* A licence having been granted under *Bartlett's* Patent relating to pneumatic tyres, the owners of the patents commenced an action for infringement

LICENCE—*continued.*

against the licensees, alleging that certain acts of the licensees were not covered by the licence. Full licence to use and exercise the invention was granted, but certain clauses of the licence, including those relating to royalties and accounts, referred only to tyres manufactured and sold by the licensees; there was also a clause prohibiting assignment or sub-licence, and a clause that the licensees should not manufacture or sell tyres constructed according to *Welch's* invention, but, subject as aforesaid, should be entitled to manufacture all forms of pneumatic tyres theretofore manufactured by them under the name or title of "*Clincher*." The Plaintiffs contended that the Defendants had infringed the Patent by the importation and sale of *Clincher-Michelin* tyres, such importations and sale not being, as the Plaintiffs alleged, within the licence, and they also alleged that the arrangement between the Defendants and *Michelin & Co.*, of Paris, was such that the Defendants were in effect sub-licensing *Michelin & Co.* They further alleged that by the clause as to *Welch's* Patent the Defendants were prohibited from making any tyre under *Bartlett's* Patent that would also infringe *Welch's* Patent. The Defendants contended, on the first point, that the licence was a general one and that they were entitled to purchase tyres from any person, and also that *Michelin & Co.* were manufacturing the tyres as their agents; and, on the second point, that an absolute licence without limitation was given to use *Bartlett's* invention. These points were decided as points of construction on admissions, and the Plaintiffs subsequently determined to call no evidence to show that the *Welch* Patent was used in the tyres complained of. The licence also contained a clause prohibiting the Plaintiffs, in events which happened, from granting more than one licence besides the licence above mentioned and one other already granted. The Plaintiffs granted a further licence, which was assigned to the C. Company, and afterwards did certain acts which, the Defendants contended, were breaches by the Plaintiffs of their agreement, and the Defendants counterclaimed in respect of the same. Such acts consisted, as the Defendants alleged, of licensing tyres in Paris for importation into this country, and of licensing in England tyres brought into this country by infringers by allowing the continued use of such tyres on payment of a royalty. The Plaintiffs contended that they were not in any way bound under the contract, which contained a special clause as to infringements, to sue for infringement, and that in the instances complained of they had only done what they were reasonably entitled to do in cases of infringement.—*Held*, by *Byrne, J.*, in the action—first, that, under the licence, the tyres sold by the Defendants must be manufactured by them, but might nevertheless be manufactured for them by a third party, and that the agreement between the Defendants and *Michelin & Co.* was for *Michelin & Co.* to make as agents for the Defendants, and, further, that the arrangement did not amount to a sub-licence; and, secondly, that the Defendants might manufacture according to *Bartlett's* Patent, and all things that they had done previous to the licence were to be deemed to be within *Bartlett's* Patent, but they might not manufacture according to *Welch's* Patent.—*Held*, on the Counterclaim—first, that the Defendants had failed to connect the Plaintiffs with the acts in Paris complained of; and, secondly, that, as to the acts complained of in England, they only amounted to a fair and reasonable way of dealing with infringers. The action and counterclaim were both dismissed with costs, including in the costs of the action given to the Defendants the costs of and occasioned by an application made by the Plaintiffs to enable them to raise the point as to *Welch's* Patent, which application

LICENCE—*continued.*

was allowed, and any costs thrown away in consequence of it, with a set-off. The Plaintiffs appealed (except as to the point with respect to *Welch's Patent*), and the Defendants served a notice that, in the event of the Court of Appeal reversing the judgment in the action, they would ask that the judgment on the Counterclaim might be reversed; as the Plaintiffs' appeal failed, however, the Defendants' appeal was not opened.—*Held*, by the Court of Appeal, that the licence was a full one, not limited, as the Plaintiffs contended, to "manufacture and sale." The judgment of *Byrne, J.*, in the action was affirmed, *Stirling, L.J.*, expressing the opinion also that *Michelin & Co.* were agents of the Defendants as held by *Byrne, J.* The appeal of the Plaintiffs was dismissed with costs, but the Plaintiffs were given any increased costs occasioned by the Defendants' appeal.—Per VAUGHAN WILLIAMS, *L.J.*—The words "use and exercise" in the grant of a licence confer, in the absence of anything limiting the construction of them, a full licence on the licensee. *DUNLOP PNEUMATIC TYRE CO., LD. v. NORTH BRITISH RUBBER CO., LD.*, p. 161.

3. Where, after an agreement for a licence has been entered into, the Patentee sells the Patents subject to the agreement for a licence, the concurrence in the licence of the assignee is not necessary.—*Agreement for sole licence.*—*Sale by licensee of his Patent rights.*—*Assignment of Patent subject to right of licensee.*—*Concurrence of assignee not necessary in carrying out the sale.* On the 17th of July 1902 D. and M. agreed to purchase from F. for 2500*l.* Patent rights in a certain system. On the 21st of July 1902 F. obtained an option for a sole licence under the four Patents. On the 7th of November 1902, by an Agreement to which the Patentee was a party, D. and M. agreed to pay the unpaid balance of the 2500*l.* on F. tendering the licence above referred to. On the 24th of October 1902 the said Patents had been transferred to J. H. H. subject to the rights of F. under the Agreement of the 21st of July 1902. D. and M. refused to pay the unpaid balance unless the licence tendered was executed by J. H. H. In an action by F. to recover the balance, *Held*, that it was not necessary that the licence should be executed by J. H. H., and that the Plaintiff was entitled to succeed. *FRENTZELL v. DOUGILL and MEYER*, p. 641.

MECHANICAL EQUIVALENT. *See also* INFRINGEMENT.

If a Patentee, having referred to one alternative in his Provisional Specification, excludes it from his Complete Specification, the Court will, in an action for infringement, infer that the Patentee did not intend to claim that alternative by any general words or to regard it as a known mechanical equivalent. *SANDOW v. SZALAY*, p. 333. *See* INFRINGEMENT, No. 7.

MERGER.

Where on the dissolution of a Company the Crown had become legal owner of the Patent, query whether the Patent had merged. *IN RE TAYLOR'S AGREEMENT TRUSTS*, p. 713.

METHOD. *See* SUBJECT-MATTER, No. 5.

MONOPOLIES (STATUTE OF).

Patents held not to be invalidated under the Statute of Monopolies on the ground of there being no manufacture by the owners of the Patents nor intention to manufacture in the United Kingdom. **Alleged exorbitant prices.**—*Patents held not to be invalidated.*—*Certificate of validity.* In an action for infringement of two Patents relating to dyes the Defendants alleged that the Patents were, or had become, invalid because, first, the Plaintiffs, the owners of the Patents, had no intention to manufacture in this country; secondly, that they had not manufactured in this country, and had used the Patents to prevent other persons from doing so; and, thirdly, that they had charged exorbitant prices for the patented articles, much in excess of those charged in other countries. The Plaintiffs alleged that these grounds of invalidity were bad in law, but that the Excise duty on alcohol would prevent profitable manufacture in this country, and that their prices in this country were not exorbitant having regard to the circumstances, including the more complete protection against infringement as compared with other countries, in some of which chemical products cannot be protected by Patents.—*Held*, that the Plaintiffs had never manufactured or intended to manufacture in this country, and that the dyes were sold at a price considerably higher than in countries where they were not protected by Patents, and higher than in certain countries where the protection was less complete; but that even if exorbitant charges for the patented articles would make the Patents invalid, the prices were not proved to be so exorbitant and unreasonable as to invalidate them; that as the dyes had been used in this country, the invention had been introduced into this country for the public good, and that manufacture in this country is not a condition of the grant of a Patent. Judgment was given for the Plaintiffs with costs against such of the Defendants as had infringed. A Certificate having been granted in a previous action as to one Patent, that the validity of the Patent came into question, although the Patent was then held to be, before amendment of the Specification, invalid as to one claim on the ground of insufficiency, the Court refused to go behind the Certificate or entertain any question as to the jurisdiction to give such a Certificate. **BADISCHE ANILIN UND SODA FABRIK v. W. G. THOMPSON & Co., LD.**, p. 473.

NOVELTY (WANT OF.) *See also SUBJECT-MATTER; CONTRACT, No. 2; and INFRINGEMENT, Nos. 6, 10, 12, and 13.*

1. **Prior user established and no subject-matter in view of common knowledge.**—*Action for infringement.*—*Alleged prior publication and prior user.*—*Subject-matter.*—*Infringement.*—*Patent held invalid.*—*Judgment for Defendant.* The owner of Letters Patent for "Means or apparatus for effecting the simulation of flames of fire for spectacular purposes" having commenced an action for infringement, the Defendant denied infringement, and alleged that the Patent was invalid on the grounds of prior publication, prior user, and want of subject-matter. The first claim of the Specification was: "In stage appliances, an open-work base, streamers attached to the said base, and means for directing currents of air to the base and for illuminating streamers through the base."—*Held*, that the alleged invention was not disclosed as a whole in the prior Specifications alleged as anticipations, but that prior user was established, and that at all events there was, in view of the common knowledge of the art, no subject-matter; and that the Defendant, not using streamers, had not infringed. The action was dismissed with costs. **FULLER v. HANDY**, p. 6.

NOVELTY (WANT OF)—*continued*.

2. **Patent held invalid on the grounds of anticipation by prior user.**—In an action for infringement of a Patent for improvements in antivibration devices for use with incandescent gas fittings, the Defendant alleged the invalidity of the Patent on various grounds, including prior user.—*Held*, that the prior user alleged by the Defendant was proved. Judgment was given for the Defendant with costs. *CROSSLEY v. COATES*, p. 282.

3. **Combination producing a known result in a more useful and beneficial way. The Patentee of a combination is not bound to point out what is novel in the combination, or to distinguish between what is novel and what is old. Patent upheld. Want of novelty or of subject-matter not established.**—*Action for infringement.—Construction of Specification.—Want of novelty.—Subject-matter.—Action dismissed.—Appeal allowed.—Appeal to the House of Lords dismissed.—Patent held to be valid.* The owners of a Patent for an improvement in galvanic batteries having commenced an action for infringement, the Defendants denied infringement and alleged that the Patent was invalid by reason of being anticipated, of want of subject-matter, and of inutility. The Specification, after stating that the invention related to galvanic batteries constructed and arranged as was thereafter described, contained the following passage :—“The materials mentioned as electrodes and as exciting and “depolarising agents and their proportions may be varied, as the “important feature of the invention is the interposition between the “positive and negative electrodes of two layers of exciting com- “position, in a semi-solid or plastic state, the one in contact with “the negative electrode having intermixed with it depolarising agents “and the one in contact with the positive electrode having no such “depolarising agents in its composition”; and the Patentee claimed : “A galvanic battery having the space between its positive and negative “electrodes filled with a semi-solid or plastic exciting agent in two “layers, the one layer in contact with the negative electrode having “depolarising agents intermixed therewith, and the other layer in “contact with the positive electrode having no such depolarising “agents, substantially as set forth.” The Plaintiffs contended that the width of the claim was limited by certain limitations which they alleged were contained in the Specification, and particularly that the depolarising layer was to be composed of materials finely pulverised. It was proved that the Plaintiffs’ battery made under the Patent had been a commercial success. At the trial, it was held by *Buckley, J.* (19 R.P.C. 113), that, although the claim should be construed as embodying some limitations indicated in the body of the Specification, the Patentee had not insisted on as necessary or claimed as part of his invention the pulverisation of the ingredients for the depolarising layer; that the claim was too wide; and that the Patent was invalid for want of novelty. The action was dismissed with costs. The Plaintiffs appealed.—*Held*, by the Court of Appeal, (20 R.P.C. 225) that the claim was not for the particular battery described, but for a class of battery, defined by the limitations contained in the Specification; (by *Vaughan Williams and Stirling, L.JJ.*) that pulverisation was an essential; (by *Cozens-Hardy, L.J.*) that, although pulverisation was not essential, the combination of materials must produce a semi-solid or plastic mass; that there was novelty and good subject-matter; and that the Patent was valid and had been infringed. The Appeal was

NOVELTY (WANT OF)—*continued.*

allowed with costs, but by consent the injunction granted was stayed pending an appeal to the House of Lords. The Defendants appealed to the House of Lords.—*Held*, that pulverisation was not a necessary element in the combination claimed; that the words “semi-solid” and “plastic” in the Specification were synonymous; that the Patentee had described and claimed as his invention a galvanic battery in language which was not anticipated by and which did not in terms cover any previous description or any battery previously known or described; that the invention was useful and good subject-matter for Letters Patent; and that the Defendants had infringed. The Appeal was dismissed with costs. *PATENT EXPLOITATION, LD. v. SIEMENS BROTHERS & Co., LD.*, p. 541.

4. **Patent upheld.**—*Certificate as to validity granted.*—*Stay of inquiry as to damages refused.* Letters Patent were granted to E. for “Improvements in wire mattresses or fabrics for bedsteads, cots, and “like articles of furniture,” the invention consisting in the use of spiral springs set at an angle to the sides of the bed in such a manner that the tension of the central part of the mattress was greater than that of the sides. In an action for infringement,—*Held*, that the invention had not been anticipated. Certificate of validity granted. Application to stay inquiry as to damages pending an appeal refused, following *Hyam v. Terry* (29 W.R. 32). *EVANS AND J. AND J. TAUNTON, LD. v. HOSKINS AND SEWELL, LD.*, p. 675.

5. **Patent held to be anticipated.** *APPLEBY v. SOUTH DURHAM STEEL AND IRON CO., LD.*, p. 750.

PARTICULARS OF BREACHES. *See* CERTIFICATE AS TO PARTICULARS OF BREACHES.

PARTICULARS OF OBJECTIONS. *See* CERTIFICATE AS TO PARTICULARS OF OBJECTIONS.

PATENTS, &c. ACT, 1883.

Section 18—

JANDUS ARC LAMP AND ELECTRIC CO., LD. *v.* ARC LAMP CO.,
p. 115.

IN THE MATTER OF HATTERSLEY AND JACKSON'S PATENT,
p. 233.

J. B. BROOKS & CO., LD. *v.* LYCETT'S SADDLE, &c. CO., LD.,
p. 651.

PATENTS, &c. ACT, 1883—*continued*.

Section 19.

JANDUS ARC LAMP AND ELECTRIC CO., LD. *v.* ARC LAMP CO.,
p. 115.

NEW CONVEYOR CO., LD. *v.* EDINBURGH AND LEITH GAS
COMMISSIONERS, p. 147.

IN THE MATTER OF GEIPEL'S PATENT, p. 379.

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p. 651.

Section 29—

BROOKS *v.* HALL, p. 29.

SACCHARIN CORPORATION, LD. *v.* SKIDMORE, p. 31.

ASHWORTH *v.* HORSFALL AND BICKHAM, p. 47.

Section 31—

CLAUGHTON *v.* FOSTER, p. 17.

Section 32—

HASKELL GOLF BALL CO. *v.* HUTCHINSON, p. 497.

LYCETT'S SADDLE, &c. CO., LD. *v.* J. B. BROOKS & CO., LD.,
p. 656.

Section 87—

IN RE TAYLOR'S AGREEMENT TRUSTS, p. 713.

Section 90—

IN RE TAYLOR'S AGREEMENT TRUSTS, p. 713.

PATENTS, &c. ACT, 1888.

Section 5—

J. B. BROOKS & CO., LD. *v.* LYCETT'S SADDLE, &c. CO., LD.,
p. 651.

“PENDING.”

Meaning of, in section 18 (10) of the Patents, &c. Act, 1883. *See* J. B. BROOKS CO., LD. *v.* LYCETT'S SADDLE AND MOTOR ACCESSORIES CO., LD., p. 651.

PETITION. *See* REVOCATION (PETITION FOR).

PRACTICE. *See also (as to costs of affidavits) DIGEST OF DESIGN CASES.*

1. **Form of interrogatories as to prior user and prior publication.**—*Action for infringement.—Alleged invalidity on the grounds of prior user and prior publication.—Application by Plaintiffs for leave to interrogate.—Form of interrogatories.* In an action for infringement of a Patent, the Defendants in their Particulars of Objections alleged prior user at a certain place by V. B. for some years prior to a certain date, and prior publication by J. B. at a certain place to M. of that place between certain dates. The Plaintiffs applied for leave to administer Interrogatories, which were shortly as follows:—As to prior user—what was the manner of the prior user; whether by means of a machine in actual use, and what was the purpose of the use of the machine, and the periods for which it was used; whether it existed, and where it could be inspected, and what was the occupation and address of V. B. As to the prior publication—whether it was oral, by document, model, or how otherwise; whether such document or model existed, and where it could be inspected; whether any more exact date could be given, and what was the occupation and address of M. At the hearing of the summons it was proposed to ask whether the machine was in the Defendants' possession or power instead of where it could be inspected.—*Held*, that, the Defendants stating that the prior user alleged was by machine, they ought to be ordered to answer the first Interrogatory by stating whether any such machine existed, and, if so, whether any such machine was in their possession, custody, or power, and stating the present address of V. B.; and, the Defendants stating that the publication referred to was by document, they ought to be ordered to answer the second Interrogatory by so stating, and by sufficiently identifying the document and the present address of M.; but the Defendants were not compelled to make further answer to either of the Interrogatories. *Birch v. Mather* (L.R. 22 C.D. 629) followed. *GENERAL ELECTRIC CO. (1900), LD. v. SAFETY LIFT AND ELEVATOR CO.*, p. 109.
2. **Undertaking or injunction by consent.**—*Action for infringement.—Perpetual injunction consented to.—Undertaking substituted.* *DOVER (H. W.) AND DOVER, LD. v. NEW TOWNEND CYCLE CO., LD.*, p. 135.
3. **Motion to advance trial refused on ground of Plaintiffs' delay in moving.**—*Action for infringement.—Delay in making application to advance trial for which leave was given to Plaintiffs on interlocutory motion for injunction.—Motion by Plaintiffs to advance the trial.—Motion refused.—Costs to be the Respondents in any event.* *HEINE, SOLLY & CO. v. CONINCO INCANDESCENT LIGHT CO.*, p. 201.
4. **Plaintiffs not owners of Patent at the date of infringement complained of in Particulars of Breaches.** *HEINE, SOLLY & CO. v. CONINCO INCANDESCENT LIGHT CO.*, p. 202.
5. **The equitable owners of a Patent are not entitled to sue alone for infringement without making the person who was at the date of the writ the legal owner a party to the action.**—*Plaintiffs held not to be the legal owners of the Patent at the commencement of the Action.—Leave to amend applied for and Order made giving leave.—Patents, &c. Act, 1888, section 13.—Appeal by Plaintiffs from decision as*

PRACTICE—continued.

to parties dismissed.—Application to Judge to vary Order dismissed. B., having made an application for Letters Patent, and obtained provisional protection for his invention, before the grant of the Patent assigned the protection and the sole and exclusive benefit of it to a Company. After the Patent had been granted to B., the Company commenced an action for infringement, alleging the sale of infringing articles by the Defendants prior to the date of the writ. The Company subsequently obtained an assignment of the Patent, and were registered as assignees. On the action coming on for trial, the Defendants objected that the legal owners of the Patent at the date of the writ, namely B.'s executors, ought to be joined. The Company alleged that they were such owners, and, in the alternative, that it was not necessary to make such owners parties.—*Held*, that the assignment before the grant of the Patent did not pass the legal interest in the Patent, and the legal owners at the date of the writ were necessary parties. Leave to amend was given on terms. The Plaintiffs appealed from the Order giving leave to amend, and alleged that it had been intended that the Plaintiffs should be in a position to appeal on the question as to parties and that there was a mistake in the form of the Order. The appeal was dismissed subject to any application at the trial to the Judge to put right any slip that had been made. A special application subsequently made to the Judge was dismissed. *E. M. BOWDEN'S PATENTS SYNDICATE, LD. v. HERBERT SMITH & Co.*, pp. 438 and 596.

6. **Service of Notice of Writ out of jurisdiction not set aside.—***Action for infringement.—R.S.C. Order XI., Rule 1 (f).* The owners of a Patent obtained leave to serve Notice of the Writ in an action for infringement of a Patent on the Defendants out of the jurisdiction. After service the Defendants moved to set the proceedings aside. In answer to the affidavit filed on behalf of the Plaintiffs, the Defendants filed affidavits stating that the substance sold by them was a different product made by a secret process, which was altogether different from the Plaintiffs' specified process.—*Held*, that the Plaintiffs, having made out a *prima facie* case of infringement within the jurisdiction, the Order for service out of the jurisdiction was rightly made.—*Held*, also, that there being a conflict of evidence on the facts, the matter could not be disposed of on motion. Order XI., Rule 1 (f.) does not enable the Court to direct service out of the jurisdiction of a Writ claiming damages for infringement of a Patent which has expired at the date of the Writ, although an injunction is also sought in respect of another Patent. *BADISCHE ANILIN UND SODA FABRIK v. CHEMISCHE FABRIK VORMALS SANDOZ IN BASEL*, p. 345.
7. **In an action for infringement in Scotland after proof allowed in general terms covering averments of damage as well as of infringement, discovery of Defendants' books allowed.—***Infringement—Conclusion for damages or profits.—Allowance of proof.—Diligence for recovery of documents.—Business books.—Amendment.—Expenses reserved.—Abandonment.—Expenses.*—B., a Patentee, raised an action of interdict against E. for infringement, concluding also for damages or alternatively for profits. On the 19th of March the Lord Ordinary before Answer allowed the parties a proof of their respective averments and to the Pursuer a conjunct probation. On the 7th of June, B. asked for a diligence to recover documents in terms of a specification calling *inter alia* for E.'s business books.—*Held*, that the interlocutor allowing proof could not be altered: that the inquiry into profits or

PRACTICE. *See also (as to costs of affidavits) DIGEST OF DESIGN CASES.*

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PRACTICE—continued.

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6. **Service of Notice of Writ out of jurisdiction not set aside.**—

Action for infringement.—*R.S.C. Order XI., Rule 1 (f.).* The owners of a Patent obtained leave to serve Notice of the Writ in an action for infringement of a Patent on the Defendants out of the jurisdiction. After service the Defendants moved to set the proceedings aside. In answer to the affidavit filed on behalf of the Plaintiffs, the Defendants filed affidavits stating that the substance sold by them was a different product made by a secret process, which was altogether different from the Plaintiffs' specified process.—*Held*, that the Plaintiffs, having made out a *prima facie* case of infringement within the jurisdiction, the Order for service out of the jurisdiction was rightly made.—*Held*, also, that there being a conflict of evidence on the facts, the matter could not be disposed of on motion. Order XI., Rule 1 (f.) does not enable the Court to direct service out of the jurisdiction of a Writ claiming damages for infringement of a Patent which has expired at the date of the Writ, although an injunction is also sought in respect of another Patent. *BADISCHE ANILIN UND SODA FABRIK v. CHEMISCHE FABRIK VORMALS SANDOZ IN BASEL*, p. 345.

7. **In an action for infringement in Scotland after proof allowed in general terms covering averments of damage as well as of infringement, discovery of Defendants' books allowed.**—*Infringement*—*Conclusion for damages or profits.*—*Allowance of proof.*—*Diligence for recovery of documents.*—*Business books.*—*Amendment.*—*Expenses reserved.*—*Abandonment.*—*Expenses.*—B., a Patentee, raised an action of interdict against E. for infringement, concluding also for damages or alternatively for profits. On the 19th of March the Lord Ordinary before Answer allowed the parties a proof of their respective averments and to the Pursuer a conjunct probation. On the 7th of June, B. asked for a diligence to recover documents in terms of a specification calling *inter alia* for E.'s business books.—*Held*, that the interlocutor allowing proof could not be altered: that the inquiry into profits or

PRACTICE—*continued.*

damages was not to be postponed until infringement had been proved. Diligence granted. On the 5th of July the Defenders were allowed to amend their record, the question of expenses being reserved. On the 9th of July the Pursuer abandoned the cause in terms of the Statute 6 Geo. IV., c. 120, section 10, under which the Pursuer has it in his power to abandon the case on paying full expenses or costs to the Defender.—*Held*, that the terms of the Statute did not preclude the Court from dealing with the expenses reserved by the interlocutor of the 5th of July, modifying them and awarding them to the Pursuer. *BROWN v. EVERED & Co.*, p. 501.

8. There being a substantial legal question to be tried and a *prima facie* case of infringement being shown, the House of Lords refused to set aside an Order for service out of the jurisdiction.—*Action for infringement.—Practice.—Service of notice of writ out of the jurisdiction.—Motion to set aside refused.—Appeal dismissed by Court of Appeal.—Appeal to the House of Lords dismissed.—Order XI., Rule 4.* The owners of Letters Patent obtained leave to serve notice of the writ in an action for infringement of the Patent on the Defendants out of the jurisdiction. After service, the Defendants moved to set the proceedings aside. In answer to the affidavits filed on behalf of the Plaintiffs, the Defendants filed affidavits stating the course of their business, and they contended that all they did within the jurisdiction was to enter into contracts for delivery of the goods abroad, and that was not infringement, and there was no cause of action. The Plaintiffs, on the other hand, alleged that the Defendants' travellers brought samples of infringing dye into this country and used them in obtaining orders, that the Defendants had extensively infringed, and that six cases of infringement had come to their knowledge.—*Held*, by the Court of Appeal (affirming *Joyce, J.*), 20 R.P.C. 478, that, the Plaintiffs having raised a *prima facie* case of infringement not completely displaced by the Defendants, and there being on the affidavits a conflict of fact, the Court would not try the question raised at this stage, and the appeal from *Joyce, J.*, who had refused the Defendants' application, was dismissed, and a stay of proceedings pending an appeal to the House of Lords was refused. The Plaintiffs appealed to the House of Lords.—*Held*, that the Orders appealed from should be affirmed, and the appeal was dismissed with costs. Observations on the evidence required in support of an application to discharge an order for service out of the jurisdiction. *CHEMISCHE FABRIC VORMALS SANDOZ v. BADISCHE ANILIN UND SODA FABRIK*, p. 533.
9. Defendant added by amendment. Cause of action not existing at the date of the writ. *See INFRINGEMENT*, No. 13.
10. Undertaking to return costs given on intimation from Judge, that otherwise he would stay payment, although not taxation. *ACKROYD AND BEST, LD. v. THOMAS AND WILLIAMS*, p. 412.
11. An order for Revocation of a Patent, even by consent, should be made in Court and not in Chambers. *IN THE MATTER OF CLIFTON'S PATENT*, p. 515.
12. Form of order for the hearing of a Petition for Revocation when the Respondent is out of the jurisdiction. *IN THE MATTER OF CLIFTON'S PATENT*, p. 515.

PRACTICE—continued.

13. Joinder in one action for infringement of persons against whom different infringements are alleged discussed.—*Action for infringement against Limited Company.—Infringement alleged before incorporation of Company.—Application by Plaintiffs for leave to amend by joining as Defendant the Company's predecessor in business.—Application granted.—Appeal by Defendants.—Appeal dismissed on a certain undertaking being given by the Plaintiffs.* SACCHARIN CORPORATION, LD. *v.* D. T. J. LYLE AND SON, LD., p. 604.
14. Stay of inquiry as to damages refused. In the absence of special reasons a stay of the inquiry pending an appeal will not be granted unless the Plaintiff consents. EVANS AND J. AND J. TAUNTON, LD. *v.* HOSKINS AND SEWELL, LD., p. 675.
15. Stay of injunction pending appeal refused. PETER PILKINGTON, LD. *v.* B. AND S. MASSEY, p. 421.
16. Form of order on motion for judgment in default of defence where several Patents are alleged to be infringed. SACCHARIN CORPORATION, LD. *v.* HOPKINSON, p. 272.
17. Inspection. *See* COSTS, No. 1.
18. Particulars of Breaches when certified whether to be initialled by the Judge. DUNLOP PNEUMATIC TYRE CO., LD. *v.* HYDE RUBBER CO., p. 210.

PRINCIPLE.

If a Patentee intends to claim a general principle, it is his duty to make that intention reasonably clear in his Specification. ACKROYD AND BEST, LD. *v.* THOMAS AND WILLIAMS, p. 737.

PRIOR PUBLICATION. *See* NOVELTY (WANT OF).

PRIOR USER. *See* NOVELTY (WANT OF).

PUBLIC AUTHORITIES PROTECTION ACT, 1893. *See* COSTS, No. 5.

REVOCATION (PETITION FOR). *See also* VARIANCE; PRACTICE, No. 12.

An Order for Revocation of a Patent, even by consent, should be made in Court and not in Chambers.—*Petition for Revocation.—Consent Order for Revocation.—Application in Chambers refused.—Order for Revocation made in Court.—Form of Order for hearing of a Petition when the Respondent is out of the Jurisdiction.* IN THE MATTER OF CLIFTON'S PATENT, p. 515.

SERVICE OUT OF THE JURISDICTION. *See* PRACTICE, Nos. 6 and 8.

SPECIFICATION (AMENDMENT OF). *See* **AMENDMENT OF SPECIFICATION.**

SPECIFICATION (CONSTRUCTION OF).

1. "My Lords, I disclaim putting either a benevolent or malevolent interpretation on the Specification, or being astute either to uphold or invalidate the Patent. I am of opinion that a Specification like any other document should be construed by the Court according to the fair meaning of the language used after being informed by evidence of the nature of the subject-matter, the state of knowledge at the date of the patent, and the meaning of any scientific or technical words that are found in it." Per Lord DAVEY in *PATENT EXPLOITATION, LD. v. SIEMENS BROTHERS & CO., LD.*, p. 549.

2. **On the construction of a Specification, an arrangement shown only in the Drawings and necessary to the utility of the machine, held to be incorporated in the claim by reference. Parts of a Specification deleted on amendment cannot be looked at on a question of construction.**—*Action for infringement.*—*Construction of Specification.*—*Sufficiency of description.*—*Essential feature shown in Drawings, but not in letterpress.*—*Parts of Specification struck out on amendment not to be regarded.*—*Utility.*—*Anticipation.*—*Action dismissed.*—*Appeal by Plaintiffs allowed.*—*Patent held to be valid.* The Plaintiff Company, the owners of a Patent for "Improvements in dobby looms for weaving," sued the Defendant Company for infringement. It appeared on the evidence that, in order to carry out the invention, it was necessary to incline the knife guides in a dobby (which before the date of the invention were always placed parallel to one another) at an angle to one another, and also to alter from their usual positions the centres of certain levers in the dobby known as the balk and jack levers. The Specification was amended some time prior to the action, when one of the claims, together with the whole of the letterpress relating to the position of the centres of the above levers, was struck out. The Drawings attached to the Specification, however, were not altered, and showed the centres of the levers in the required position for carrying out the invention. It was held at the trial, that the Plaintiffs' invention was useless unless the centres of the levers were placed in certain particular positions; that, since in the letterpress of the amended Specification there was no reference to the position of these centres, the Specification did not sufficiently describe the invention, which as described was useless, and that the Letters Patent were consequently invalid. The action was dismissed with costs. The Plaintiffs appealed. On the appeal the Respondents argued that, even if they were wrong on the question of construction, the Patent was anticipated; and, further, that one claim was meaningless and bad for want of utility.—*Held*, by the Court of Appeal, that on the true construction of the Specification the invention claimed was a dobby with the knife guides inclined to one another and having the system of centring shown in the Drawings, and that the claim for this combination was good; that the Patent had not been anticipated and was valid. The appeal was allowed with costs of the appeal and below, and an injunction was granted with delivery up and an inquiry as to damages, but a stay as to delivery up and as to the inquiry was arranged in case of an appeal to the House of Lords. A Certificate of the validity of the Patent having come into question was granted. Where a Specification has been amended by deleting certain parts, those parts cannot be looked

SPECIFICATION (CONSTRUCTION OF)—*continued.*

at on a question of construction. *Inglis v. Buttery* (L.R. 3 App. Cas. 552) followed. *GEORGE HATTERSLEY & SONS, LD. v. GEORGE HODGSON, LD.*, p. 517.

3. "Now in my judgment (and I think it has been so held) a Patentee "may show what he claims either by the printed matter of the "Specification alone, or by the drawings alone, or by the combination "of the two." Per COLLINS, *M.R.*, in *GEORGE HATTERSLEY & SONS, LD. v. GEORGE HODGSON, LD.*, p. 525.

SPECIFICATION (INSUFFICIENCY OF).

A Patentee is not bound to describe the best way of carrying his invention into effect, but only the best way to his knowledge. *HARDMUTH v. BAKER & SON*, p. 514.

STAY PENDING APPEAL. See PRACTICE, Nos. 10, 14 and 15.

SUBJECT-MATTER. See also NOVELTY (WANT OF), Nos. 1, 3.

1. New combination, in which a well-known mechanical arrangement was applied to a new subject, requiring considerable ingenuity, held good subject-matter and not anticipated.—*Action for infringement.—Subject-matter.—Combination.—Infringement.—Patent held valid.* In 1893 a Patent was granted to G. for "Improvements in steam traps." In 1894 another Patent was granted to G. for "Improvements in steam traps." The traps in question were expansion traps. The 1894 Patent was in effect for a combination of a lever and spring operating the valve of the steam trap. The Defendants in an action for infringement of this Patent pleaded a number of prior publications, and contended that all that the Plaintiff had done was to take a well-known mechanical contrivance and apply it to a subject to which it had not been hitherto applied, and that there was no invention.—*Held*, that the Plaintiff's invention had not been anticipated, and that the arrangement of his combination required the exercise of considerable ingenuity; that the Patent was valid, and the Plaintiff entitled to succeed. *GEIPEL v. LORD MAYOR, ALDERMEN, AND CITIZENS OF MANCHESTER*, p. 41.
2. New application of old device so as to make a useful commercial article. — *Combination. — Novelty. — Invention. — Patent held to be valid and the Defendants to have infringed. — Practice. — Amendment of writ. — Particulars of Breaches. — Patents, Designs, &c. Act, 1883, section 29 (1).* The owners of three Patents for improvements in pocket automatic gas lighters commenced an action for infringement. The Defendants denied infringement, and alleged that the Patents were invalid by reason of being anticipated, of want of subject-matter, of novelty, and of utility. The Writ as originally issued alleged infringement of one Patent only. Subsequently it was amended by the inclusion of two others. From the Statement of Claim it appeared that, although the Plaintiffs ultimately became the assignees of all the Patents, at the time of the issue of the Writ they were not the assignees of the two added under the Order giving leave to amend. The Particulars of Breaches delivered related to articles sold before the Plaintiffs had acquired a title to these two Patents, and

SUBJECT-MATTER—*continued.*

no amended Particulars of Breaches were delivered. The Plaintiffs were not able to bring their Particulars of Breaches within the first Patent. Upon objection being taken to the Plaintiffs proceeding, it was arranged by consent that the question of the validity of one only of three Patents (*i.e.*, one of the two subsequently added) should be tried, together with the question of infringement thereof, the Plaintiffs waiving any inquiry as to damages.—*Held*, that the invention was a new application of an old form of protecting cover in combination with old and well known attributes of platinum black so as to produce a useful commercial article; that the Patent was valid; and that the Defendants had infringed. *HEINE, SOLLY, & CO. v. THE CONINCO INCANDESCENT LIGHT CO.*, p. 202.

3. Patent held invalid for want of invention.—*Action for infringement.—Subject-matter.—Novelty.—Judgment for Defendant.—Certificates to Particulars of Objections.* The Plaintiffs sued for infringement of a Patent for an invention for wire mattresses, which, according to the Plaintiffs' expert witness, consisted in the combination of several parts, with a practical continuity from side to side of the framework, over which the wire fabric was stretched; the device of gaining strength by overlapping being admitted to be an old idea. In dismissing the action on the ground that no invention was proved, the Court granted a Certificate as to the Particulars of Objections delivered by the Defendant with respect to (a) subject-matter, (b) vagueness, and (c) novelty. *SIDDALL AND HILTON, LD. v. WOOD*, p. 230.

4. Patent held to be novel and to have subject-matter and to be infringed.—*Action for infringement.—Construction of Specification.—Patent held valid.—Infringement found.* A Patent was granted to B. for improvements relating to the extraction of dust from carpets, &c. The owners of the Patent brought an action for infringement against the S. Co., the L. Co., and J. S., who was the secretary and manager of, and, as the Plaintiffs alleged, a shareholder in the S. Co. The Defendants denied infringement, and set up the invalidity of the Patent. In the course of the trial the action was dismissed against the L. Co. with costs.—*Held*, that according to the true construction of the Specification the Patent was for an instrument to carry out a particular process, and was valid; and that the S. Co. had infringed, and an injunction was granted against them; but that no case had been made out against J. S., and the action was dismissed as against him with costs. *BRITISH VACUUM CLEANER CO., LD. v. SUCTION CLEANERS, LD.*, p. 303.

5. Patent for a method and a machine held to be confined to the method by means of the patented machine. Patent held valid and infringement found.—*Action for infringement.—Construction of Specification.—Novelty.—Subject-matter.—Utility.—Infringement.—Judgment for Plaintiff.—Defendants' appeal dismissed.* The Patentees of an invention of "Improvements in attaching bindings to the brims of hats" stated in their Specification that the invention consisted "in fitting a hat having a stiff, curled, or rolled brim, with a binding having its inner edge connected to the inner side of the brim by stitches extending through the same and being turned over the edge of the brim so as to cover said edge and also cover and protect the connecting stitches; the said binding having its ends connected

SUBJECT-MATTER—*continued*.

"together subsequent to its connection to the brim and prior to its being turned or snapped over the edge of same, for a purpose herein—after pointed out"; that the invention also consisted of a machine, and the Specification proceeded to describe the machine and the method of attaching the binding to the hat by means of the machine. The Patentee claimed, first, "The herein described method of attaching to a hat having a stiff, curled or rolled brim, a binding having," &c. (as above) "substantially as specified," and the other claims were for sewing machines comprising elements therein respectively specified. The Defendants denied infringement, and alleged want of novelty and want of subject-matter as to all the claims, and contended in particular that the first claim included attaching the binding by hand in the manner described in that claim. For the Plaintiffs, whilst it was alleged that in any case the method was new, it was contended that Claim 1 only included attaching the binding by the machine. The Defendants also alleged that the only thing new in the machine was making a concavity in the underside of the work-supporting arm for the purpose of clearance in working, that all the other elements were old, and that there was no invention.—*Held*, (affirming *Buckley, J.*), that Claim 1 was for the method of attaching the binding by means of the machine; that novelty and utility in respect of all the claims was established; and that the Defendants had infringed. *GAMMONS v. BATTERSBY*, p. 322.

6. **New application of a known device in such a way as to form a new and useful apparatus.**—*Action for infringement.*—*Novelty.*—*Subject-matter.*—*Appendant claim.*—*Judgment for Plaintiff.*—*Certificate that the validity of the Patent came in question given.* In 1899 a Patent was granted to the Plaintiff and another for "Improved means applicable for use in the production of photo-prints." The invention consisted essentially in mounting a cylinder, used in conjunction with an arc light for reproducing architects' and engineers' drawings by photography, upon trunnions, so that it could be placed in a horizontal position. The main defence was want of subject-matter.—*Held*, that the invention was new, useful, and had not been anticipated, and that it was good subject-matter for a Patent, and also that the Defendants had infringed. One claim was held to be merely appendant. Judgment was given for the Plaintiff. *JOSEPH HALDEN v. B. J. HALL & Co.*, p. 609.

THREATS (ACTION TO RESTRAIN).

1. **Due diligence in section 32 of the Patents, &c. Act, 1883 means after the threats not after the acts complained of as infringements.**—*Action for infringement.*—*Motion by Defendants to restrain advertisements by Plaintiffs.*—*Threats.*—*Due diligence.*—*Contempt of Court.*—*Motion dismissed.*—*Patents, &c., Act, 1883, section 32.* On the 19th of April 1904, the owners of Letters Patent commenced an action for infringement of the Patent, in which they delivered their Statement of Claim on the 20th of May 1904. On the 8th of June they issued advertisements containing threats, which were circulated among the customers of the Defendants and referred specifically to their goods. The Defendants moved in the action to restrain the Plaintiffs from representing by advertisements or

THREATS (ACTION TO RESTRAIN)—*continued.*

otherwise that the Defendants' goods were infringements of the Plaintiffs' Patent, and they relied on section 32 of the Patents, &c. Act, 1883, alleging that the Plaintiffs had known of the sale of the Defendants' goods for eighteen months; they also alleged that the advertisements were a contempt of Court. At the date of the hearing of the Motion, on June the 23rd, the Defendants had not put in their Defence. The Plaintiffs had brought actions against other persons, who had submitted. —*Held* (following *Challender v. Royle*, 4 R.P.C. 363), that "due diligence" in section 32 means after the threat and not after the acts complained of as infringements, and that no want of due diligence on the part of the Plaintiffs was proved; also that the advertisement was not a contempt of Court. The motion was dismissed with costs. *HASKELL GOLF BALL CO. v. HUTCHISON and MAIN*, p. 497.

2. An action for infringement of a Patent in which the question can at some stage be tried whether certain articles, in respect of which the threats are issued, are infringements of the Patent, is an action for infringement within the proviso to section 32 of the Patents, &c. Act, 1883.—*An action to restrain threats in respect of the sale of certain articles.—Action for infringement by owners of Patent.—Particulars of Breaches not alleging specifically infringement by particular articles against which the threats were directed.—Action whether within proviso to section 32 of the Patents, &c. Act, 1883.—Alleged mala fides.—Judgment for the Defendants.* In April 1903, the Defendants, the owners of a Patent, issued circulars warning persons dealing in, or using any of the Plaintiffs' "saddles with four, six or more wires made in infringement" of the Patent. They also subsequently made certain threats in respect of specific saddles of a pattern known as "L 5," "L 14" and "L 16." In May 1903, the Defendants commenced an Action against the Plaintiffs for infringement of the Patent, but the Particulars of Breaches did not mention these saddles; "L 5" and "L 14" had not been sold prior to the commencement of the infringement Action, and the Defendants alleged that they did not then know of "L 16." In November 1903, the Plaintiffs commenced this Action to restrain the Defendants from issuing threats in respect of "L 5," "L 14" and "L 16," and for damages. They based their Action both on section 32 of the Patents, &c. Act, 1883, and on a common law right, alleging *mala fides* on the part of the Defendants. The Defendants contended that their Action against the Plaintiffs was an Action for infringement within the proviso of section 32, and was a defence under that section, and they denied *mala fides*. At the trial, the Plaintiffs submitted that the issue whether the three saddles mentioned were infringements of the Patent should be decided in the threats Action, and contended that this question could not be decided in the pending Action for infringement. The Action for infringement had, at the date of the trial of this Action, been stayed under the circumstances appearing in the Report thereof, (p. 655).—*Held*, that the infringement Action was an Action for the infringement of the Patent within the proviso to section 32 of the Patents, &c. Act, 1883, and that it constituted a defence to the threats Action so far as founded on that section, that there was no evidence of *mala fides* in the Defendants' conduct, and that under the circumstances it was unnecessary to decide the issue of infringement, which could be decided at some stage of the infringement Action. The Action was dismissed with costs. *LYCETT SADDLE AND MOTOR ACCESSORIES CO., LD. v. J. B. BROOKS & CO., LD.*, p. 656.

TRANSVAAL PATENT ACT, 1887.

Under section 29 of the Transvaal Patent Act, 1887, the Court had power to order the cancellation of a Patent although the State Attorney was not a party. No appeal from a judgment in an Action in High Court of the late South African Republic before annexation.—*Order for cancellation of Patent.—Appeal to Supreme Court of Transvaal.—Jurisdiction to hear Appeal.—Appeal dismissed.—Appeal to Privy Council dismissed.—Transvaal Patent Act, No. 6 of 1887, sections 29, 30, and 31.* In 1896 judgment was given by the High Court of the late South African Republic in an action brought to obtain a declaration that a Patent granted by the Republic was null and void. The Order of the Court declared that the Patent was void, and that the Patent was therefore cancelled. In 1902 the owners of the Patent presented a Petition to the Supreme Court of the Transvaal asking that the judgment might be set aside, or that the record might be amended by striking out the Order for cancellation, and for liberty to apply for leave to amend the Specification, the owners of the Patent having applied for such leave prior to the said judgment. The Supreme Court decided that it had no jurisdiction to rehear the matter; that the Order for cancellation was right under sections 29 to 31 of the Transvaal Patent Act, No. 6 of 1887; and that the application for leave to apply to amend the Specification could not now be considered. The owners of the Patent appealed.—*Held*, by the Judicial Committee of the Privy Council, that the Supreme Court of the Transvaal had no jurisdiction to entertain an appeal from the High Court of the South African Republic, and that the High Court had power to order the Patent to be cancelled. The appeal was dismissed with costs. *AFRICAN GOLD RECOVERY CO., LD. v. HAY*, p. 729.

TRUSTEE ACT, 1893. *See* VESTING ORDER.

USE AND EXERCISE. *See* LICENCE, No. 2.

UTILITY. *See* SPECIFICATION (CONSTRUCTION OF), No. 2.

VARIANCE.

1. *Alleged disconformity not established.* The terms on which liberty should be given to apply at the Patent Office for leave to amend a Specification are in the discretion of the Judge giving such liberty.—*Petition for revocation.—Disconformity.—Want of subject-matter.—Disclaimer of part of invention.—Form of Order of revocation.—Terms imposed on amendment by disclaimer under section 19 of the Patents, &c. Act, 1883.—Patents, &c. Act, 1883, section 26.* In 1893 Letters Patent were granted to G. for improvements in and connected with steam traps. A Petition was presented for revocation of the Patent, and it was alleged in the Particulars of Objections, as amended and re-amended, that the invention was not new, that there was no subject-matter, that the invention was not useful, and that the Complete Specification of the Letters Patent described and claimed an invention different from and larger than the

VARIANCE—*continued.*

alleged invention described in the Provisional Specification. During the hearing of the Petition it was admitted that, in any event, the Specification would require amendment, as one modification of the invention was proved useless. It was held by *Buckley, J.* (20 R.P.C. 545), that there was good subject-matter for the Patent, but that disconformity between the Provisional Specification and the Complete Specification was established, as the nature of the invention described in the Provisional was the application, in the way described, of the principle of differential expansion, whereas the Complete covered an application, in a particular way described, of the principle of controlled expansion, and that the Patent must be revoked, unless within three months the Patentee obtained leave to amend by disclaimer. It was also *held*, that if the Specification was amended no injunction was to be asked for in any action brought for infringement of the Patent in respect of any steam traps made prior to the date of judgment, unless the Patentee established to the satisfaction of the Court that his original claim was made in good faith and with reasonable skill and knowledge. The Patentee, Respondent to the Petition, appealed, and there was a cross appeal by the Petitioners against the judgment as to terms under section 19.—*Held*, that there was no disconformity between the Provisional Specification and the Complete Specification, as otherwise a Patentee could not in any way vary from his Provisional Specification, and that the appeal must be allowed.—*Held* also, that the Judge had exercised his discretion with regard to terms as to disclaimer, and that the cross appeal must be dismissed. IN THE MATTER OF GEIPEL'S PATENT, p. 379.

VESTING ORDER.

Where by reason of the dissolution of a Company the Crown has become legal owner of a Patent, the Court has no jurisdiction to make an order vesting the Patent in a person equitably entitled as against the Company.—*Sale of Company.—Dissolution of Company without assignment.—Petition for Vesting Order dismissed.—Trustee Act, 1893, sections 25 and 35.—Patents, &c. Act, 1883, sections 87 and 90.* A Limited Company, the registered proprietor of a Patent, went into voluntary liquidation, and the liquidators contracted to sell the Patent. The final meeting of the Company was held and the requisite return was made by the liquidators to the Registrar of Joint Stock Companies, and by virtue of section 143 of the Companies Act, 1862, the Company was dissolved on the expiration of three months from the return. The purchase money under the contract was previously paid, but no assignment of the Patent was made to the purchaser. The purchaser presented a Petition under the Trustee Act, 1893, asking for a Vesting Order; the Petition was also entitled as being under the Patents, &c. Act, 1883. It was contended for the Petitioner that the Company had become a trustee for him, and that in view of its dissolution the trustee could not be found within the meaning of section 35 of the Trustee Act, 1893. By the direction of the Court the Petition was served on the Crown, and Counsel for the Crown was willing to consent to a Vesting Order.—*Held*, that the case did not fall within the provisions of the Trustee Act, 1893; that the legal estate had vested in the Crown, and that the Crown was not bound by a trust, and was not bound by the Trustee Act;

VESTING ORDER—*continued.*

that, even if there were consent on behalf of the Crown, there was no jurisdiction under the Act to make a Vesting Order under the circumstances. The Petition was ordered to stand over to allow the Petitioner to apply at the Patent Office to have his name entered on the Register as proprietor of the Patent; this was done under the direction of the Board of Trade, and the Petition was dismissed. *Query*, whether the Patent had merged. *In re Accident Assurance Corporation, Ltd.* (L.R. (1904) 1 Ch. 147) not followed. IN RE TAYLOR'S AGREEMENT TRUSTS, p. 713.

WARRANTY (BREACH OF). *See* CONTRACT, No. 2.

DIGEST OF DESIGN CASES.

INFRINGEMENT.

Infringement found of one Design, but not of another.—*Marking before sale.*—*Anticipation.*—*Verdict for Plaintiffs with 5l. damages.*—*Costs.*—*Patents, &c. Act, 1883, section 51.* INGRAM AND KEMP, LD. v. EDWARDS BROTHERS, p. 463.

MARKING OF ARTICLES. *See* VALIDITY and INFRINGEMENT.

PRACTICE.

Costs of unnecessary affidavits disallowed.—*Action for infringement.*—*Motion treated as trial.*—*Judgment for Plaintiff by consent.*—*Costs of affidavits.* TINLEY v. SMART AND PARKER, LD., p. 210.

VALIDITY.

Design not invalidated by the grant of a Patent for the same article on an application previous to the registration of the Design. **Marking of articles.**—*Action for infringement.*—*Validity of registration.*—*Patent granted on application prior to registration of Design.*—*Novelty.*—*Defendants threatening to sell after knowledge of registration.*—*Marking of articles.*—*Judgment for Plaintiffs.*—*Appeal dismissed.*—*Patents, &c. Act, 1883, sections 51, 58, and 59.* On the 18th of November 1901, M. W. and E. W. registered a Design applicable "for the pattern as shown of a motor-cycle frame," and the registered proprietors of the Design subsequently commenced an action for infringement. The Defendants denied infringement, and alleged that the registration was invalid for want of novelty; they also alleged that the sales made by them before action had been made without knowledge of the registration of the Design, and at the trial they contended that, although they had made a few sales after the commencement of the action, they had never threatened to do any wrongful act, since on the evidence the copyright had ceased under section 51 of the Patents, &c. Act, 1883, by reason of insufficient marking of articles by the Plaintiffs; they further alleged that a Patent had been applied for on the 8th of November 1901 for a frame for motor-cycles the same as that shown in the Design, and that, the Patent having been granted on an application made before the application to register the Design, the

VALIDITY—*continued.*

registration of the Design was invalidated by reason of a prior grant of exclusive rights in the article. It was *held* by *Byrne, J.*, at the trial, that the Design was novel, and that the design of the machine sold by the Defendants was, with the exception of immaterial details, identical with the registered Design; that the fact of the registration was unknown to the Defendants before action, and their acts until then were protected as far as penalties or damages were concerned, but that having regard to the subsequent sales and the position taken up by the Defendants on the motion and subsequently, the Plaintiffs were entitled to an injunction against infringement; that there was no evidence of articles insufficiently marked having been sold; and that the registration of the Design was not invalidated by the Patent, because, first, the Design was registered before the actual grant of the Patent; secondly, that the right of copyright in a Design is not a grant but is statutory; and, thirdly, that rights under a Patent and in a Design are separate and distinct and may co-exist. An injunction was granted with costs, and by arrangement the Plaintiffs accepted a fixed sum for damages. The Defendants appealed.—*Held*, that the learned Judge was correct in his finding of the facts; that in the circumstances the registration of the Design was valid, and that the applicant for a Patent for an article, and for registration of a Design for the shape of a similar article is not, under the Patents, &c. Act, 1883, put to an election, but may secure both. The Appeal was dismissed with costs. *WERNER MOTORS, LD. v. A. W. GAMAGE, LD.*, pp. 137 and 621.

DIGEST OF TRADE MARK, TRADE NAME AND OTHER CASES.

ADVERTISEMENTS.

To make advertisements relevant in a passing-off action, it must be shown that they had some effect. Per VAUGHAN WILLIAMS, *L.J.*, in *CHRISTY & Co. v. TIPPER AND SON*, p. 97.

ALTERATION OF MARK.

Addition of Limited, alteration of address, &c. Form of Order.—*Motion for leave to alter Registered Trade Mark.*—*Name of proprietor.*—*Address.*—*Leave given.*—*Form of Order.*—*Practice.*—*Patents, &c. Act, 1883, section 92.* Leave was given to add the word "limited" to the name of the former proprietor, to substitute the address of the Company and to minor alterations, but the alteration allowed was according to a particular exhibit, following *In the Matter of Cockle & Co's. Trade Mark*, 20 R.P.C. 353. IN THE MATTER OF THE TRADE MARK OF J. T. DAVENPORT, LD., p. 726.

APPLICATION FOR REGISTRATION. *See* REGISTRATION.

BOTTLES WITH NAME EMBOSSED ON THEM. *See* INFRINGEMENT, No. 5; MERCHANDISE MARKS ACT, 1887; PASSING-OFF, No. 2.

CERTIFICATE OF VALIDITY OF TRADE MARK HAVING COME INTO QUESTION.

Certificate granted. *BURROUGHS AND WELLCOME v. THOMPSON AND CAPPER*, p. 85.

COSTS.

1. Successful Defendant deprived of costs because of his wrongful use of the word "registered." *B. WARSOP & SONS, LD. v. WARSOP*, p. 481.
2. Successful Defendant deprived of costs because of false statements on his wrappers as to medals and awards. *KING & Co., LD. v. GILLARD & Co., LD.*, p. 589.

COUNTY COURT.

A County Court has jurisdiction to try an action for infringement of Trade Mark, where the damages claimed are less than £50, subject to the Defendant applying to remove the action to the High Court on the ground of the County Court having no jurisdiction to expunge the Trade Mark.—*Action for infringement in County Court.*—*Validity of Trade Mark put in issue by Defendant.*—*Jurisdiction of County Court.*—*"Franchise."*—*No Order made.*—*Appeal by Plaintiff.*—*County Court held to have jurisdiction.*—*Appeal allowed.*—*County Courts Act 1888, sections 56 and 126.*—*Patents, &c. Act, 1888, section 18.* The registered proprietor of a Trade Mark having brought an action for infringement in a County Court, the Defendant gave notice that he disputed the validity of the Trade Mark and intended to apply to the High Court to have the Trade Mark expunged from the Register. At the hearing it was contended for the Defendant that the County Court had no jurisdiction on the grounds, first, that the Trade Mark was a "franchise" within the meaning of section 56 of the County Courts Act, 1888; and, secondly, that the machinery of Trade Mark litigation was inconsistent with the existence of jurisdiction in the County Court. The Judge, having regard to there being no jurisdiction in the County Court to try the issue of validity, made no Order. The Plaintiff appealed.—*Held*, that a Trade Mark is not a "franchise," and that the County Court had jurisdiction to try the action, but that, if an application were made by the Defendant under section 126 of the County Courts Act, 1888, to remove the action to the High Court, effect ought to be given to it. The Appeal was allowed, the costs to abide the result of the action. Leave to appeal was given. *BOW v. HART*, p. 718.

DELAY.

Delivery up refused on account of Plaintiffs' delay. *COUNTY CHEMICAL CO., LD. v. FRANKENBURG*, p. 722. See *PASSING-OFF*, No. 23.

DELIVERY UP.

Refused on account of Plaintiffs' delay. *COUNTY CHEMICAL CO., LD. v. FRANKENBURG*, p. 722. See *PASSING-OFF*, No. 23.

DISENTITLED TO PROTECTION. See *RECTIFICATION OF THE REGISTER*, No. 7.

EVIDENCE.

In an action for passing-off and for infringement of Trade Mark, it is not permissible to ask a witness whether in his opinion any confusion is likely to arise between the words or marks; but surrounding facts and circumstances on which he would form his opinion may be proved. *N. K. FAIRBANK CO. v. COCOS BUTTER MANUFACTURING CO.*, p. 23.

FANCY WORD. See *RECTIFICATION*, No. 2.

FRANCHISE.

A Trade Mark is not a franchise. *BOW v. HART*, p. 718. See COUNTY COURT.

GEOGRAPHICAL WORD. See PASSING-OFF, No. 7.

INFRINGEMENT. See also MERCHANDISE MARKS ACT, 1887; PASSING OFF, Nos. 1, 7, 10; and COUNTY COURT.

1. "**Securine**" held to be an infringement of "**Seccotine**."—*Similarity of name used by Defendants to the Plaintiffs' Trade Mark.—Injunction granted.* The Plaintiffs in 1894 registered the word "Seccotine" as a Trade Mark for a cement, and used it extensively. The Defendants began to sell a cement as "Securine."—*Held*, that "Securine" was a colourable imitation of "Seccotine," and an injunction was awarded with consequential relief. *MCCAW, STEVENSON, AND ORR, LD. v. NICKOLS & CO.*, p. 15.
2. **Infringement found. Defendants' label calculated to deceive.**—*Action for infringement and to restrain passing off.—Reputation acquired under words descriptive of a Trade Mark.—Injunction granted with costs, but no inquiry as to damages, as the Defendant's sales were so small.* B. and S. (the Plaintiffs), distillers and wine and spirit merchants, registered in 1879 a Trade Mark (No. 20,505 in Class 43) for fermented liquors and spirits, including liqueurs, as having been used for 25 years prior to 1879. The mark comprised a cat with one paw uplifted standing on a barrel placed on its bilge. Sweetened gin, one of the articles sold by them, had long been known as "Old Tom," and with the mark they associated those words. In addition to selling gin they in 1893 began to sell a liqueur called "Sloe Gin" under their mark with suitable letterpress. The Defendant H., in November 1899, commenced to sell sloe gin under a label containing thereon a cat looking out of a barrel with the words "Cat Brand" on a scroll underneath it. No manufacturer's name appeared on the label, but there were the words, "Specially prepared and bottled for A. C. Huddart." H. obtained the article bottled and labelled from M. D. & Co. M. D. & Co., in response to a letter of complaint addressed to H., accepted the responsibility, gave H. an indemnity, claimed that the label complained of was their ordinary label used by them in their trade since 1876, and that it had been adapted for sloe gin by the addition of suitable letterpress. In 1887 M. D. & Co. had applied to register a Trade Mark consisting of a cat and barrel. The application was refused on the ground that the mark was calculated to deceive. They, however, continued to use the mark, and placed upon their label the word "Registered." It was suggested by them, in answer to Plaintiffs' inquiries, that this meant copyright registered. No registration, however, anterior in date to the 4th of February 1899 was produced at the trial. M. D. & Co., who were not Defendants, sought to prove that a cat and barrel label was common to the spirit trade, and that the Plaintiffs, with knowledge of its use, had not been vigilant. They contended also that at the date of registration the Plaintiffs did not manufacture "Sloe Gin," and that they could not claim the exclusive use of the mark for all articles in the class. The Plaintiffs contended that M. D. & Co.'s user had been acquired in fraud of them by the use of the word "Registered"; and there was no

INFRINGEMENT—*continued*.

satisfactory evidence of the user of similar marks; and claimed that they (the Plaintiffs) had acquired an exclusive reputation for goods of the same description as gin under the designation "Cat Brand" or "Cat and Barrel Brand."—*Held*, that the label complained of was an infringement of the Plaintiffs' registered Trade Mark, and also was calculated to mislead and to induce the belief that goods so labelled were the manufacture of the Plaintiffs. An injunction was granted with costs, but no inquiry as to damages, the Defendant's sales being so small. *BOORD & SON v. HUDDART*, p. 149.

3. **Mark used by salesman on baskets containing goods consigned to him. Use as a Trade Mark. Defendant responsible for acts of his agent.**—*Conversion of baskets.*—*Judgment for Plaintiff for nominal damages and costs.* The name of a Covent Garden salesman was registered as an old mark, and was marked upon baskets belonging to him and used by growers of the vegetables consigned to him for sale on commission for the purpose of packing and forwarding their goods to him. Some of the baskets sent by him to one of such growers for such purposes were made use of to send vegetables to other salesmen, and the vegetables were exposed for sale in the baskets by the other salesmen. The business of the grower had been assigned to the Defendant as trustee for the grower's creditors and at the time of the wrongful use of the baskets the grower was carrying on the business as agent for the Defendant.—*Held*, that the Plaintiff was entitled to damages for infringement of Trade Mark and for conversion of the baskets against the Defendant, notwithstanding that the wrongful acts had been committed contrary to his orders. The Plaintiff charged the growers to whom he sent his baskets a sum, less than the value of the baskets, as security for their return and to enable him to keep an account. This was not held to constitute a sale of the baskets. *MONRO v. HUNTER*, p. 296.

4. **Wine rejected by Plaintiffs sold in casks bearing their name which was registered as their Trade Mark. Defendants not entitled to sell it as Plaintiffs' wine.** *Passing-off.*—*Mark name of Plaintiff.*—*Sale of goods bearing name.*—*Estoppel.*—*Injunction against infringement of Trade Mark and Passing-off.* The Plaintiffs, who are the registered proprietors of the Trade Mark "Burgoyne," for wine, sold by auction wine in casks bearing the inscription "Burgoyne, London." The wine had been consigned to the Plaintiffs on approval and rejected by them, and was sold on account of the growers. The Defendants purchased the wine at the auction, and re-sold it as "Burgoyne's Superior Australian Burgundy." In an action to restrain the Defendants from infringing the Plaintiffs' Trade Mark, and from passing-off the wine in question as being the Plaintiffs' wine.—*Held*, that the wine was not the Plaintiffs' wine, and that the Plaintiffs were not estopped by their conduct from restraining the sale of the wine as their wine. An injunction and an account of profits were granted. *BURGOYNE & CO., LD. v. A. H. GODFREE & CO.*, p. 551.*

* The decision in this case has since been reversed on appeal.

INFRINGEMENT—*continued.*

5. Interdict granted against the use of syphons bearing the Plaintiffs' Trade Marks and names.—*Trade Mark engraved on syphons.—Property in syphons.—Bottle Exchange.—One member interdicted from using another's syphons.* B. & Co., M., and C., the three Complainers, and M. and D. the Respondents, were all manufacturers of aerated waters and members of a Bottle Exchange. When their full syphons were sent to customers they received in return empty syphons, sometimes marked with their own name, sometimes plain, sometimes marked with the names and Trade Marks of other manufacturers. The last it was their duty by the rules of the Bottle Exchange to send to the Exchange. Instead of doing this the Respondents had filled with their aerated water a number of syphons of the Complainers and sent them to *W. and W.* in execution of an order for the Respondents' aerated waters.—*Held*, that the Complainers were entitled to interdict the Respondents from so using their syphons. *BARR AND CO. v. MAIR AND DOUGALL, MOORE v. SAME, COMRIE v. SAME*, p. 665.

“INNOCENTLY.” See *MERCHANDIZE MARKS ACT, 1887.*

INTERLOCUTORY INJUNCTION.

Injunction granted. *POULTON & SON v. KELLY & SON*, p. 393.

INVENTED WORD.

1. An invented word must be invented for the purpose of being used as a Trade Mark, and must not be merely an old word used in a new sense. *Semble* that it must be coined for the purpose of being registered as a Trade Mark. *HOMMEL v. GEBRÜDER BAUER & Co.*, p. 576. See *RECTIFICATION OF THE REGISTER*, No. 6.
2. “Absorbine” held not to be an invented word for an absorbent preparation. *CHRISTY & Co. v. TIPPER & SON*, pp. 97 and 775. See *RECTIFICATION*, No. 3.
3. “Bioscope” held to be a known English word at the date of Registration and not an invented word. *WARWICK TRADING CO., LD. v. URBAN*, p. 240. See *RECTIFICATION*, No. 4.

JURISDICTION. See *COUNTY COURT.*

LIMITATION OF REGISTRATION. See *RECTIFICATION*, No. 5.

MERCHANDIZE MARKS ACT, 1887.

A person is not acting innocently within the meaning of section 2, subsection 2 (c) of the Act if he is doing intentionally a thing which the Act forbids.—*Selling mineral waters not of Plaintiffs' manufacture, in bottles embossed with Plaintiffs' name, registered as a Trade Mark, but bearing labels with Defendants' name and address as manufacturers.*—No actual fraud or deception proved or alleged.—*Meaning of "innocently" in section 2, subsection 2, of Merchandise Marks Act, 1887.*—*Injunction granted.*—*Appeal dismissed.* The Plaintiffs were manufacturers of mineral and aerated waters in Dublin, which they sold to the trade in bottles embossed with their names, registered as Trade Marks. The Defendants, who were manufacturers in Limerick, had become possessed of a number of the Plaintiffs' bottles so embossed, which they refilled with waters of their own manufacture, and sold to retailers, but with labels affixed bearing their own name and address as manufacturers. It was not proved or alleged that fraud was intended, or that any person had been actually misled. The Defendants gave evidence that the public were guided, not by the name embossed on the bottle, but by the label; but the Plaintiffs contended that the label was liable to fall off, or might be removed by a fraudulent retailer, who could then sell the contents as of Plaintiffs' manufacture. No evidence was given that this had in fact been done; but the Plaintiffs had served notices on the Defendants cautioning them against using bottles so embossed, notwithstanding which they persisted in using them, and claimed a right to do so. An injunction was granted by the *Master of the Rolls* with costs, 20 R.P.C. 663. The Defendants appealed.—*Held*, by the Court of Appeal, that the Defendants, by putting mineral water of their own manufacture into bottles bearing the Plaintiffs' Trade Marks, committed an offence against the Merchandise Marks Act; that "innocently," in section 2, subsection 2 (c) of that Act means innocence of intention to infringe the Act, and that placing labels bearing their own names on the bottles did not exonerate the Defendants. Appeal dismissed, and the decision of *Master of Rolls* affirmed, with costs. *Allen v. Richards* (26 S.J. 658), approved. *THWAITES & CO. v. M'EVILLY. CANTRELL AND COCHRANE v. MURPHY AND BRADSHAW*, p. 397.

NON-USER. See RECTIFICATION, No. 5.

OPPOSITION. See REGISTRATION.

PASSING-OFF. See also INFRINGEMENT, Nos. 2, 4; RECTIFICATION, No. 5; TRADE NAME.

1. "Cocosoline" not an infringement of or likely to be mistaken for "Cottolene."—*Articles made from different natural products.*—*Get-up dissimilar.*—*Absence of fraud.*—*No probability of deception.*—*Action dismissed.* The N. K. F. Co. had for many years prior to 1888 manufactured from cotton-seed oil and sold in America a butter substitute called "Cottolene." In 1888 and 1899 they registered the word "Cottolene" in Class 42. In 1892 they commenced to sell wholesale in this country, and so continued. In 1902 the Defendant, a member of a firm of cocoa-nut oil manufacturers of Ceylon, commenced to manufacture in England and sell wholesale a butter substitute made

PASSING-OFF—*continued.*

from cocoa-nut oil, and advertised it for sale under the name "Cocosoline." The N. K. F. Co. alleged that the "Co" of "Cocosoline" would be omitted in practice; that, the sound being similar, would cause confusion, and enable the Defendant's goods to be passed off as and for the Plaintiffs'. The get-up of the Defendant's goods was different from the get-up of the Plaintiffs' goods.—*Held*, that the Defendant had acted honestly in the choice of a name not inappropriate, and that there was no reasonable probability of the Defendant's goods being passed off as the Plaintiffs' by the mere use of the word "Cocosoline." The action was dismissed with costs. *N. K. FAIRBANK CO. v. COCOS BUTTER MANUFACTURING CO.*, p. 23.

2. **Trade name embossed on bottles held under the circumstances not indicative of the origin of the contents.**—*Alleged passing off and deceit.—Action to restrain.—Interdict refused by the Lord Ordinary and by the Inner House.* W. & S. and also M. were beer bottlers and possessed bottles on which, as in the case of other Edinburgh bottlers, their respective names were embossed, and in which they bottled beer or aerated waters which they did not brew or make. Prior to the institution of a "Bottlers' Exchange" in March 1902 (which "Exchange," however, did not comprise all the members of the trade), the practice of the trade justified the retention by individual bottlers of other bottlers' bottles, returned in exchange for their own, and filling them and sending them out again as if they were their own. After March 1902, each bottler was supposed to get back and fill only his own bottles, and individual bottlers tried to prevent their rivals filling bottles embossed with any but their own names. In December 1902, W. & S. found in a grocer's shop seventeen of their bottles marked with their name, bearing also the name of the brewer but not of the name of any bottler, although they had been filled by M. W. & S. thereupon sought to interdict M. from filling their bottles and sending them on the market, on the ground that by doing so M. represented that the beer so bottled and sold by him was beer of W. & S.'s bottling.—*Held*, by the *Lord Ordinary*, that W. & S. had failed to prove that the Respondent's use of their bottles deceived the trade or the public, or was in the circumstances fitted to deceive the trade or the public. Interdict was refused with expenses. W. & S. reclaimed. The Inner House adhered to the Judgment of the *Lord Ordinary*. *WOOLLEY AND SON v. MORRISON*, pp. 63 and 349.
3. **Secondary meaning of descriptive word not established. No right of action in Plaintiffs not proving a secondary meaning, although descriptive word not properly used by Defendant.**—*Trade Name of goods.*—"Naphtha."—*Action to restrain passing-off.*—*Name associated with Plaintiffs' goods by public for two years.*—*Descriptive word.*—*No right of action in Plaintiffs, who are unable to claim such a name as their own, to an injunction restraining its use even where it is not properly descriptive.*—*Appeal dismissed.* The Plaintiffs, *Fels & Co.*, were manufacturers in America of a cold water household soap which from its commencement in 1891 they had sold under the name "Fels-Naphtha," naphtha being in fact an important ingredient in the soap from its special cleansing qualities. They commenced substantial sales of their soap in England in February 1900 under the above name, but it appeared that dealers and customers had frequently, while the Plaintiffs' soap was the only soap of the kind on the market, designated this soap by the simple name "Naphtha" or

PASSING-OFF—*continued.*

"Naphtha Soap." In the latter part of 1902 the Defendants commenced to manufacture and sell a similar soap, which was put upon the market as "Christopher's Naphtha Soap—Chrstr. Thomas & Brothers, Ltd., Bristol." There was a conflict of expert evidence of analysts with respect to the presence of naphtha in the Defendants' soap, all the analysts called for the Plaintiffs alleging that it did not contain naphtha but only contained a distinct chemical substance called naphthaline. Judgment was given for the Defendants. The Plaintiffs appealed.—*Held*, that, the word being a descriptive term as applied to the Plaintiffs' soap, the Plaintiffs had not discharged the onus of proving the identification of the name "Naphtha Soap" with themselves, which they must do in order to ask the Court to find that the Defendants had intended passing-off; and that the presence of naphtha in the Defendants' soap was irrelevant. *FELS v. CHRISTOPHER THOMAS & BROTHERS, LD.*, p. 85.

4. **Secondary meaning of descriptive word not established.**—*Trade name of goods.*—"Naphtha."—*Action to restrain passing-off.*—*Name associated with goods by public.*—*Naphtha an actual ingredient in Plaintiffs' and Defendants' goods.*—*Descriptive word.*—*Injunction refused.* The Plaintiffs, *Fels & Co.*, were manufacturers in America of a cold water household soap, which from its commencement in 1894 they had sold under the name "Fels-Naphtha," naphtha being in fact an important ingredient in the soap from its special cleansing qualities. They commenced substantial sales of their soap in England in February 1900 under the above name, but it appeared from the evidence given in this action that dealers and customers had frequently, while the Plaintiffs' was the only soap of the kind on the market, designated this soap by the simple names "Naphtha" or "Naphtha Soap." In the latter part of 1902 the Defendants, who were wholesale and retail grocers, commenced selling a similar soap made by certain manufacturers, which was put upon the market as "Rock Oil Naphtha Soap." Apart from the general trade evidence, the expert evidence of analysts was adduced, which showed that only a small amount of naphtha, far less than in the Plaintiffs' soap, was contained in the Defendants' soap. Judgment was given for the Defendants. The Plaintiffs appealed. On the appeal coming on for hearing, an Order was simply taken dismissing the appeal with a view to the consolidation of this and two similar actions for the purposes of an appeal to the House of Lords. *FELS v. STEPHENSON BROTHERS, LD.*, p. 89.
5. **Secondary meaning of descriptive word not established. No evidence of deception by similarity of get-up.**—*Trade name of goods.*—"Naphtha."—*Action to restrain passing-off.*—*Name associated with goods by public.*—*Descriptive word.*—*Get-up.*—*Injunction refused.* The Plaintiffs, *Fels & Co.*, were manufacturers in America of a cold water household soap, which from its commencement in 1894 they had sold under the name "Fels-Naphtha," naphtha being an important ingredient in the soap from its special cleansing qualities. They commenced substantial sales of their soap in England in February 1900 under the above name, but it appeared that, while the Plaintiffs' was the only soap of the kind on the market, it had extensively become the popular practice for dealers and customers to designate their soap by the simple names "Naphtha" or "Naphtha Soap," and the Plaintiffs therefore contended that those names denoted their soap.

PASSING-OFF—*continued.*

In August 1902 the Defendants *Thomas Hedley & Co., Ltd.*, put upon the market a similar soap also containing naphtha, under the name "Ladybird Naptha Soap," the word "Ladybird" being their registered Trade Mark and used for all their goods. It appeared that the Defendants' soap had also been supplied in response to orders for "Naptha" or "Naptha Soap," and was sold in wrappers similar to the Plaintiffs' (but bearing the Defendants' Trade Mark "Ladybird" and also a registered device), of which the Plaintiffs also complained.—*Held*, at the trial, by Mr. Justice *Byrne*—(1) that the get-up of the Defendants' goods, apart from the use of the words "Naptha Soap," was not calculated to deceive; (2) that as applied to the goods in question the name "Naptha" was a descriptive word, denoting an ingredient contained in them; (3) that the Defendants had done no more than they were legally entitled to do. The action was accordingly dismissed. The Plaintiffs appealed.—*Held*, on appeal, that, the decision of Mr. Justice *Byrne* on the absence of secondary meaning from the words "Naptha Soap" being correct, there was no evidence of deception by similarity of "get-up." The appeal was dismissed accordingly. *FELS v. HEDLEY & Co., LD.*, p. 91.

6. *Trade name.*—"Naptha."—*Action to restrain manufacturers from passing off their soap as the Plaintiffs'.*—*Previous action against retailers in respect of same soap dismissed.*—*Dismissal affirmed by the Court of Appeal.*—*Present action dismissed.*—*Arrangement as to appeal.* *FELS v. HODGSON AND SIMPSON*, p. 95.

7. *Word indicating locality. Exclusive right of Plaintiffs not established.*—*Trade name of goods.*—*Consolidated actions to restrain passing off and infringement of Trade Mark.*—*Plaintiffs whether exclusively entitled to word.*—*Word whether indicating locality or the goods of the Plaintiffs exclusively.*—*Appeal of Plaintiffs dismissed.* The *Grand Hotel Company of Caledonia Springs, Ltd.*, being the owners of natural springs in the township of Caledonia, Ontario, brought two actions (which were afterwards consolidated) to restrain infringement of Trade Mark and passing off, claiming an exclusive right to the word "Caledonia" in certain phrases, including "Caledonia Water," "Caledonia Springs Water," and "Mineral Water from Caledonia Springs," and also of the words "Natural Saline Water," and "Natural Seltzer." The Plaintiffs' springs were called "Caledonia Springs," and the locality was also known by that name. The Plaintiffs had the right to take water from another spring situate about two miles from those before mentioned, and included this spring in the expression "Caledonia Springs." The word "Caledonia" formed an element in certain of their Trade Marks sued on, and the Plaintiffs' waters had acquired in the market the name of "Caledonia Water." One of the Defendants bored on land belonging to another Defendant, and adjoining that of the Plaintiffs, and tapped two springs, which yielded water generally resembling that of the Plaintiffs' springs, and they entered into arrangements with the other Defendants for placing the waters so yielded on the market and selling the same. The Defendants' water was sold under the description "Natural Saline Water, from the New Springs at Caledonia," and as "Beaver Brand," which phrases appeared on the labels. At the trial, it was held that there had been no infringement of the Trade Marks, except a temporary infringement of one of them by a label of one of the Defendants, but that the Plaintiffs had

PASSING-OFF—*continued*.

established their case as to the trade names "Caledonia Water" and "Water from Caledonia Springs," and an injunction was granted restraining (*inter alia*) the use of those expressions and of "Water from the New Springs at Caledonia" by the Defendants. The Court of Appeal of Ontario allowed the Defendants' appeal dissolving the injunction, except as regards the one Defendant, against whom an injunction against the use of certain labels was granted. The Plaintiffs appealed.—*Held*, by the Judicial Committee of the Privy Council, that the Plaintiffs had not an exclusive right to the use of the word "Caledonia" in connection with waters, although the Respondents could not use the word so as to pass off their goods as those of the Plaintiffs; that there had been no infringement of Trade Mark, except in the particular instance mentioned, nor imitation of get-up; that the Defendants were entitled to indicate the local source of the waters sold by them, and that they had discharged the burden cast on them of distinguishing their goods from those of the Plaintiffs. The appeal was dismissed. GRAND HOTEL COMPANY OF CALEDONIA SPRINGS, LD. *v.* WILSON, p. 117.

8. **Secondary Meaning of descriptive term not established. Prior user found.**—*Trade name.*—*Actions for injunctions to restrain use of.*—*Descriptive term.*—*Prior user by one Defendant.*—*Actions dismissed.* W. B., an American firm, began to sell corsets in this country in February 1901, under the title of "Erect Form Corsets." Their sales prior to action were not large. In February 1902, they commenced an action against W. R. to restrain him from passing off his corsets as theirs by the use of "Erect Form," and in April 1902, they commenced a similar action against H. S. & Co. The two actions were in the list for trial on the same day, and were in effect tried together.—*Held*, that "Erect Form" as applied to corsets was a descriptive term, and had not acquired a secondary signification as denoting the Plaintiffs' corsets, and that the term had been in fact first used in this country by the Defendants S. & Co. Both actions were dismissed with costs, the Defendant W. R. being allowed the costs of three Counsel. WEINGARTEN BROTHERS *v.* ROSENTHAL. WEINGARTEN BROTHERS *v.* SHERWOOD & Co., p. 212.

9. **Passing-off by use of word "Tabloid."**—*Alleged infringement of Trade Marks and passing-off.*—*Motion to expunge Trade Marks from the Register.*—*Motion dismissed.*—*Judgment for Plaintiffs.* In and previously to the month of March 1884 the Plaintiff's firm B. W. & Co. were manufacturing and selling compressed drugs in a solid form and of a lenticular or bi-convex shape. In 1884 B. W. & Co. registered the word "Tabloid" in Classes 3 and 42, and in 1885, in the same classes, a device consisting of a frame with the word "Tabloids" inside. H. S. W., the Plaintiff (who was the surviving partner of the firm of B. W. & Co.) claimed to have invented the word "Tabloid." The acts of the Defendants complained of by the Plaintiff consisted in selling goods not of the Plaintiff's manufacture in response to orders and prescriptions for drugs under the designation of "Tabloids," or "Tabloids—B. & W." or "Tabloids—Burroughs, Wellcome & Co." preceded or followed by the name of the particular drugs required. The Plaintiff's contention was that "Tabloid" and "Tabloids" were fancy words and that they meant exclusively the goods of B. W. & Co. The Defendants denied any passing-off, and as to the Trade Marks moved to expunge them from

PASSING-OFF—*continued.*

the Register. They submitted that "Tabloid" was not a fancy word; and further, that it had not acquired an exclusive meaning as denoting the goods of B. W. & Co., but, on the contrary, had acquired a meaning connoting any compressed medicine made up in a bi-convex or similar shape, and denoted as well the goods of other manufacturers as those of B. W. & Co.; and that it had also acquired an extended meaning by analogical transfer—*e.g.*, "tabloid knowledge."—*Held*, that "Tabloid" was a fancy word as applied to the goods for which it was registered, and that the Motion to rectify failed and must be dismissed; and that, to those who constituted that portion of the public, who were primarily concerned in the matter, the words "Tabloid" and "Tabloids" meant and denoted, and had always meant and denoted, the goods of B. W. & Co.; that the Plaintiff had made out his case and was entitled to an injunction to restrain the Defendants from using the word "Tabloid" or "Tabloids" so as to pass off goods not manufactured by the Plaintiff as or for the goods of the Plaintiff. A Certificate was granted under section 77 (a) of the Patents, &c. Act, 1883, that the right to the exclusive use of the Trade Mark came in question. *Field v. Wagel Syndicate* (17 R.P.C. 266) followed. *BURROUGHS, WELLCOME & CO. v. THOMPSON AND CAPPER. IN THE MATTER OF THE TRADE MARKS*, Nos. 36,154, 36,155, 42,378, 42,379, 225,812, 225,813, 225,814, 225,815, 225,816, p. 69.*

10. **Acts complained of not established. The liability of masters for acts of servants considered.**—*Trade Mark.—Trade name.—Action to restrain use of trade name and infringement of Trade Mark.—Action to restrain the passing-off of bread as "Bermaline Bread."*—*Probability of deception.—Absence of deceit or fraud on the part of Defendant personally.—Liability for act of servant.—Interdict granted by the Lord Ordinary, but refused by the Second Division of the Inner House.* M. & Co., bakers, &c., in Scotland (the Pursuers in the action) began in 1886 to make a special bread containing extract of malt, and called this bread "Bermaline Bread," registering the word "Bermaline" as a Trade Mark, and calling the malt extract used in their bread "Bermaline Malt Extract." They advertised such names extensively and appointed agents throughout the kingdom, who were authorised to sell the Pursuers' bread and to make bread containing the Pursuers' extract of malt. In February 1902, being in a position to supply flour and meal to all their agents, they intimated to their agents that, unless they took their meal or flour for making "Bermaline Bread" made under the licence from the Pursuers, their agencies would be recalled. M. resigned his agency February 1902, took down "Bermaline Bread" from the window of his one shop in Bellshill and put up "Marshall's Malt Bread," under which name he directed his servants to sell his bread. He also instructed them never to give out his own bread as "Bermaline." The Pursuers alleged that thereafter, on fourteen occasions between October 1902 and January 1903, his servants sold to seven persons loaves as "Bermaline Bread" which were not "Bermaline Bread" having paper bands around them which were said to be colourable but innocent imitations of bands enclosing the Pursuers' loaves. Y., an agent, who had shops in Edinburgh, resigned his agency on the 5th of November 1902, and directed his servants to say they no longer kept "Bermaline Bread." The Pursuers alleged

* An appeal in this motion to rectify was dismissed. See RECTIFICATION, No. 2.

PASSING-OFF—*continued*.

that thereafter, on ten different occasions at five different shops, Y.'s servants, however, sold and described loaves as "Bermaline Bread" which were not "Bermaline Bread" to nine persons who were either customers or emissaries of M. & Co.—*Held*, by the *Lord Ordinary*, (20 R.P.C. 781) that both Defendants through their servants had represented their goods as the goods of the Pursuers and infringed their Trade Mark, and that their personal innocence did not affect the Pursuers' right to damages for invasion of a proprietary right and commission of a legal wrong; and *held*, further, that as the number of sales suggested a practice which afforded reasonable ground for an apprehension of continuance of the wrong, interdict must be granted against both Defendants selling under the name of "Bermaline" bread not manufactured by the Pursuers, or which had not been manufactured or put on the market by the Pursuers or with their authority.—*Contra held*, by the Inner House (Second Division) on the ground that the evidence did not satisfy them that either Defendant intended or committed wilful injury, or that wrong had actually been done. Observed (per Lords *Young* and *Traynor*) that, where the Court are of opinion that a master has adopted all reasonable means to prevent his servants committing a wrong, mere inadvertence or carelessness in a few unimportant instances, even if proved, may not warrant interdict being granted. Interdict refused. *MONTGOMERIE & Co., LD. v. YOUNG BROTHERS. MONTGOMERIE & Co., LD. v. MARSHALL*, p. 285.

11. **Use by Plaintiffs and Defendants of same catch-phrase in advertisements.** The Plaintiffs not the first users of the phrase as alleged.—*Action dismissed*. A firm of boot manufacturers alleged that they had invented and used as their Trade Mark the phrase, "Fair wear or a free pair," and they commenced an action against a firm of retailers of boots and shoes, complaining of the use by the Defendants of the same phrase in connection with the sale of boots and shoes, and claiming an injunction against its use and against the Defendants representing their business to be connected with the Plaintiffs' business.—*Held*, that the evidence established user of the phrase prior to the Plaintiffs' user by other persons. The action was dismissed with costs. *S. T. MIDGLEY AND SONS, LD. v. MORRIS AND COWDERY*, p. 314.
12. **Defence that the use by the Defendant of the Trade Name of the Plaintiffs' goods had been inadvertent and on few occasions not established. Evidence allowed to be given of use by the Defendants beyond the instances specified in the Record.**—"Parozone."—*Name of bleaching fluid.—Admission by Respondent of Complainers' exclusive title.—Failure of Respondent to prove inadvertence in use.—Interdict granted.—Evidence.—Specification of instances of wrongful use of name.—Evidence not limited to such specification.* The P. Co. invented and applied the name "Parozone" to a bleaching fluid made by them, and it was admitted that they were entitled to the exclusive use of that name as indicating fluid manufactured by them only. G., a small trader, also made a bleaching fluid, but said that he never sold it as "Parozone," and when asked for "Parazone" explained that his fluid was not "Parozone." The P. Co. proved that on five occasions, to two persons, G. or his servants sold his fluid in answer to a request for "Parozone," and without explanation. They further proved that G. pointed out to two former shop-girls the jar where he kept his "Parozone," and that it was a matter of

PASSING-OFF—*continued.*

daily occurrence for G.'s fluid to be sold to customers who asked for "Parozone," without explanation. G. proved that on some occasions he had explained that his bleach was not "Parozone." In the Record the P. Co. specified two individuals to whom G. had sold his bleach as "Parozone." G., in defence, stated that while he might by inadvertence have failed in one or two instances, yet his "invariable answer" to persons asking for "Parozone" was that "he had a bleaching fluid of his own manufacture which he was able to supply to them."—*Held*, by the *Lord Ordinary*, that while the P. Co. must prove their specific instances, they were entitled, without specification, to prove other instances as an answer to this defence.—*Held also*, that the P. Co. were entitled to interdict. *PAROZONE CO., LD. v. GIBSON*, p. 317.

13. **Secondary meaning of Name of Band, apart from conductor's name, not established.**—*Trade name on Band.*—*Action for injunction to restrain Defendants from representing their Band to be the Plaintiff's by the use of certain names.*—*Action dismissed.* W. brought an action against W. and G. to restrain them from representing any band other than the Plaintiff's Band to be the "White Viennese Band," the "White Hungarian Band," or the "White Band," claiming these titles as the trade names of his Band. At the trial he abandoned his case as to the two last titles.—*Held*, that the Plaintiff had failed to establish that the title "White Viennese Band" has acquired a secondary signification as denoting his Band only, and that no case of passing off had been established against the Defendants, and the action was dismissed with costs. *WURM v. WEBSTER AND GIRLING*, p. 373.
14. **Use by widow in carrying on her late husband's business of the words "from C. & Co." previously properly used by her late husband.**—*Motion for interim injunction.*—*Injunction refused.* N. was for several years in the employ of C. & Co., as assistant in and manager of their coal business. Leaving their employ, he set up business on his own account as a coal merchant, under the style of "N. from C. & Co.," which he habitually used in advertisements, letter-paper and coal waggons. Upon his death, within a year, his widow continued the business under the same style. C. & Co. commenced an action for an injunction to restrain her from so doing, but were refused such injunction, and the action was dismissed with costs. *RICKETT, COOKERELL & CO., LD. v. NEVILL*, p. 394.
15. **Plaintiff and Defendant of same surname. Marking of Defendant's goods held to be sufficiently distinct.**—"Get-up" of *Cricket Bats.*—*Name, address, and device.*—*Undertaking given by Defendant on Motion for interlocutory injunction to drop the device until the trial.*—*Injunction refused at trial.*—*Costs refused to Defendant by reason of wrongful use of word "registered."* The Plaintiffs were old established manufacturers of "B. Warsop's Cricket Bats." The Defendant, *Alfred Warsop*, who was formerly in the Plaintiffs' employ, commenced to sell "*A. Warsop's World-renowned Cricket Bats*," stamped with his initial and surname, and with a device somewhat similar to that which appeared on the Plaintiffs' bats. The word "registered" appeared on both bats, the Plaintiffs' device being in fact registered as a trade mark, but not the Defendant's, although steps had been taken to obtain registration. On the Plaintiffs' Motion for an

PASSING-OFF—*continued.*

interim injunction, no Order was made on the Defendant undertaking to sell his bats without any mark except his name and the address "Marylebone."—*Held*, at the trial, that the markings on the two bats were so distinct that it was impossible for an average man about to purchase a cricket bat to be deceived into thinking that the Defendant's bat was the Plaintiffs'; and the action was dismissed, but without costs, by reason of the Defendant's wrongful user of the word "registered." *B. WARSOP & SONS, LD. v. WARSOP*, p. 481.

16. The Defendants held entitled to describe goods as sold "for the "Neostyle," the get-up of their goods not being calculated to deceive.—*Trade name of goods.—Description of accessories for use in connection with Plaintiffs' machine.—No exclusive right in Plaintiffs to name in connection with accessories.—Judgment for Defendants.—Appeal by Plaintiffs dismissed.* The *Neostyle Manufacturing Co.*, which traded in duplicating machines and manufactured and sold accessories for use therewith, which machines and accessories they sold under the name "Neostyle," commenced an action to restrain another Company from passing off ink, paper, and stationery not of the Plaintiffs' manufacture or merchandise as and for the goods of the Plaintiffs by the use of the word "Neostyle" or otherwise, and from infringing their Trade Mark "Neostyle," registered in Class 39 in respect of paper, stationery, and bookbinding. Before the trial the Trade Mark was ordered by the Court of Appeal to be removed from the Register on the ground that the Plaintiffs had not an exclusive right to the word "Neostyle" for such goods (*Neostyle Manufacturing Co.'s Trade Mark*, 20 R.P.C. 803). The Defendants alleged *inter alia* that the term "Neostyle" was not distinctive of the Plaintiffs' goods, and that, as applied to paper, ink, and accessories, it meant that such paper, ink, and accessories were suitable for use in the "Neostyle" machine. The Defendants had described their accessories as being "for the Neostyle," and had used the term "Neostyle Ink" in a catalogue meant for the trade, and two cases of sale of "Neostyle Ink" were proved. At the trial the Plaintiffs adduced evidence to establish a case of passing-off by means of the tins in which the Defendants sold their "ink for the Neostyle," which tins had not in all cases the Defendants' name on them. It was *held* at the trial that, although the word "Neostyle" had become identified in England with the Plaintiffs' duplicating machines, they had never had any exclusive right to the word in connection with duplicator accessories; that the Defendants might sell ink and paper for use on the "Neostyle" machine, and so describe them, provided that they did not by words or get-up represent their goods as those of the Plaintiffs; that there had been no passing-off by the Defendants; and that the Plaintiffs had failed to establish a case entitling them to an injunction; but the Court suggested that the Defendants' name should always appear on the tins of ink sold by them. The action was dismissed with costs. The Plaintiffs appealed.—*Held*, that the conclusion of fact arrived at on the trial ought not to be disturbed, and the appeal was dismissed with costs. *NEOSTYLE MANUFACTURING CO., LD. v. ELLAM'S DUPLICATOR CO.*, pp. 185 and 569.

17. Notwithstanding that a word has been struck off the Register of Trade Marks, it is open to the Plaintiff in a passing-off

PASSING-OFF—*continued*.

action to prove that the word has become identified with his goods. *NEOSTYLE MANUFACTURING CO., LD. v. ELLAM'S DUPLICATOR CO.*, p. 569. *See No. 16, supra*.

18. The fact that a word which is descriptive has been registered as a Trade Mark and has been ordered to be removed from the Register is an element to be considered when a secondary meaning of the word, denoting the Plaintiff's goods, is alleged. *HOMMEL v. GEBRÜDER BAUER & CO.*, p. 576. *See RECTIFICATION OF THE REGISTER, No. 6.*
19. Defendants' goods not likely to be taken for the Plaintiffs' even by an unwary purchaser. Defendants deprived of costs by reason of false statements as to medals and awards.—*"Get up."*—*Soup-packets in steel boxes.*—*Points of resemblance common to the trade.*—*Injunction refused.* The Plaintiffs and their predecessors for upwards of fifteen years had made and sold three varieties of a special preparation of dried materials for soup in packets of certain size, shape, and printing, and these packets were put up in steel boxes of a peculiar kind. They claimed that their goods had become and were known and recognised and distinguished from all other prepared soups by means of their mode of packing and get-up. In 1903 the Defendants, who had been pickle manufacturers for many years, began to make and sell similar preparations of soup which were put up in a series of similar packets and boxes, and their name "*Gillard's*" appeared where "*Edwards*" appeared on the Plaintiffs' goods. The wrappers of the Defendants also contained untrue statements as to medals and awards in the same position as accurate statements of the Plaintiffs.—*Held*—(1) that the get-up of the Plaintiffs' goods was not distinctive of goods of their manufacture; (2) that the Defendants' goods only resembled the Plaintiffs' in points common to the trade; (3) that no case of actual deception had been proved; (4) that the Defendants' goods were not calculated to deceive even an unwary purchaser. The action was dismissed, but judgment was given for the Defendants without costs by reason of the untrue statements as to medals and awards made on their wrappers. Per *KEKEWICH, J.*—"Deception is not always the deception of the person who purchases, not proceeding from his or her mind, but is the deception of the person who sells; and where you can see that the person who sells has been enabled by the resemblance of the goods to practice deception, that is quite as conclusive as any deception that is really entertained by the mind of the person buying." *KING & CO., LD. v. GILLARD & CO., LD.*, p. 589.
20. Failure of the Plaintiffs to prove that "Get-up" was solely identified with their goods. Plaintiffs' brand name not taken. Reliance by Plaintiffs on that name in cautions and advertisements.—*"Get-up."*—*Narrow red band round cigars.*—*Common to the trade.*—*Name of brand.*—*Fraud neither alleged nor proved.*—*Judgment for Defendants at trial.*—*Appeal dismissed with costs.* The predecessors of the Plaintiffs, who were cigar manufacturers, in 1888 commenced to sell cigars under the name "*Marcella*," having round them a narrow band of red paper five thirty-seconds of an inch in width, with the name of the brand printed thereon in white. They contended that these cigars were so well known and so much asked for as "narrow red band" cigars, as to entitle them to an injunction restraining the sale by the Defendant of cigars bearing

PASSING-OFF—*continued.*

similar bands three-sixteenths of an inch in width, and sold under the name "Purnella." The Defendant alleged that he had sold "Purnella" cigars since 1882 in large quantities, and other cigars bearing similar bands since 1878, but produced no documentary evidence of orders for or sales of "Purnella" cigars with a narrow red band prior to 1901, when the Plaintiffs first knew of his cigars. Evidence was also given of other long uses of cigar-bands of practically the same width and style. It was held at the trial—(1) that a plain red band for cigars of whatever width was common and open to the trade; (2) that the Defendant's red band was sufficiently distinguished from all other red bands by the name "Purnella"; and (3) that even if the Plaintiffs had used a narrow red band to a greater extent than any other manufacturer, that gave them no exclusive right thereto, and the action was dismissed with costs. The Plaintiffs appealed.—*Held*, by the Court of Appeal, that the Plaintiffs had not established an exclusive right to a narrow red band, and that upon the evidence as a whole the Plaintiffs had failed to satisfy the Court that what the Defendant was doing was calculated or intended to deceive. The appeal was dismissed with costs. IMPERIAL TOBACCO CO. (OF GREAT BRITAIN AND IRELAND), LD. v. PURNELL & CO., pp. 368 and 598.

21. **Action dismissed where only one instance of passing was proved, there being no damage and no intention to repeat the act, and no fraudulent intent.**—*Isolated case by shop assistant proved.*—No damage to Plaintiffs was proved nor any fraud on the part of the Defendants, nor any intention of repeating the act complained of.—Action as to passing-off dismissed with costs. The Plaintiffs, *John Knight & Sons, Ltd.*, soap manufacturers, sold soap known as "*John Knight's Primrose Soap*," and they commenced an action against a Company carrying on business as retail drapers and grocers, for a certain breach of contract in regard to the sale by the Defendants of Primrose Soap, and for passing-off soap not of the Plaintiffs' manufacture as or for soap of the Plaintiffs. The only case of passing-off proved at the trial was that a person sent by the Plaintiffs to the Defendants' shop in reference to the breach of contract, asked for a bar of "*John Knight's Primrose Soap*," and was given a bar of "*Crisp's Imperial Primrose*," with a representation that it was manufactured by the Plaintiffs, which was not the fact; but it was not proved that the assistant making the representation did so with the intention of deceiving, or that he did not make it merely by mistake.—*Held*, that the one instance of passing-off, without any intention to continue doing so or any proof of damage, did not constitute a ground of action. The action so far as founded on passing-off was dismissed, and the Plaintiffs having established a breach of contract, it was agreed that there should be no costs on either side. *JOHN KNIGHT & SONS, LD. v. CRISP & CO., LD.*, p. 671.
22. **Alleged deceptive use of label. Defendants' label found to be earlier in date and not calculated to deceive.**—*Judgment for Defendants.* The Plaintiffs, who were manufacturers of and dealers in toilet paper, brought an action against another Company, manufacturers of and dealers in the same goods, and against a purchaser from them, alleging that the label used by the Defendants was an imitation of the Plaintiffs' label, and that the Defendants were by the

PASSING-OFF—*continued.*

use of such label passing off their goods as those of the Plaintiffs. The Defendants alleged that they and their predecessors in business had used the label complained of before the Plaintiffs had used their label. —*Held*, that the Defendants had used their label continuously from a date prior to that when the Plaintiffs first used their label, and that in any case the Defendants' label was not calculated to deceive. The action was dismissed with costs. COLLEY'S PATENTS, LD. v. BRITISH PATENT PERFORATED PAPER CO., p. 68¹.

23. **Intention to deceive and probability of deception established. Delivery up refused on account of Plaintiffs' delay.**—"Get-up."

—*Cycle repair outfits in tin boxes.*—*Injunction granted.*—*Order for delivery up refused on account of Plaintiffs' delay in taking action.* The Plaintiffs in January 1902 commenced to make and sell materials for the repair of pneumatic tyres packed in tin boxes of a certain colour, shape, and design. They claimed that, until the wrongful acts of the Defendant, such boxes were used exclusively by them. In 1903 the Defendant sold inferior materials for the same purpose in boxes closely resembling those of the Plaintiffs —*Held*—(1) that there was an intention to imitate; (2) that intention to deceive might be inferred from the circumstances of the case although no case of actual deception was proved; (3) that the Defendant's boxes were calculated to deceive. An injunction was granted; but no Order was made for the delivery up of boxes which offended against the injunction because the Plaintiffs had neglected to take action for six months after they became aware of the imitation. COUNTY CHEMICAL CO., LD. v. FRANKENBURG, p. 722.

24. "On the whole, all I need say is that I think the Plaintiffs have not established that the goods themselves, as they are sold by the Defendants, are calculated to deceive merely because those goods are not marked with the Defendants' names as manufacturers, seeing that the get-up of the goods is distinct." Per ROMER, L.J. in NEOSTYLE MANUFACTURING CO., LD. v. ELLAM'S DUPLICATOR CO., p. 575. See above No. 16.

25. **No passing off by the use of the word "Bioscope" established.**

—*Action dismissed.*—*Motion to expunge Trade Mark from the Register.*—*Mark struck off.*—*Invented word.*—*Patents, Designs and Trade Marks Act, 1883, section 64, sub-section 1 (d).* The W. T. Company was incorporated in May 1898, and in August of that year registered as a Trade Mark the word "Bioscope" in connection with their business, which was that of sellers (not manufacturers) of cinematographic apparatus. In September 1903, they commenced an Action against C. U., who had previously been in their service as managing director, in respect of similar apparatus bearing the name "Bioscope," and sold by him, and against a Company promoted by him. The Plaintiffs claimed relief on the grounds of infringement of their Trade Mark, and also of passing off. At the trial of the Action which came on with a motion by the Defendants to rectify the Register, evidence was given of the use of the term "Bioscope," both with and without reference to cinematographic apparatus, for many years prior to the commencement of the Plaintiffs' business; and it further appeared that a machine bearing that name had previously been patented in England. —*Held*, on the Motion, that the word "Bioscope" was not an invented

PASSING-OFF—*continued*.

word within the meaning of sub-section 1 (*d*) of section 64 of the Patents, &c. Acts, and that the Trade Mark must therefore be struck off the Register with costs. And *held*, in the Action: (1) That the Defendant Company had not represented its business to be the business of the Plaintiff Company; (2) that the Defendant's goods had not in fact deceived, and were not calculated to deceive the public into the belief that they were the goods sold by the Plaintiff Company, but that the Defendant's goods were sufficiently distinguished; and (3) that the word "Bioscope" did not denote the Plaintiff Company's goods exclusively, and that they had no monopoly in the word. The action was dismissed with costs. *WARWICK TRADING CO., LD. v. URBAN*, p. 240.

PATENTS, &c. ACT, 1883.

Section 64, sub-section 1—

IN THE MATTER OF BURROUGHS, WELLCOME & CO.'S TRADE MARKS, pp. 69 and 217.

CHRISTY & CO. *v.* TIPPER & SON, pp. 97 and 755.

WARWICK TRADING CO., LD. *v.* URBAN, p. 240.

IN THE MATTER OF ELLIS & CO.'S TRADE MARKS, p. 617.

Section 73—

IN THE MATTER OF THE APPLICATIONS OF BOOTH'S DISTILLERY COMPANY, LD., p. 18.

IN THE MATTER OF ELLIS & CO.'S TRADE MARKS, p. 617.

Section 77A—

IN THE MATTER OF BURROUGHS, WELLCOME & CO.'S TRADE MARKS, p. 69.

Section 90—

IN THE MATTER OF ELLIS & CO.'S TRADE MARKS, p. 617.

Section 92—

IN THE MATTER OF THE TRADE MARK OF J. T. DAVENPORT, LD., p. 726.

PATENTS, &c. ACT, 1888.

Section 10—

CHRISTY & CO. *v.* TIPPER & SON, pp. 97 and 755.

WARWICK TRADING CO., LD. *v.* URBAN, p. 240.

IN THE MATTER OF ELLIS & CO.'S TRADE MARKS, p. 617.

PERSON AGGRIEVED.

The Society of Friends held not to be persons aggrieved by the registration of the word "Quaker" for spirits. **IN THE MATTER OF ELLIS & CO.'S TRADE MARKS**, p. 617.

PRACTICE. *See also* **DELIVERY UP and, as to costs of affidavits, DIGEST OF DESIGN CASES.**

1. Arrangements as to appeal. The Court of first instance cannot extend the time for appealing even by consent of the parties, that being a matter for the Court of Appeal. Any agreement between the parties can only be therefore that an application to the Court of Appeal for the purpose will not be opposed. **FELS v. HODGSON AND SIMPSON**, p. 95.
2. An application that the question whether a word was an invented word should be set down for argument refused, as being a question involving the hearing of evidence. **CHRISTY & CO. v. TIPPER & SON**, p. 97.
3. **Commission.**—A commission abroad for the purpose of obtaining evidence in a passing-off action of advertisements of the Plaintiffs' goods in American journals circulating in this country refused. **CHRISTY & CO. v. TIPPER & SON**, p. 97.
4. Undertaking or injunction by consent. *See* **DIGEST OF PATENT CASES, PRACTICE, No. 2.**
5. In an action in Scotland for passing-off the complainers in the record specified two persons to whom the Respondent had sold his goods under the complainers' trade name. The Respondent in Defence stated that "his invariable answer" to persons asking for goods by that name was that he had goods of his own manufacture, which he was able to supply to them.—*Held* that the complainers were entitled to prove instances beyond the two specified. **PARAZONE CO., LD. v. GIBSON**, p. 317. *See* **PASSING-OFF, No. 12.**
6. Costs of three counsel allowed. **WEINGARTEN BROTHERS v. ROSENTHAL**, p. 216.
7. Inquiry as to damages not ordered, where the Defendant's sales had been small. **BOORD & SON v. HUDDART**, p. 149.

RECTIFICATION OF THE REGISTER. *See also* **ALTERATION OF MARK.**

1. When it is sought to remove from the Register a mark which has been long registered on grounds depending on the proof of facts existing at the date of registration, the Court will give the registered owner the benefit of any doubt. *Chesebrough Manufacturing Company's Trade Mark* (19 R.P.C. 342; L.R. (1902) 2 Ch. 1) followed. **IN THE MATTER OF BURROUGHS, WELLCOME & CO.'S TRADE MARKS**, p. 217.
2. "Tabloid" held to have been properly registered in 1884 as a fancy word. Presumption in favour of mark long registered.—*Fancy word.*—*Motion to expunge Trade Marks from the Register.*—

RECTIFICATION OF THE REGISTER—*continued.*

Motion dismissed.—Appeal dismissed.—Patents, Designs, and Trade Marks Act, 1883, section 64, sub-section 1 (c). In and previously to the month of March 1884 B. W. & Co. were manufacturing and selling compressed drugs in a solid form and of a lenticular or bi-convex shape. In 1884 B. W. & Co. registered the word "Tabloid" in Classes 3 and 42, and in 1885, in the same classes, a device consisting of a frame with the word "Tabloids" inside. They had previously registered and used the word "Tablet" for the same goods. H. S. W. (who was the surviving partner of the firm of and traded as B. W. & Co.) invented the word "Tabloid." B. W. & Co. commenced an action against T. and C. complaining of their selling goods not of the Plaintiffs' manufacture in response to orders and prescriptions for drugs under the designation of "Tabloids," or "Tabloids—B. & W.," or "Tabloids—Burroughs, Wellcome & Co." preceded or followed by the name of the particular drugs required. The Defendants denied any passing off, and, as to the Trade Marks, moved to expunge them from the Register on the ground that "Tabloid" was not a fancy word; that it was descriptive; that it was used by B. W. & Co. in 1884 and onwards to denote the various articles so sold; and further, that it had not acquired an exclusive meaning as denoting the goods of B. W. & Co., but, on the contrary, had acquired a meaning connoting any compressed medicine made up in a bi-convex or similar shape, and denoted as well the goods of other manufacturers as those of B. W. & Co. The Plaintiffs' contention was that "Tabloid" and "Tabloids" were fancy words and that they meant exclusively the goods of B. W. & Co. It was held at the trial that "Tabloid" was a fancy word as applied to the goods for which it was registered, and that the Motion to rectify failed and must be dismissed; and that the Plaintiffs had made out their case and were entitled to an injunction to restrain the Defendants from using the word "Tabloid" or "Tabloids" so as to pass off goods not manufactured by the Plaintiffs as or for the goods of the Plaintiffs. The Defendants appealed from the judgment so far as it dismissed their Motion.—*Held*, by the Court of Appeal, that "Tabloid" was at the date of registration not descriptive, and was a distinctive fancy word not in common use. The appeal was dismissed with costs. When it is sought to remove from the Register a mark which has been long registered on grounds depending on the proof of facts existing at the date of registration, the Court will give the registered owner the benefit of any doubt. *Chesebrough Manufacturing Company's Trade Mark* (19 R.P.C. 342; L.R. (1902) 2 Ch. 1), followed. IN THE MATTER OF BURROUGHS, WELLCOME & CO.'S TRADE MARKS, pp. 69 and 217.

3. "Absorbine" held not to be an invented word for an absorbent veterinary preparation.—*Motion to rectify Register.—Invented word.—"Absorbine."—Mark registered subject to a note on the Register.—Passing-off.—Application before trial for commission to take evidence abroad refused.—Application to set down question of law refused.—Action dismissed.—Mark ordered to be removed from Register.—Appeal dismissed.—Patents, &c. Act, 1883, section 64; Patents, &c. Act, 1888, section 10.* In 1901 Y., carrying on business in the United States, registered the word "Absorbine" as a Trade Mark in Classes 2 and 3, stating in his application that no claim was made to the exclusive use of the word "Absorb," and this disclaimer appeared on the Register. He used the word, which he himself had invented some years before, as the name of a liquid veterinary preparation, of which there were large sales in the United States, and considerable advertisement from 1894 onwards in American papers circulating in this country,

RECTIFICATION OF THE REGISTER—*continued.*

there had also been some sales in the United Kingdom from 1894. In 1901 *C. & Co.*, carrying on business in the United Kingdom, became Y.'s agents. In 1901 *T. & Son*, who had for many years sold an absorbent ointment for veterinary purposes as "Absorbent Ointment," changed the name to "Absorbine," but had not sold under that name until shortly after Y.'s application to register, although catalogues and labels having the new name in them had been prepared before that date. *T. & Son* had acted *bonâ fide*, and they did not know of Y.'s use of the word "Absorbine" until December 1902, when they complained of it, and in 1903 Y. and *C. & Co.* commenced an action against *T. & Son* to restrain them from infringing the Trade Marks and from passing off. *T. & Son* moved to rectify the Register by removing the Trade Marks on the grounds that the word was not an invented word at the date of registration, and was descriptive, and had been used before registration by themselves and others. It appeared that another firm had used the word to some extent before the registration, but they decided not to oppose the registration. Two interlocutory applications were made; one by the Plaintiffs for a commission to the United States to take evidence, especially as to the circulation in England of American papers and magazines in which the Plaintiffs had advertised "Absorbine." This application was granted by *Kekewich, J.*, but the Order for a commission was, on appeal, discharged by the Court of Appeal. The second interlocutory application was by the Defendants to have the question of law separately argued whether "Absorbine" was a registrable word. This Application was refused by *Kekewich, J.* The action and motion to rectify were heard together.—*Held*, that no case of passing-off had been established, and that "Absorbine" whether it was a mis-spelling of "absorbing" or formed by adding the common termination "ine" to "absorb," was not an invented word. The Trade Mark was ordered to be expunged in both classes, and the action was dismissed. The Plaintiffs appealed, but on the hearing of the appeal the question of the validity of the registration was alone argued. The appeal was dismissed with costs. *Eastman Photographic Materials Company's Application* (15 R.P.C. 476; L.R. (1898) A.C. 571), discussed and followed. *CHRISTY & CO. v. TIPPER & SON*, pp. 97 and 755.

4. "Bioscope" held not to be invented word nor a word having no reference to the character of the goods.—*Alleged infringement and passing-off.—Name of article.—Action dismissed.—Motion to expunge Trade Mark from the Register.—Mark struck off.—Invented word.—Patents, Designs and Trade Marks Act, 1883, section 64, subsection 1 (d).* The W. T. Company was incorporated in May 1898, and in August of that year registered as a Trade Mark the word "Bioscope" in connection with their business, which was that of sellers (not manufacturers) of cinematographic apparatus. In September 1903, they commenced an Action against C. U., who had previously been in their service as managing director, in respect of similar apparatus bearing the name "Bioscope," and sold by him, and against a Company promoted by him. The Plaintiffs claimed relief on the grounds of infringement of their Trade Mark, and also of passing-off. At the trial of the Action which came on with a Motion by the Defendants to rectify the Register, evidence was given of the use of the term "Bioscope," both with and without reference to cinematographic apparatus, for many years prior to the commencement of the Plaintiffs' business; and it further appeared that a machine

RECTIFICATION OF THE REGISTER—*continued.*

bearing that name had previously been patented in England.—*Held*, on the Motion, that the word “Bioscope” was not an invented word within the meaning of sub-section 1 (d) of section 64 of the Patents &c. Acts, and that the Trade Mark must therefore be struck off the Register with costs. And *held*, in the Action: (1) That the Defendant Company had not represented its business to be the business of the Plaintiff Company; (2) that the Defendant’s goods had not in fact deceived, and were not calculated to deceive the public into the belief that they were the goods sold by the Plaintiff Company, but that the Defendant’s goods were sufficiently distinguished; and (3) that the word “Bioscope” did not denote the Plaintiff Company’s goods exclusively, and that they had no monopoly in the word. The action was dismissed with costs. *WARWICK TRADING CO., LD. v. URBAN. IN THE MATTER OF TRADE MARK, No. 216,821, p. 240.*

5. **Exclusion of certain goods from those for which the Trade Marks were registered. No intention to use one mark for such excluded goods; the other mark common for excluded goods.—Action for infringement of Trade Marks and for passing-off.—Motion to rectify by exclusion of certain goods.—No intention to use Trade Mark for such goods.—Mark common to the Trade.—Action dismissed.—Order for rectification of Register.** In 1878 a Company registered a Trade Mark, consisting of a figure of a milkmaid with the words “Milkmaid Brand,” in Class 42, for substances used as food or ingredients in food, with the exception of certain goods, not including butter in such exceptions. In 1901 the same Company registered another Trade Mark consisting of a slightly different figure of a milkmaid with the same words for the whole of Class 42. The Company had also other Trade Marks with the figure of a milkmaid in them, but not for butter. Their principal Trade was in condensed milk, and they never traded in butter in the United Kingdom until May 1901, although they had formed the intention of so trading in 1897, and had traded abroad in butter. In 1902 they commenced an action against another Company for infringement of, in particular, the Trade Marks of 1878 and 1901, and for passing-off, and in it complained of the use by the Defendants of coloured posters and handbills having thereon the figure of a milkmaid with the Defendants’ trade name prominently thereon and the words “Milk Blended “Butter”; these posters and handbills were first used in November 1901. The Plaintiffs alleged that they had a reputation in various articles of dairy produce under the brand of a milkmaid, and that the posters were calculated to lead persons to believe that the butter to which they referred was the Plaintiffs’ butter. The Plaintiffs had only a small retail trade in butter, and used only the 1901 Trade Mark, and not that of 1878, in connection with such trade. The Defendants had a very large retail trade in their milk blended butter. They denied infringement and passing-off, and moved to exclude butter from the goods for which the Trade Marks were registered on the grounds that the Plaintiffs had never used or intended to use the 1878 Trade Mark for butter, and that in 1901 a milkmaid was common to the trade. The action and motion were heard together.—*Held*, by *Joyce, J.* (20 R.P.C. 509) that the action failed as to passing-off, and that the Register must be rectified so as to exclude butter from the goods for which the Trade Marks were registered, on the ground, as to the 1878 Trade Mark, that there had been no real intention to use it for butter, and, as to the 1901

RECTIFICATION OF THE REGISTER—*continued.*

Trade Mark, that at the date of its registration the device of a milkmaid was common to the butter trade. The action was dismissed, and an Order made for rectification in the manner mentioned. The Plaintiffs appealed.—*Held*, by the Court of Appeal (affirming *Joyce, J.*) that the action failed as to passing-off and that the Register must be rectified so as to exclude butter from the class of goods for which the Trade Marks were registered on the ground, as to the 1878 Trade Mark, that there had been no real intention to use it for butter, and as to the 1901 Trade Mark that at the date of its registration the device of a milkmaid was in common use in the trade as an ornamentation and indication of goods sold and also as a Trade Mark for butter. The action was dismissed and an Order made for consequential rectification of the Register. *ANGLO-SWISS CONDENSED MILK CO. v. PEARKS, GUNSTON AND TEE, LD. IN THE MATTER OF THE TRADE MARKS NOS. 15,920 and 238,790 OF THE ANGLO-SWISS CONDENSED MILK CO., p. 261.*

6. An invented word must be invented for the purpose of being used as a Trade Mark, and must not be an old word used in a new sense. *Semble*, that it must be coined for the purpose of being registered as a Trade Mark.—*Action for infringement of Trade Mark and for passing-off.—Motion to rectify by striking the Trade Mark off the Register.—Passing-off not established.—Descriptive word.—Invention.—Action dismissed.—Order made for rectification of Register.—Stay refused.* In 1890 *Hommel*, the Plaintiff in the action, first sold in Germany a proprietary medicine which he called "*Hommel's Hæmatogen*" (later "*Hæmatogen prepared by Dr. Hommel*"), the name "*Hæmatogen*" having been suggested to him by a friend in the previous year. The word appeared to have been applied in 1883 to a similar but non-commercial product by a physiological chemist, but this fact was not known to the Plaintiff, although he admitted that prior to 1890 he had heard of the word used (in German) as an adjective but not as a substantive. In 1893 he introduced his product on the English market, since when the sales had rapidly increased without a rival. In 1899 he registered the word "*Hæmatogen*" as a Trade Mark. In 1902 a Hamburg firm commenced to sell a similar product under the name "*Hæmatogen*," and this was introduced on the English market by the Defendants. The Plaintiff commenced an action for infringement of his Trade Mark and for "passing-off," his complaint being confined to the word "*Hæmatogen*" which he alleged meant his preparation only and not extending to the "get-up" of the goods. The Defendants moved to rectify the Register of Trade Marks by striking off the word.—*Held*, on the Motion, that the Trade Mark was not an "invented word" within the meaning of section 64 of the Patents, &c. Act, 1883 to 1888, and must therefore be struck off the Register.—*Held*, in the Action that if there had been actual or attempted "passing-off" it consisted in the use of the word "*Hæmatogen*," and that this word had not acquired such a secondary meaning as the Plaintiff alleged. Action dismissed accordingly. *Cellular Clothing Company v. Maxton and Murray* (16 R.P.C. 397; L.R. (1899) A.C. 326) followed. *HOMMEL v. GEBRÜDER BAUER & CO. IN THE MATTER OF THE TRADE MARK "HÆMATOGEN," p. 576.**

* The decision in this case has since been upheld on appeal.

RECTIFICATION OF THE REGISTER—*continued*.

7. **The Society of Friends held not to be persons aggrieved by the Registration of the word "Quaker" for spirits.**—*"Quaker."*—*Whether a word having reference to the character or quality of the goods, or calculated to deceive or disentitled to protection.*—*Motion to rectify dismissed.*—*Patents, &c. Act, 1888, sections 64 (1) (e), 73, and 90; Patents, &c. Act, 1888, section 10.* A firm of wine merchants having registered the word "Quaker" as a Trade Mark in Class 43 for fermented liquors and spirits, not including whiskey, the Secretary of the Society of Friends applied by Motion to rectify the Register by the removal of the Trade Mark on the grounds that it was not entitled to protection in the Court or Registry, and was scandalous and liable to deceive, or had reference to the character or quality of the goods. There is no rule of total abstinence in the Society of Friends.—*Held*, that no damage in a legal sense could accrue to the Society of Friends, or that portion of its members who are total abstainers, from the use of the Trade Mark, and that they were not persons aggrieved; also that the word had no reference to the character or quality of the goods, and was not calculated to deceive or disentitled to protection. The Motion was dismissed with costs. **IN THE MATTER OF ELLIS & CO.'S TRADE MARKS**, p. 617.
8. **Mark, consisting of "Macfarlane & Co." as a signature, removed on the admission of Respondents' counsel that it could not be supported as it was not at the date of registration the signature of an existing firm.** **MACMILLAN v. EHRMANN BROTHERS, LD.**, p. 357. *See* **TRADE NAME**.
9. **Order to rectify made on Respondents' admission. No costs of evidence allowed as no affidavits had been filed and no *viva voce* evidence given on the motion.** **MACMILLAN v. EHRMANN BROTHERS, LD.**, p. 368.
10. **Stay of order of rectification pending an appeal refused.** **HOMMEL v. GEBRÜDER BAUER & CO.**, p. 576.

"REGISTERED." *See* **INFRINGEMENT, No. 2; PASSING-OFF, No. 15; REGISTRATION, No. 2.**

REGISTRATION.

1. **Comptroller's discretion. Right of Comptroller to have regard to previous refusals of similar marks. "Jock Scott" too near to "Scotch Jock."**—*Application to register.*—*Mark calculated to deceive.*—*Mark similar to marks which had been already refused registration.*—*Appeal by Applicants from Comptroller dismissed.*—*Patents, &c. Act, 1888, section 73.* A Company sought to register two marks as Trade Marks in Class 43, both having the device of a salmon fly, one of them having the words "Salmon Fly Brand" and the other having also the words "Jock Scott Salmon Fly." The Comptroller refused to register the marks on the ground of similarity to a mark consisting of the words "Scotch Jock" and also on the ground that other marks of a similar nature had already been refused. The Applicants appealed, and the appeal was referred to the Court. At the hearing the owners of the "Scotch Jock" mark opposed, and there was

REGISTRATION—*continued.*

evidence of use since 1896 of one of the marks of which registration had previously been refused. The Applicants had made no inquiries as to these marks, although invited to do so by the Comptroller.—*Held*, that the use of the words "Jock Scott" would be calculated to deceive, and as to the other mark that the Comptroller had exercised his discretion properly, and that it ought not to be overruled. The appeal was dismissed with costs. IN THE MATTER OF THE APPLICATIONS OF BOOTH'S DISTILLERY CO., LD., p. 18.

2. Comptroller ordered to proceed with an application for registration, notwithstanding mistaken use of the words "Registered Trade Mark" before application.—*Application for registration of word.—Previous use of word coupled with "Registered Trade Mark."*—*Comptroller's refusal to register.—Appeal.—Bonâ fide mistake proved on appeal.—Decision of Comptroller reversed and application ordered to be proceeded with.* IN THE MATTER OF ALTMAN'S APPLICATION FOR A TRADE MARK, p. 753.

SERVANT (ACTS OF).

Whether master responsible for acts of servant. See PASSING-OFF, No. 10; INFRINGEMENT, No. 3.

STAY. See RECTIFICATION OF THE REGISTER, No. 10.

TRADE NAME.

Action to restrain use of a name that was not either Plaintiffs' or Defendants' own name.—*No intent to deceive or actual deception or probability of deception proved.—Action dismissed.—Appeal dismissed.* A firm of *Macfarlane & Co.* (sometimes with various initials) traded as whisky distillers and merchants at Paisley from 1740 till 1897; they had a good local reputation. The then continuing member of the firm, *J. Macfarlane*, assigned the goodwill of the business to *Foulds & Co., Ltd.* The Plaintiffs were four of the directors of *Foulds & Co., Ltd.* It was agreed that the business should be assigned by *Foulds & Co., Ltd.*, to the Plaintiffs, but that assignment was not actually executed till after action brought. *Foulds & Co., Ltd.*, remained the real owners of and carried on the business under the style of *Macfarlane & Co.* In the year 1897 *Ehrmann Bros.*, the predecessors in business of the Defendants, began to use the name "*Macfarlane*," or "*Macfarlane & Co.*," to denote a brand of whisky sold by them. They adopted the name at the suggestion of a gentleman named *Macfarlane*, who was associated with them in their business of dealers in wines and spirits. They registered the signature of "*Macfarlane & Co.*" as their Trade Mark. During the year 1899 the trade, nominally carried on by the Plaintiffs, was extended to England. The Plaintiffs, when the respective trades of the parties came into collision, brought this action to restrain the Defendants from using the name "*Macfarlane & Co.*," so as to represent their whisky as that of the Plaintiffs. At the trial it was *held* that the Plaintiffs had failed to prove that the Defendants' acts had

TRADE NAME—*continued*.

intercepted or were calculated to intercept the Plaintiffs' trade. The action was dismissed with costs. The Plaintiffs appealed. The appeal was dismissed with costs, the judgment below being upheld on all points. *MACMILLAN AND OTHERS v. EHRLMANN BROTHERS, LD.*, pp. 357 and 647.

TRAP ORDERS.

Observations on the importance to be attached to trap orders. *BURROUGHS, WELLCOME & CO. v. THOMPSON AND CAPPER*, p. 84.

USE AS A TRADE MARK. *See* INFRINGEMENT, No. 3.

WORD HAVING NO REFERENCE TO THE CHARACTER OR QUALITY OF THE GOODS.

1. "Quaker" held to be such a word for fermented liquors and spirits. *IN THE MATTER OF ELLIS & Co.'s TRADE MARKS*, p. 617. *See* RECTIFICATION, No. 7.
 2. "Bioscope" held not to be such a word for cinematographic apparatus at the date of registration. *WARWICK TRADING CO., LD. v. URBAN*, p. 240. *See* RECTIFICATION, No. 4.
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(NAME AND SUBJECT-MATTER.)

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OF

PATENT, DESIGN, AND TRADE MARK CASES.

EDITOR : JOHN CUTLER, ONE OF HIS MAJESTY'S COUNSEL.
ASSISTANT EDITOR : FRANK G. UNDERHAY, BARRISTER AT LAW.

Vol. XXI] WEDNESDAY, JANUARY 13, 1904. [No. 1.

IN THE COURT OF SESSION IN SCOTLAND (OUTER HOUSE).

Before The Lord Ordinary, LORD LOW.

January 9th, February 17th, March 17th, June 20th, and July 22nd, 1903.

NEW CONVEYOR COMPANY, LD. v. EDINBURGH AND LEITH GAS
COMMISSIONERS.

5

Action for infringement of Patent.—Specification admittedly bad.—Application by Pursuers for liberty to apply at the Patent Office for leave to amend Specification by way of disclaimer and to sist procedure in the meantime.—Application refused.—Action dismissed.—Patents, &c. Act, 1883, section 19.

- 10 *The N. C. Co., who were the owners of Letters Patent for improvements in charging inclined gas retorts, raised an action against the Edinburgh Gas Commissioners for infringement of the same. After the pleadings had been closed and a proof allowed, the N. C. Co. admitted that the Specification was bad, and that, if its defects were cured, the Summons would have to be correspondingly amended, and, under the 19th section of the Patents Act, 1883, moved for an Order authorising them to apply at the Patent Office for leave to amend their Specification by way of disclaimer, and to sist procedure in the action until such application had been disposed of by the Patent Office. The motion was refused, and the action thrown out.*
- 15 *Observed, per Lord Ordinary, that the granting of an Order under the said section was entirely a matter of discretion for the Court.*
- 20

New Conveyor Company, Ltd. v. Edinburgh and Leith Gas Commissioners.

The Pursuers in this action, which was signetted on the 9th of January 1903, the *New Conveyor Company, Ltd.*, having its registered office at Smethwick, Birmingham, were the owners of Letters Patent No. 20,709 of 1892, which were granted to *Ludovico Van Vestraut* and *Maurice Graham* for "Improvements 5
"in charging inclined gas retorts." In the Complete Specification the invention was described as follows:—"Over the bed or bench of the retorts is fixed a
"hopper which may be erected over one bed in a requisite place, or may be
"erected over the full length of the beds or bench of settings of retorts and
"overhead and above the charging mouthpieces. This hopper contains the
"supply of coal required for charging or feeding the several retorts, the coal 10
"being first broken and then lifted by machinery and deposited in the said
"hopper or bunker. At the bottom of the same are one or more valves,
"doors or slides of suitable pattern. Division plates are fixed inside to form
"compartments if necessary, and also, to strengthen and be a support to the side
"of the hopper, necessary stays are fixed which are used for supporting the 15
"conveyors and other machinery for filling the hopper. Upon the bottom
"of these large or main hoppers are fixed either permanent or moveable
"secondary hoppers or chambers which act as measuring chambers. At the
"top and bottom of these hoppers or chambers are slides or valves of a suitable
"pattern, which are moved and worked by means of a lever or levers 20
"preferably fixed, so that when the top slide is opened the bottom is shut and
"*vice versa*. The object of the bottom slide is to prevent the coal falling down
"the shoot before the chamber is filled and ready for charging, the object
"of the top is to prevent the coal falling into the chamber from above
"during the operation of charging and so increasing the already measured 25
"charge." The Pursuers claimed *inter alia* as the invention:—"The fixed
"measuring hoppers or chambers with top and bottom doors or slides or valves
"as shown of any required construction to suit the purpose in conjunction with
"the action of the levers, so that when one is shut the other is open, and *vice*
"*versa*, substantially as described in the Specification and according to the 30
"accompanying drawings." The value of the patent shot pouch contained in
the said Patent consisted in the fact that by a lever acting in a very simple
manner one man could charge a retort in a few seconds, an operation which
apart from the invention would take him a much greater period of time. The
invention also prevented the loss of gas during the period of charging retorts. 35
It was therefore, according to the Pursuers, of great commercial value to them.

The Defenders were the *Edinburgh and Leith Corporations Gas Commissioners*, incorporated by Act of Parliament. They had recently erected large gasworks at Granton, near Edinburgh, in which they employed charging apparatus of a style and character to which the Pursuers alleged they had sole right. 40
This the Pursuers said was an infringement of their Patent and they asked for 2500*l.* damages, for interdict against further infringement, and for expenses. The Defenders admitted that in fitting up their works they had made use of the latest and most useful contrivances and designs in the installation of machinery and retorts, but denied that they had infringed any existing Patent. The specifications and the detailed drawings for all the plant supplied were prepared by 45
the Defenders' chief engineer, *Walter Ralph Herring*, from what was common knowledge amongst gas engineers, or of his own special design. They averred that the alleged Patent was not valid or effectual in respect that neither the said *Ludovico Van Vestraut* and *Maurice Graham*, nor either of them, were 50
the true and first inventors of the alleged invention described therein. The first and true inventors were *Frank Morris* and *James Husband*, the engineer and assistant engineer of the *Brentford Gas Company*, who in the year 1889 first charged a 20-feet inclined retort at Southall experimentally, and in the years 1890 and 1891 invented at the Brentford Works of the said Company the said 55
apparatus for charging inclined gas retorts upon the principle of automatic charging with the storage hopper and measuring chamber combined, known as

New Conveyor Company, Ltd. v. Edinburgh and Leith Gas Commissioners.

the "Shotpouch" system. An invention and apparatus similar to or substantially the same as that described and claimed in the Specification of the Pursuers' Patent was disclosed and published within the United Kingdom prior to the date of the Patent by the manufacture by the *Thames Ironworks Company* from drawings and designs by the said *Frank Morris* and *James Husband*, supplied to the said Company in the year 1890, of apparatus for charging inclined gas retorts identical with those claimed in the said Patent and by the erection and user by the *Brentford Gas Company* of the said apparatus at their Brentford Works in and since the year 1891. Detailed drawings of the said installation at Brentford were published by being sent to the *Automatic Coal Gas Retort Company* in January 1892, containing full details of all the said alleged inventions claimed in the Pursuers' Patent and relative Specifications. Detailed specifications, and drawings showing continuous hoppers, measuring chambers, and overhead coal conveyors for supplying inclined retorts as described in Pursuers' Patent were also disclosed and published in May and June 1892 by *West's Gas Improvement Company, Ltd.*, of Manchester, in tendering for the installation of inclined retorts.

The Pursuers admitted that an apparatus for charging inclined gas retorts identical with those claimed by their Patents had been installed at the Brentford Gasworks, but averred that this was done after the Patent was taken out, and that the apparatus was erected by arrangement between *Vestraut*, one of the inventors, and the *Brentford Gas Company*, in whose employment *Vestraut* then was. *Vestraut* was the joint inventor along with *Frank Morris* of Patent No. 16,489 of 1889. This he assigned, along with any and every improvement that he or they might make thereon, to the *Automatic Coal Gas Retort Company, Ltd.* The present Patent was one of the said improvements, and therefore as soon as it was taken out belonged to the *Automatic Coal Gas Retort Company, Ltd.*, in virtue of the said agreement. The rights of that Company were transferred to the Pursuers.

The Defenders averred that the alleged invention was not new at the date of the Patent. Inventions or contrivances similar to or substantially the same as the alleged invention were described and disclosed and published within the United Kingdom prior to said date, and particularly in the Specifications and drawings of the following Patents, all dated prior to the Patent founded on by the Pursuers:—(1) Patent No. 2473 of 1861, granted to *William Malam* for "Improvements in apparatus for the manufacture of gas"; (2) Patent No. 4576 of 1877, granted to *Matthew Hilton* for "Improvements in the manufacture of gas"; (3) Patent No. 4874 of 1883, granted to *John Woodward* and *William Foulis* for "Improvements of retort charging and drawing machines, and in the apparatus or means for delivering coal to the scoops of such charging machines"; (4) Patent No. 7563 of 1885, granted to *Alexander Melville Clark* for "Improvements in retorts for the distillation of coal and other solid matters and in apparatus connected therewith"; (5) Patent No. 16,489 of 1889, granted to *Frank Morris* and *Ludovico Van Vestraut* for "Improvements in apparatus for charging inclined gas retorts"; (6) Patent No. 16,213 of 1890, granted to *Andre Coze* for "Improvements in apparatus for charging inclined gas retorts"; (7) Patent No. 18,230 of 1890, granted to *Ludovico Van Vestraut* and *Maurice Graham* for "Improvements in the construction of shoots for charging inclined gas retorts"; (8) Patent No. 20,030 of 1890, granted to *Ludovico Van Vestraut* for "Improvements in apparatus for charging inclined gas retorts"; (9) Patent No. 9318 of 1891, granted to *Alfred Julius Boulton* for "Improvements in apparatus for charging retorts"; (10) Patent No. 10,902 of 1891, granted to *James Francis Braidwood* for "Improvements in apparatus for charging retorts for the manufacture of gas and for other like purposes"; (11) Patent No. 12,572 of 1891, granted to *George Ernest Stevenson* for "Improvements in apparatus for charging inclined gas retorts"; (12) Patent No. 21,249 of 1891, granted to *Edward Drory* for

New Conveyor Company, Ltd. v. Edinburgh and Leith Gas Commissioners.

"Improvements in apparatus for charging inclined retorts for use in the manufacture of coal gas and for similar purposes."

The Defenders therefore averred that at the date of the said Patent the alleged invention was part of the stock of the public general knowledge, and the alleged invention was not new as to the public use and exercise thereof in the United Kingdom. The principles thereof were matters of common general knowledge and common general use amongst manufacturers of gas retorts and gas engineers, and were in common use in all works where materials had to be raised from a lower to a higher level and distributed by gravity. Apparatus similar to or substantially the same as that described and claimed by the Patent had been for years past and was presently in use in the following gasworks within the United Kingdom, viz.:—The *Gas Light and Coke Company's* Gasworks, London; the City Gasworks, Saltley, Birmingham; the Gaythorn Gasworks, Manchester; the *Oxford Gas Company's* Gasworks, Oxford; the Brighthouse Gasworks, Brighthouse; the Londonderry Gasworks, Londonderry; the Brentford Gasworks, Brentford and Southall; and in the Defenders' gasworks at New Street, Edinburgh. In the case of no one of these installations of inclined retorts was any licence issued by Pursuers or their authors, or royalty claimed by or paid to them in respect of the use of the apparatus described in their Patent. Subsequent to the installation of inclined retorts at the Brighthouse Gasworks the Pursuers, in the year 1900, raised an action against the *Mayor and Aldermen and Burgesses of Brighthouse* for an injunction restraining the Defendants from infringing the Patent and for damages. Before proof the Plaintiffs, however, withdrew their action on payment of the Defendants' full costs.

The Pursuers explained in their pleadings that they had commenced this action under a misapprehension, and that it was discovered before the case came on for hearing that the Brighthouse Corporation had not used the Pursuers' Patent as they supposed, but had substituted for it travelling loaded charging shoots. In consequence of this discovery the Pursuers withdrew their action. They admitted that the apparatus claimed in their Patent was at present in use in some at least of the above-mentioned gasworks, but averred it had been installed in all these cases after the Patent was taken out.

The Defenders also averred that the alleged invention as set forth in the Complete Specification of the Patent founded on was larger than and different from that disclosed and referred to in the Provisional Specification thereof. Further, the Complete Specification was not intelligible and did not describe with sufficient clearness the nature of the said invention, nor the manner in which the same was to be performed. Further, the Patentees did not sufficiently distinguish between what was old or was in use and known at and prior to the date of the Patent, and what they alleged to be new and claimed to be the invention. Further, they claimed as new what was old and well known at the date of the Patent. The alleged invention as to all the claims of the Complete Specification was not good subject-matter of a grant of Letters Patent within the meaning of the Patent Acts.

On the 17th of February 1903 Defences and a Statement of Fact for the Defenders were lodged. The Lord Ordinary, Lord KINCAIRNEY for Lord LOW, allowed the Pursuers to answer the Defenders' Statement of Facts by the 27th of February, and continued the Adjustment of Record till the 3rd of March, and the Record was closed on the 17th of March 1903, both parties being allowed a proof of their respective averments and the Pursuers a conjunct probation, to proceed on a day to be afterwards fixed.

On the 20th of June 1903, Counsel for the Pursuers, *Craigie* (instructed by *Laing and Harley, W.S.*) moved for an Order in terms of the 19th section of the Patents, &c., Act, 1883, authorising them to apply at the Patent Office for leave to amend their Specification by way of disclaimer and to sist procedure in the meantime. It was admitted that the Specification as it stood was bad.

New Conveyor Company, Ltd. v. Edinburgh and Leith Gas Commissioners.

J. D. Millar (instructed by *James McG. Jack*, S.S.C.) opposed the motion. Lord Low took the case to *avizandum*.

The motion was on the 22nd of July 1903 refused, and the action was dismissed by the Lord Ordinary, the Pursuers being found liable in expenses.

- 5 Lord Low.—In asking for authority to apply for leave to amend their Specification, the Pursuers admit that they cannot maintain the present action upon the Specification as it stands. If the Specification was amended it is probable that the Pursuers would require to ask leave to amend the Summons and the Record ; and, further, it is difficult to see how the Pursuers could in
10 any action upon the amended Patent insist in their claim of damages for alleged infringement of the Patent as it now stands.

- Under the Patents Act, 1883, it is entirely within the discretion of the Court whether leave to apply for an amendment of a Specification by way of a disclaimer should or should not be granted ; and it is provided that, if it is
15 granted, it shall be “subject to such terms as to costs and otherwise as the “Court may impose.” Now as the reason for which the Pursuers ask for an Order for leave to apply for an amendment of the Specification is that they are satisfied that they cannot succeed in the action as laid, it seems to me that the Order could only be granted upon the condition that the Pursuers should pay
20 to the Defenders the whole expenses already incurred by them.

- The question therefore arises, whether there is any sufficient reason for keeping this action in Court ? The only reason for doing so would be that the Pursuers might be thereby saved the cost of bringing a new Summons. But the Pursuers’ Counsel did not dispute that the probable result of the proposed
25 disclaimer, if allowed by the Patent Office, would be that, before the question of infringement could be tried in this action, it would be necessary to amend the Summons. It does not follow, however, that the necessary amendment would be competent, and that is a question which has not yet arisen, and upon which I have no means of forming an opinion.

- 30 In these circumstances it seems to me that it would not be fair to the Defenders to keep this action hanging over them on the chance that the Pursuers might obtain leave to amend the Specification, and might also be found entitled so to amend the pleadings as to make them available for the trial of the question of infringement of the amended Patent. I therefore think that the proper course
35 to follow is to dismiss the action, leaving it open to the Pursuers in the event of the Specification being amended to bring a new action.
-

Fuller v. Handy.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BYRNE.

October 28th and November 2nd, 1903.

FULLER v. HANDY.

Patent.—Action for infringement.—Want of novelty.—Alleged prior publica- 5
tion and prior user.—Subject-matter.—Infringement.—Patent held invalid.—
Judgment for Defendant.

The owner of Letters Patent for "Means or apparatus for effecting the
"simulation of flames of fire for spectacular purposes" having commenced an
action for infringement, the Defendant denied infringement, and alleged that 10
the Patent was invalid on the grounds of prior publication, prior user, and
want of subject-matter. The first claim of the Specification was: "In stage
"appliances, an open-work base, streamers attached to the said base, and means
"for directing currents of air to the base and for illuminating streamers
"through the base." 15

Held, that the alleged invention was not disclosed as a whole in the prior
Specifications alleged as anticipations, but that prior user was established, and
that at all events there was, in view of the common knowledge of the art, no
subject-matter; and that the Defendant, not using streamers, had not infringed.
The action was dismissed with costs. 20

On the 24th of November 1899 Letters Patent (No. 23,473 of 1899) was granted to *Ida May Fuller* for an invention of "Means or apparatus for effecting the "simulation of flames of fire for spectacular purposes."

The Complete Specification was as follows:—"The object of the invention is to provide means whereby the effect of a fierce fire may be produced upon a 25 "stage, or elsewhere without the possibility of injury to the surroundings or "to any person appearing to be in the midst of the flames and apparently "handling the tongues of fire or moving in close proximity thereto.

"Another object of the invention is to provide means whereby the colouring "of the illusory flames may be quickly and conveniently changed at will during 30 "an act without the colour-changing medium being visible from any portion of "the auditorium, including the galleries, although the portion of the stage at "which the display is made may be visible to all of the audience.

"Another object of the invention is to provide a smoke effect through the "same medium employed to furnish the representation of flames, and, further- 35 "more, to provide an illusion representing individual tongues of flames, any

Fuller v. Handy.

"one of which tongues may be separated from its fellows and when released will automatically return to an upright position and again form a part of the volume of illusory fire.

5 "The invention consists in the novel construction of the several parts, as will be hereinafter fully set forth, and pointed out in the claims.

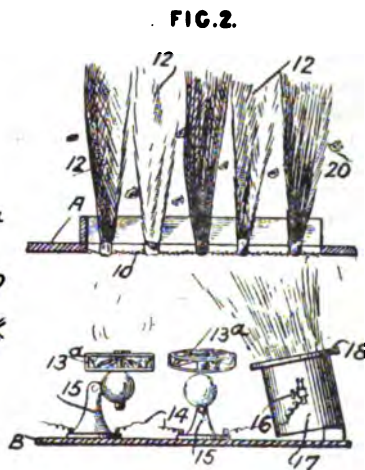
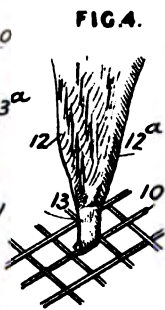
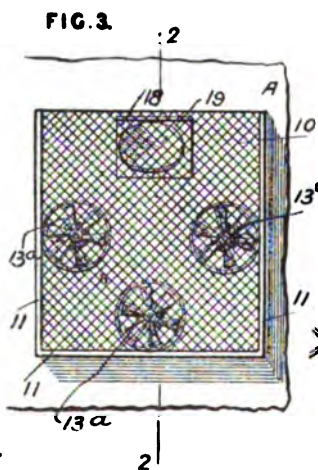
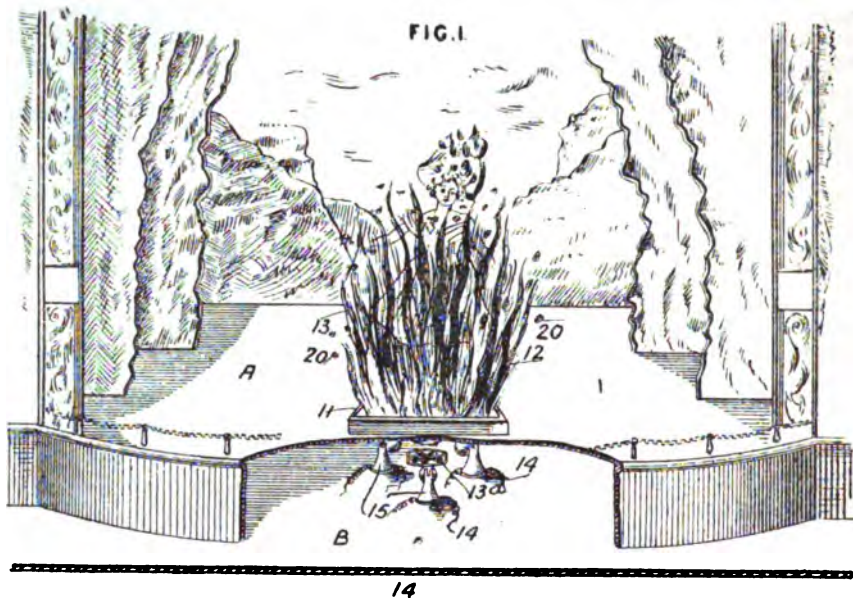
"Reference is to be had to the accompanying drawings, forming a part of this Specification, in which similar characters of reference indicate corresponding parts in all the figures. Figure 1 is a perspective view of a stage, parts being broken away, illustrating the application of the appliance. Figure 2 is 10 "a vertical section through that portion of the stage at which the illusory fire is produced, showing the streamers employed in upright position, also illustrating a portion of the apparatus employed for illuminating the streamers and maintaining them upright. Figure 3 is a plan view of that portion of the stage at which the illusory fire is produced, the streamers being removed ; 15 "and Figure 4 is a detail view illustrating the manner in which the streamers are attached to their supports. A represents the stage-floor, and B a platform or floor beneath the stage, a suitable space intervening between the two. The stage A is provided with an opening, at which opening a gridiron or screen 10 is secured, serving as a partial cover for said opening. This gridiron or screen 20 "is preferably made of wire, the wire and meshes being coarse, and preferably a shield in the shape of a vertical flange 11 is placed at the front and sides of the opening in the stage-floor at which the gridiron or screen 10 is located. Strips 12 of a translucent or a transparent fabric are employed, the said strips being preferably tapering, although they may be given any desired shape, and these 25 "strips have loops 13 formed at their lower ends, which loops receive the wires of the gridiron or screen 10 as shown in Figure 2. These strips 12 are of a color approximating the color of a flame—as for example, they may be of a dark-red color, a light red, or a salmon color, or may be of any intermediate shade—and, if desired some of the strips may be colored differently from the 30 "others or be of various shades. These strips are entirely free above the point to which they are attached and are capable of waving, fluttering, or curling when subjected to a suitably-directed blast of air. This blast of air is produced through the medium of fans 13^a of any desired character : but the fans usually employed are electrically operated. The fans are shown as three in number 35 "although a greater or a less number may be employed. These fans are arranged in a single group, and their axes are inclined towards each other. The centre of this space is practically in vertical alignment with the central portion of the gridiron or screen 10, to which the streamers or strips 12 are secured. The fans are mounted upon a suitable base 15 being pivotally connected with the base, 40 "so that the position of the fans may be changed as may be found necessary to direct the streamers 12 in a proper direction. For example, the position of the fans may be changed so that the volume of the streamers may be carried to one side or the other or to the front or to the rear, or the fans may be so adjusted that the streamers will be given a vertical position.

45 "In the drawings the electric fans are shown as supplied with electricity through the medium of suitably-connected wires 14, leading from any source of electric supply. I desire it to be understood that the streamers 12 are placed sufficiently close together to collectively form a column or volume of strips when the strips are under the influence of the air-supply ; but the spaces 50 "between the said strips are sufficiently great to permit each individual strip to wave independently in front of or at the back or side of an adjacent strip.

"The illusion of fire is produced by directing rays of light upward through the screen or gridiron and upon and through the mass of waving strips 12. This light is usually supplied through the medium of an arc light, the connections 16 whereof only are shown in the drawings, and this lamp is located 55 "within a casing 17, placed below the stage and below the gridiron or screen 10, the said casing, whose inner face is preferably a reflecting surface, being

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"inclined in a manner to direct the light to the central portion of the screen or gridiron 10. Various colors or shades of color may be imparted to the light supplied to the strips or streamers, thus indicating the changes of colors in a leaping flame, and this change of colors is obtained by passing a frame 18 over the top of the casing 17 of a light, which frame contains a transparent 5 suitably colored pane 19 of glass, gelatine, or a similar material.



"While guides are provided for the colored screens 18, I prefer to operate these screens by hand, simply passing them to and fro over the top of the casing 17 of the light. Under this arrangement an operator may hold a screen of one color in one hand, and a screen of another color in the other hand and alternately pass them over the light or carry the two in the path of the light whenever desired, and in this manner changes may be more rapidly made than when guides are provided for these color-screens.

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"I produce a smoke effect preferably to either darkly coloring the edges of sundry of the strips 12, as shown at 12^a in Figure 4, or by attaching to the longitudinal edges of sundry of the main strips 12 a strip of very dark smoke or slate color, and usually these additional strips are applied to the outermost strips 12 of the series, as is likewise the additional coloring when employed.

"The effect of sparks is obtained by introducing small bits of paper, cardboard, or the like 20, suitably colored, between the currents of air and the screen or gridiron, whereupon the said currents of air will carry these small pieces of colored material up through the meshes of the gridiron, and as soon as they are freed from the influence of the air-blast the said pieces will fall to the stage, where their smooth surfaces and glittering color will continue to sparkle when the light is turned on or changed on the screen or gridiron. The whole effect described is preferably produced when the room or apartment is darkened to a greater or a less degree."

The Patentee claimed:—"(1) In stage appliances, an open-work base, streamers attached to said base, and means for directing currents of air to the base and for illuminating streamers through the base. (2) In stage appliances, a foraminated structure, streamers connected thereto, fans beneath the foraminated structure, arranged to concentrate air-currents thereon and an illuminating device the delivery whereof is directed to the aforesaid foraminated structure. (3) In stage appliances, a foraminated structure, streamers connected at one end to the said structure, fans grouped beneath the foraminated structure, having their axes inclined in direction of each other and the centre of said structure, supports on which the fans are adjustably mounted, a reflector inclined in direction of the central portion of the foraminated structure, and a light within the said reflector. (4) In stage appliances, a foraminated structure, streamers connected at one end to the said structure, fans grouped beneath the foraminated structure, said fans being in circular arrangement and having their axes inclined in direction of each other and the centre of said structure, supports upon which the fans are adjustably mounted, a reflector inclined in direction of the central portion of the foraminated structure, a light within the said reflector, and colored screens adapted to be passed over the said reflector, enabling the light directed to the streamers to be changed in color or shade at the will of the operator."

On the 8th of May 1902 *Ida May Fuller* commenced an action against *Emilie Diana Handy* for infringement of the Patent, claiming the usual relief.

The Plaintiff by her Statement of Claim alleged that she was the registered legal owner of the Patent, and that the Defendant had infringed the same.

The Particulars of Breaches alleged—(1) that the Defendant had since the date of the Patent, and prior to the issue of the writ in the action, used and continued to use, for the purpose of effecting simulation of flames of fire, certain stage appliances and apparatus constructed substantially as described in the Complete Specification of the Patent and claimed in all the claiming clauses thereof; (2) that in particular the Plaintiff complained that the Defendant in a public performance given by her on the 6th and 7th of May 1902, at the Empire Theatre at Stratford, in the county of Essex, did use for the simulation of flames of fire, stage appliances and apparatus constructed in infringement of the Plaintiff's Patent as aforesaid.

The Defendant by her Defence did not admit the Plaintiff's title to the Patent, denied infringement, and alleged the invalidity of the Patent.

The Particulars of Objections, as amended, alleged as follows:—(1) that the alleged invention claimed in all the claiming clauses of the final Specification of the Patent was not new by reason of its having been published in the realm prior to the date of the Patent by the deposit in the Patent Office Library of the Specifications of the following Letters Patent:—(a) *Lake* (No. 10,301 of 1893); (b) *Plunkett* (No. 24,807 of 1893); and (c) *Vernici* (No. 19,472 of 1897); the

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whole of each of the said Specifications was relied upon; (2) that the alleged invention was not new by reason of its having been used in the realm prior to the date of the said Letters Patent by (a) Mr. *Harry Wieland*, of 1, Cranbourne Street, Leicester Square, in the county of London, who exhibited publicly at the times and places thereafter set out an apparatus for the imitation of flames, sparks, and smoke obtained by means of fans, prepared paper, transparent silk and steam, the said apparatus being constructed and arranged substantially as described by the Plaintiff's Patent and claimed in all the claiming clauses thereof; that the said public user took place at certain places in the Particulars of Objections mentioned; (b) the common general practice of attaching ribbons or streamers to a grating or frame behind or within which a fan or fans were working, and by the common general employment of beams of light projected upward through the platform or stage for producing theatrical effects; (3) that the alleged invention as to all the claiming clauses of the Specification of the Plaintiff's Patent was not the proper subject-matter for valid Letters Patent. Under this head the Defendant would refer to the prior users and common general practice set out in paragraph 1 thereof.

The Defendant's apparatus will be found described in the judgment.

A. J. Walter (instructed by *Gresham, Davies, and Dallas*) appeared for the Plaintiff; *J. H. Gray* (instructed by *Harry Wilson & Co.*) appeared for the Defendant.

Walter opened the Plaintiff's case.—The Patent relates to the imitation of fire on the stage. The Defences raised are want of novelty, by reason of prior publication and prior user, want of subject-matter, and non-infringement. [*Gray* stated that he relied on all as substantial Defences.] [The Specification was read.] Claim 1 is a broad claim for a combination of the four elements mentioned in it. Claims 2 and 3 are for more special combinations. In Claim 4 the fans are inclined so as to produce one whirlwind. The patented invention has been used in "Dante" and at the Alhambra; it enabled effects to be produced which were impossible previously, and that without danger in any way. The effect on more than one occasion has been so realistic that the audience has thought there was actually a fire. The apparatus complained of as an infringement was without any distinction from the Plaintiff's.

The Plaintiff's evidence taken on commission was read, and the following witnesses were called, namely—Messrs. *W. Clark*, patent agent; *John Bretherton*, electrical and mechanical engineer at the Theatre Royal, Drury Lane; and *J. Webber*, electrical engineer.

Gray opened the Defendant's case.—There was no subject-matter for the invention claimed in view of the state of the art. If a broad construction is not put on the claims, then there is no infringement. The state of the art is shown by a book called "Magic," in which a fire dance is described with a flame and smoke effect, and where all the Plaintiff's elements are present except the waving to and fro by currents of air. If streamers are essential to the Plaintiff's invention, then the Defendant did not use them, and there was no infringement. The Patentee only aimed at getting a particular flame effect, for which separate strips of material were essential, and the Defendant had neither streamers nor strips. But if they are not essential, then all the other kinds of flame effect are included in the claim, and on the previous knowledge the Patent is invalid. Evidence of prior user of the invention will be given.

The following gave evidence for the Defendant, namely—Messrs. *A. W. Handy*, the Defendant's husband; *H. W. Wieland*, *Atfred Butt*, *Arthur Lloyd*, and *Thomas Jennings*.

Gray summed up the Defendant's case.—The prior user was of substantially the whole of the alleged invention. *Wieland* had (1) the drapery on the performer formed in parts into streamers; (2) the lights from below; and (3) the currents of air; and the realistic effect of flames was produced. The only difference is that the streamers were attached to the performer. That the effect

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of a lantern slide was sometimes tried in addition does not matter; even if it were never dispensed with, the claim would cover a case in which a lantern was used as an addition. But quite apart from the prior user and *Plunkett's* Specification, there was in view of the state of the art no subject-matter. The only details introduced by the Patentee were the currents of air and perhaps streamers. *Plunkett* had currents of air, and precludes the idea of any novelty. The Patentee's elements do not necessarily give a flame effect; it all depends how they are used. Further, the Defendant did not use any streamers or strips, and did not infringe.

10 *Walter* in reply.—As to the construction of the Specification, Claim 1 is for a combination of four elements, the other claims being more detailed and narrower. The Defendant had all the four elements, for the serrated edges of the fabric and the heavy pleating of it were equivalent to the streamers. As to the alleged prior user, no flame effect was produced except by the use of the magic lantern, and no open-work base was used. In fact, what was used was not the patented appliance, and no effect was produced except the old fire dance. The prior Specifications were not anticipations. There was no air and no open-work base. The combination of the Plaintiff was a new one for producing the appearance of flames of fire.

20 Judgment was reserved, and was delivered on the 2nd of November 1903.

BYRNE, J.—This is an action restraining an alleged infringement of Letters Patent No. 23,473 of 1899. The Defences relied on are—want of novelty by reason of publication of prior Specifications and anticipations; and, secondly, prior user: then want of subject-matter in view of the state of the art at the date of the Patent is also relied upon, wherefore there is no invention: and, lastly, non-infringement. The Plaintiff's Specification states the objects of the invention, and, put shortly, they are to produce a scenic effect, “whereby the effect of a fierce fire may be produced upon a stage or elsewhere without the possibility of injury to the surroundings or to any person appearing to be in the midst of the flames, and apparently handling the tongues of fire, or moving in close proximity thereto.” The objects are otherwise stated in one place. It says: “Another object of the invention is to provide a smoke effect through the same medium employed to furnish the representation of flames, and, furthermore, to provide an illusion representing individual tongues of flames, any one of which tongues may be separated from its fellows, and when released will automatically return to an upright position and again form part of the volume of illusory fire.” The objects are all old, as admitted by Mr. Clark, the Plaintiff's witness, unless so far as it was desired to obtain an appearance of individual tongues of flame which could be separately handled and dealt with as part of the general effect produced. Of course scenic effects of fire of a more or less realistic kind are very old indeed, and it was not suggested that that was new. The invention is described as consisting in the novel construction and combination of the several parts of the apparatus, which is described in detail. Put shortly, the apparatus is of this nature—under the stage there is a platform upon which are put, in a suitable position, fans, having their axes converging towards one another—towards a centre; above that there is an opening in the stage, and also below there are means for lighting from below through the hole in the stage; on the top there is a sort of box-shaped construction, and on that there is a wirework lid. I am not giving the Patentee's own words, but I am shortly giving the general nature of the invention. To this wirework there are fastened separate strips of translucent or transparent material, shaped according to fancy, in the form of flames. The Patentee makes a point of the separation of these flames from the actual fastening right up to the top, and a special point of their fastening. She shows exactly how they are to be fastened to this network. When the thing is put into operation, the light is directed upward through this opening, a draught being created by means of the fan below. The strips of diaphanous material

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ascend and give the appearance of flickering by reason of the waving produced by the draught below; coloured lights are then thrown upon this material by means of the lights below. The performer stands behind, and it gives, as the evidence shows, a very realistic representation of fire with flames, which the performer, as he or she chooses, can apparently handle with impunity, and take separately into his or her hands. The claims are, first: "In stage appliances 5
 "an open-work base"—that is what I have described as the box-like structure with the wire covering—"streamers attached to said base, and means for directing currents of air to the base, and for illuminating streamers through 10
 "the base." Then there is more or less a repetition: "In stage appliances a foraminated structure"—by which I understand a box-like thing with a grid-iron or network thing over the top—"streamers connected thereto, fans 15
 "beneath the foraminated structure arranged to concentrate air currents thereon and an illuminating device the delivery whereof is directed to the aforesaid foraminated structure. (3) In stage appliances, a foraminated 20
 "structure, streamers connected at one end of the said structure, fans grouped beneath the foraminated structure, having their axes inclined in direction of each other and the centre of said structure, supports on which the fans are 25
 "adjustably mounted, a reflector inclined in direction of the central portion of the foraminated structure, and a light within the said reflector." Then there is a repetition: "In stage appliances, a foraminated structure, streamers con- 30
 "nected at one end of the said structure, fans grouped beneath the foraminated structure, said fans being in circular arrangement and having their axes inclined in direction of each other and the centre of said structure, supports 35
 "upon which the fans are adjustably mounted, a reflector inclined in direction of the central portion of the foraminated structure, a light within the said reflector and coloured screens adapted to be passed over said reflector, enabling the light directed to the streamers to be changed in colour or shade at the will 40
 "of the operator." Before I refer to Mr. *Clark's* examination, as there was a certain amount of discussion about the meaning of the word "flame" in this Specification, I may say I have taken the opportunity of consulting the new 30
 English Dictionary, and I find the proper definition of it, which appears to me to be perfectly apt and applicable to the present case, namely: "A portion of ignited vapour, often spire-like or tongue-like." Now Mr. *Clark* in his evidence describes in his examination in chief what he considers the invention 35
 consists of, and in his cross-examination he says, speaking of the perforated or open-work base, that "a pipe underneath the streamers would do. The only purpose of the open-work base is to allow the air to come through; a pipe would do it; it is not necessary that the strips should be attached to the base, 40
 "if they are in its immediate vicinity, anchored to something in the proper position; so long as you get streamers to go in the way you want it does not matter which way the draught comes, whether from below or otherwise." He 45
 says: "The strips might be attached to the performer I should say—it is not referred to in the Specification; there may be less efficient ways of carrying out the invention; it is not necessary the light should come from below." Then it is put to him: "What are the elements which go to make up the 50
 "thing?—The open-work base, streamers, currents of air, light and colour added; if they are coloured that gives the appearance of fire, but it must have a particular colour; anyone could do it, having got the combination."
 Next I may say at once, speaking of what the Defendant does, that the Defendant does the same as the Plaintiff, with certain exceptions, one an 55
 important difference. She employs a number of lights below, or a number of fans—I am not sure which, but I think both. Those are comparatively immaterial. But the Defendant uses a gridiron or cover, but does not attach separate streamers to it; she employs a sort of screen of diaphanous or translucent material, coloured so as to imitate fire, and flames, and I think pleated, at all 55
 events intended to represent fire. I think it is about 4 feet in height altogether

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or thereabouts—and the last 10 inches at the top are split, so that that gives a flickering at the top of this diaphanous frame. The frame is continuous all round and is in the shape of a cylinder—you can hardly call it a cylinder, because it is, as I understand it, a comparatively square cylinder fastened round the opening in the stage.

I have had evidence before me of what was done by Mr. *Wieland*, whose operations and apparatus are relied upon as being a prior user of the invention. Mr. *Wieland* exhibited certain displays prior to the date of this Patent. He had six large arc lights under the stage; he had one motor fan from a motor; he had slides giving colour, which are called mediums; he had a communication for wind continued up to the stage through a large pipe running into a large slot—that is to say, there is what I should describe as a slit on the floor of the stage about a yard long, by about an inch and half the other way. The performer stood on a large glass plate, with the slot in front. The performer wore a certain dress composed of diaphanous or gauzy material, a portion of which was produced before me, and there was a large quantity of this dress. The performer had two whips to enable her to raise the dress to a distance or to any height she liked, and the dress hung from the neck leaving the arms free, but was fastened to the ankles in such a way as not to rise. Then, in front, the performer was provided with an apron of shredded silk, cut to represent flames, and not only cut to represent flames, but painted or dyed with aniline dyes applied so as to, in colour, resemble flames. When the flames were wanted to burst out or fly up, the motor was put in action below. He had also an apparatus for emitting something that represented smoke, and this apron with the representation of flame went up, and the performer appeared to be on fire. It is perfectly obvious that the performer could have caught hold of any of those flames, and could have appeared to have handled any one of them if he had so desired. There was also, as usually first used, a lantern slide so coloured and used in a sort of magic lantern or projector, with a representation upon it of some sort of fire, which assisted the effect. But I am satisfied on the evidence that that was not essential for producing a very good flame effect. The evidence goes to show that it was not used when there was not enough electric power for the purpose, and ultimately it was discontinued altogether, and Mr. *Wieland*, asked whether it was as good with or without it, had rather an inclination, although he did not express it very strongly, to think that the use of his original lantern with the slide was the better of the two, and many people thought it was, but ultimately he found he could dispense with the magic lantern slide altogether, and he did so. There were four powerful lights above, and so, as well as being lighted from below, it was lighted from above, and these performances lasted for a considerable time. The dance was called the "Dance en Flame," and his entertainment he called "Zæo in "Flames," and without the magic lantern he said he obtained the effect, and it looked as if the performer was in flames.

Having read that, I consider what are the several parts going to make up the combination of the Plaintiff's invention? First of all, the perforated base, which Mr. *Clark* himself says is non-essential—that is to say, it is non-essential that it should be perforated in the sense of having a gauzy screen over it for the purpose of permitting the air to come up—that is what it was wanted for; a pipe would do; the strips need not be attached to the base if they are in the vicinity and in the proper position. Secondly, there were separate strips of translucent material, which have been called streamers throughout. That Mr. *Clark* said was an essential part of it. Thirdly, there was an apparatus below for producing strong currents of air sufficient to blow the strips up. He pointed out, as I have said, that it was non-essential that it should be below if the draught was properly directed so as to make the strips wave in the way in which they were wanted. Fourthly, there was an apparatus below throwing beams of light on the strips, so as to produce the appearance of tongues of flame;

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he also said that it was not essential; that the effect could be produced without having the light from below. As to prior Specifications, I do not find the whole combination of these elements, as described by the Plaintiff, in any of them. I do find in *Lake's* the illumination from below, and in *Plunkett's* what may perhaps have produced a result, which was very like the result produced from lighting from below. He employed quite different means from the Plaintiff, but he had several pipes for conducting the air blown in or underneath drapery to cause it to wave and wave upwards, if necessary. *Vernici's*, the third, was a case where the light was directed from below.

I have said that I cannot see that any one of these can be taken to be an anticipation of the Plaintiff's invention as stated as a whole, but I think they do show a great deal of common knowledge with reference to the art, and of most of the elements going to make up the Plaintiff's invention, and that they do reduce what otherwise might have been considered to be the ambit of it. As to the prior user in *Wieland's* performance, I find substantially the whole of the Plaintiff's alleged invention. There is the combination of apparatus; there is an opening of a different shape from the Plaintiff's, but an opening in the stage floor; I find the streamers represented by the apron of the performer, and I find similar apparatus below for producing currents of air sufficient to blow the strips up. It is true that he was in the habit of employing one fan, whereas the Plaintiff's Specification shows, I think—I say I think, because there is just a question upon it—two or more. Mr. *Wieland* employed one large fan to produce what he wanted. The Plaintiff in her Specification claims the use of two or more. Then, lastly, there is similar apparatus below for throwing beams of light on to the strips so as to produce the appearance of tongues of flame. The distinctions really are of the narrowest. The first seems to be this: the strips were fixed to the performer instead of being fixed to the wirework cover of the box-like structure—to use the inventor's words, “the foraminated structure.” There was a narrower hole for the light to come up. The light coming from below came through glass instead of coming through a wirework cover. There was the employment of one large fan instead of two or more small ones, with axes inclined towards one another, and, lastly, there was additional light thrown on from other places—in the case of *Wieland* the whole light did not come from below. In substance and in fact I think there has been prior user, and the Defendant is entitled to succeed on this point. Whether this be so or not, I consider, having regard to the user of Mr. *Wieland's* apparatus and the common knowledge of the art, it did not require invention sufficient to support a Patent to produce the Plaintiff's apparatus, and that there was therefore no sufficient subject-matter. Even if that view is wrong, I think, to give validity to this Patent, it would be necessary to tie the Plaintiff very strictly to her special separated streamers, separated throughout the whole length and fastened in a particular way to the cover of the foraminated structure as described, and in that case the Defendant has not infringed, as she employs an angular cylinder or cage of transparent material, the upper part for about 10 inches being slit into strips and differently fastened. I think the action fails, and must be dismissed with costs.

McCaw, Stevenson, and Orr, Ld. v. Nickols & Co.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE KEKEWICH.

July 31st and October 26th, 1903.

MCCAW, STEVENSON, AND ORR, LD. v. NICKOLS & CO.

- 5 *Trade Mark.—Infringement.—Similarity of name used by Defendants to the Plaintiffs' Trade Mark.—Injunction granted.*

The Plaintiffs in 1894 registered the word "Seccotine" as a Trade Mark for a cement, and used it extensively. The Defendants began to sell a cement as "Securine."

- 10 *Held, that "Securine" was a colourable imitation of "Seccotine," and an injunction was awarded with consequential relief.*

On the 16th of November 1894 *McCaw, Stevenson, and Orr, Ld.*, registered under No. 183,699 the word "Seccotine" in Class 50 for "a cement for mending broken articles," and from the year 1886 sold and at the date of the action
15 were selling their cement as "Seccotine" very extensively. In April 1903 they discovered that *William John Nickols* (trading as *Nickols & Co.*) was selling cement under the name "Securine." On being communicated with *Nickols* was willing to withdraw his goods called "Securine" from the market on payment by *McCaw, Stevenson, and Orr, Ld.*, of the sum of 40*l.*, to which they
20 refused to agree. An action for an injunction to restrain *Nickols* from infringing the Trade Mark and from selling any cement or other adhesive substance under the name "Securine" and for consequential relief was then commenced against *Nickols* in his trading style of *Nickols & Co.*, and notice of motion for an interlocutory injunction was given. This motion came on for hearing
25 before Mr. Justice KEKEWICH on the 31st of July 1903, when the following Order was made :—"That the Defendant *William John Nickols* sued and trading as "*Nickols & Co.*, his servants and agents, be restrained until judgment in this "action or further Order from manufacturing or selling, or causing to be manu-
30 factured or sold, any cement, gum, or other adhesive substance under or "marked with the word, name, or brand of 'Securine,' or any other word, "name, or brand constituting a colourable imitation of the Plaintiffs' registered "Trade Mark 'Seccotine,' or from otherwise infringing the said Trade Mark. "And the Judge treating this application as a summons for directions adjourned "into Court, it was ordered that the action be set down for trial forthwith,

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"without pleadings." The learned Judge further directed that the action should come on for trial on the 26th of October 1903, and it came on accordingly.

P. O. Lawrence, K.C., and the Honourable *Frank Russell* (instructed by *Charles Russell & Co.*) appeared for the Plaintiffs; the Defendant appeared in person.

J. A. Robinson, a director of the Plaintiff Company, having given evidence in support of the Plaintiffs' case, the Defendant gave evidence on his own behalf, and stated in the course of his examination in chief that he thought he was justified in doing what he did.

KEKEWICH, J.—It is extremely difficult in these cases to say why one word is like another and to weigh in one's mind how the only half-wary customer would deal with buying one thing or another; and I think I should probably do best by not attempting to explain why I think "*Securine*" is a colourable imitation of "*Seccotine*." I think it is. I think it is calculated to deceive. That is enough for me.

Then the Defendant on oath says that he conscientiously believed that there was no infringement—he did not intend to infringe. Giving him credit for that belief, nevertheless, he comes here to insist that it is not an infringement. In doing that he is exercising his right; but, if it is fraudulent, it is no less fraudulent because he now endeavours to protect that which he says he did not intend to be an infringement. That only goes to the question of costs. I must grant an injunction, that is to say, make perpetual the injunction granted before, and the Defendant must pay the costs of the action. Whether it is worth while having destruction or delivery up of what he has got in stock is another matter.

Lawrence, K.C.—I ask for the delivery up of all infringing articles, and also for an account of profits.

KEKEWICH, J.—You are entitled to it.

Olaughten v. Foster.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BYRNE.

October 27th and 28th, 1903.

CLAUGHTEN v. FOSTER.

5 *Patent.—Action for infringement.—Validity.—Infringement.—Judgment by consent for injunction on terms.—Certificate of validity refused.—Patents, &c. Act, 1883, section 31.*

The owner of a Patent for improvements in siphons for cisterns for water closets, having brought an action for infringement, the Defendant pleaded
 10 *non-infringement and invalidity, but during the trial he consented to an injunction on certain terms, including the grant to him of a licence on a royalty; and judgment was given accordingly. BYRNE, J., refused to grant a Certificate that the validity of the Patent came in question.*

On the 17th of January 1894 Letters Patent (No. 1026 of 1894) were granted
 15 to J. W. Hancock for "Improvements in siphons for cisterns for water closets."

The claims of the Specification were as follows:—"1. In siphon arrangements
 "for cistern used with water closets and for similar purposes, attaching one end
 "of the siphon to a cylinder fitted with a piston which has a valve so arranged
 "that when the piston moves in one direction it acts upon the water in the
 20 "cylinder to start the action of the siphon, and which also allows the water
 "drawn by the siphon when started, to pass through it substantially as shown
 "and described in the accompanying drawing and Specification.

"2. A siphon arrangement for cisterns used with water closets and similar
 "purposes constructed and arranged substantially as shown and described in
 25 "the accompanying drawing and Specification."

The owners of the Patent commenced an action against the Defendant *Foster* for infringement of the same, claiming the usual relief.

The Defendant in his Defence denied infringement and alleged the invalidity of the Patent, and the Particulars of Objections alleged (*inter alia*) anticipation
 30 by certain Specifications and want of subject-matter.

The action came on for trial on the 27th of October 1903.

T. Terrell, K.C., and J. C. Graham (instructed by Corbyn and Greener, agents for Beaumont and Croft, of Leeds) appeared for the Plaintiffs; A. J. Walter and J. H. Gray (instructed by Helliwell, Harby, and Evershed, agents
 35 for Jubb, Booth, and Helliwell, of Halifax) appeared for the Defendant.

The case was opened for the Plaintiffs, and an expert witness was called for them on the 27th of October; on the 28th of October, whilst one of the Plaintiffs was being examined, Terrell, K.C., stated that an understanding had been arrived at between the parties, and that they had agreed that there should be a judgment,
 40 subject to his Lordship's permission, for the Plaintiffs for an injunction, and that they agreed to grant the Defendant a licence on a royalty, and, as to the rest of the terms, that there should be a Judge's Order if it became necessary.

BYRNE, J.—By consent you take an Order for an injunction upon terms agreed between the parties. Are you going to put the terms into the Order?

45 Terrell, K.C.—There must be an injunction.

Olaughten v. Foster.

BYRNE, J.—Are you going to put into the Order that there is to be a licence granted?

Terrell, K.C.—Yes. Will your Lordship certify that the validity of this Patent came into question in the action?

BYRNE, J.—No, I do not think I ought to do that, because there is an agreement between the parties, and how can I certify that validity came into question? 5

Terrell, K.C.—It did come in question.

BYRNE, J.—Yes, it did come in question, but in the result there has been an arrangement between the parties, and that is not a decision. 10

Terrell, K.C.—The object of the Certificate is that the Patentee should not be troubled with a large succession of actions.

BYRNE, J.—Yes, but that means if the case has been fought out. I have had actions coming on as short causes, in which there has been no evidence given at all, and I have refused to give a Certificate. The only object is with reference to the costs in a future action. If an action is brought which is compromised, that ought not to prejudice other persons. I do not think this is one of those cases where a Certificate ought to be given. It is liable to misconstruction, and it would give rise to a strong argument in the next case, that it could not have been meant. You have agreed about the costs, I suppose? 15 20

Terrell, K.C.—Yes.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE FARWELL.

October 29th, 1903.

IN THE MATTER OF THE APPLICATIONS OF BOOTH'S DISTILLERY COMPANY 25
LD., FOR THE REGISTRATION OF TRADE MARKS.

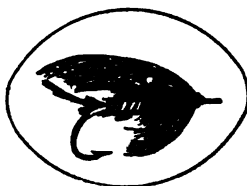
Trade Marks.—Application to register.—Mark calculated to deceive.—Mark similar to marks which had been already refused registration.—Appeal by Applicants from Comptroller dismissed.—Patents, &c. Act, 1883, section 73.

A Company sought to register two marks as Trade Marks in Class 43, both 30 having the device of a salmon fly, one of them having the words "Salmon Fly Brand" and the other having also the words "Jock Scott Salmon Fly." The Comptroller refused to register the marks on the ground of similarity to a mark consisting of the words "Scotch Jock" and also on the ground that other marks of a similar nature had already been refused. The Applicants appealed, and the 35 appeal was referred to the Court. At the hearing the owners of the "Scotch Jock" mark opposed, and there was evidence of use since 1896 of one of the marks of which registration had previously been refused. The Applicants had made no inquiries as to these marks, although invited to do so by the Comptroller. 40

In the Matter of the Applications of Booth's Distillery Company, Ltd., for the Registration of Trade Marks.

Held, that the use of the words "Jock Scott" would be calculated to deceive, and as to the other mark that the Comptroller had exercised his discretion properly, and that it ought not to be overruled. The appeal was dismissed with costs.

- 5 On the 3rd of November, 1902, *Booth's Distillery Company* applied to register two Trade Marks in Class 43 in respect of fermented liquors and spirits, the applications being numbered 249,746 and 249,747 respectively. The essential particulars of No. 249,746 were stated to be the following, viz., a distinctive label having in the centre the device of a salmon fly in an oval shape with the words "Salmon Fly Brand" below that shape. The essential particulars of
- 10 No. 249,747 were stated to be the following, viz., a distinctive label having in the centre the device of a salmon fly of the kind known as the "Jock Scott" salmon fly in an oval shape with the words "Salmon Fly Brand" above such shape and the words "Jock Scott Salmon Fly" below such shape. A representation of No. 249,746 is shown below; No. 249,747 only differed from this in having the words "Salmon Fly Brand" above and the words "Jock Scott
- 15 "Salmon Fly" below the device.



- On the 18th of November, 1902, the Comptroller wrote calling the attention of the Applicants to two Trade Marks, the registration of which, he stated, had
- 20 been applied for at a date previous to the Applicants' registration, and which appeared to resemble the marks they claimed; and stating that, in accordance with the provisions of section 72 of the Patents, &c. Act, 1883, as amended by section 14 of the Patents, &c. Act, 1888, the Applicants' marks therefore appeared to be incapable of registration, and their applications accordingly could not be
- 25 proceeded with. One of the marks referred to, viz., No. 50,423, consisted of the words "Scotch Jock," and was registered in 1886 in Class 43 in the name of *R. M. Mackilligin*. The other mark was No. 135,045, registered in the name of *Hegarth Brothers*, being a fish-hook with a landscape as a background and the words "Fish-hook Brand." On the 18th of December 1902 the Comptroller
- 30 heard the solicitors of the Applicants, when he informed them that certain earlier applications had been refused, yet the earlier applicants might have used the marks shown on their applications or marks of a similar character; that it appeared from some of the earlier applications that the labels had been prepared and were quite possibly in use; and the Comptroller pointed out that user
- 35 of any of these previous marks might affect the right to registration of the Applicants' marks, and in order that they might make the fullest inquiries on the subject he gave them ample particulars, both of the marks and of the persons who respectively applied for the registration of them. These marks are further referred to later and in the judgment. On the 19th of December
- 40 1902, the Comptroller wrote to the Applicants stating that, in pursuance of Rule 19 of the Trade Mark Rules, 1890, in exercise of the discretionary power given to him by the Patents, &c. Acts, 1883 to 1888, the applications to register were refused. The Applicants appealed to the Board of Trade, who referred the appeal to the Court with the usual directions, and a direction to serve

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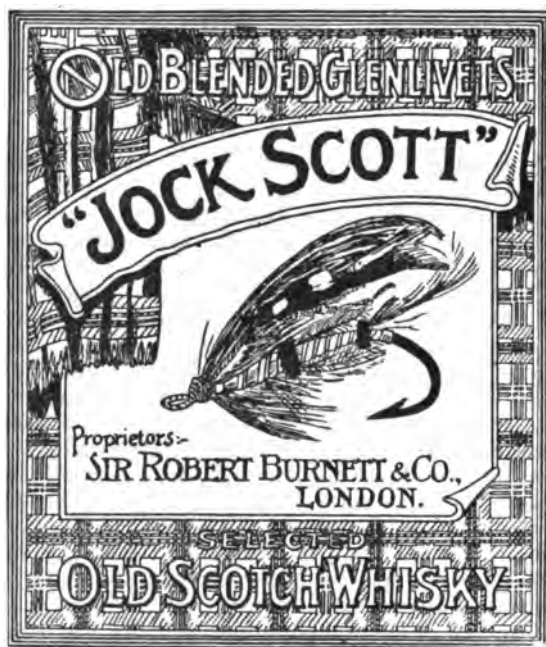
A. H. Wallace, trading as *R. M. Mackilligin*, and also *Hogarth Brothers*. The Applicants gave notice of motion accordingly that the Comptroller might be ordered to proceed with the registration.

Affidavits were filed on behalf of the Applicants stating that the firm of *Hogarth Brothers* could not be found, and that no transfer of their mark had been registered, and that they had never seen or heard of goods being sold thereunder. 5

The evidence for the Applicants also alleged, in effect, that the "Scotch Jock" mark had been little used, and that there was no probability of confusion.

Affidavits were filed in opposition by and on behalf of *A. H. Wallace*, alleging that a considerable business had been done under his mark, and that the words "Jock Scott" in the Applicants' mark (No. 249,747) were calculated to deceive. 10

The Comptroller made an affidavit in which he referred to four applications in Class 43, namely, No. 192,943, the essential particulars of which were the words "Old Jock Scott"; No. 193,008, consisting of a salmon fly; No. 195,135, applied for by *Sir R. Burnett & Co.*, containing the words "Jock Scott" and the representation of a salmon fly; and No. 200,485, consisting of a salmon fly and the words "Jock Scott Whisky," with the Applicants' name and address. (A representation of No. 195,135 is shown below.) He also stated what had occurred at the hearing, and that, 15 20



not finding from the Applicants' affidavits that they had made any inquiries as to these prior Applicants, he had therefore made certain inquiries. The result of these was that the persons applying for marks No. 192,943 and No. 193,008 did not appear to be known at the addresses given, and might therefore be out of business; that he found that the label shown on application No. 195,135 was in use, and had been in use since 1896; that he found that the Applicants for 25

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the label shown on application No. 200,485 ceased using it, fearing it might be an infringement of the rights of another firm, but they considered that the application still held good, and they were still desirous of having it registered either simply as originally applied for or for the two words "Jock Scott," and they unhesitatingly objected to any other firm using it; but the Comptroller stated that it did not appear that the application No. 200,485 could now proceed, though it was of course open to the same Applicants to lodge a fresh application if they were so advised.

An affidavit in reply was made by *J. W. Bashford*, chairman of the Applicant Company, in which he stated that he had been in business for 25 years past, and had, during that period, had very extensive transactions in the purchase and sale of whisky, and that he had never in his experience seen or heard of the label referred to in the application No. 195,135, and he was sure that if the same had been actually in use since the year 1896, or had been an established brand of whisky, he must have known of it, and that, as the result of inquiries he had made, he was convinced that no general user of such mark had been made, and that it was unknown to the trade.

The motion was heard on the 29th of October 1903.

Whinney (instructed by *Foster, Spicer, and Foster*) appeared for the Applicants; *R. J. Parker* (instructed by the *Solicitor to the Board of Trade*) appeared for the Comptroller; *Attwater* (instructed by *F. G. Mellows*) appeared for the Respondent, *A. H. Wallace*.

Whinney for the Applicants.—As to No. 249,746, the essential particular is the distinctive label as a whole. The existence on the Register of the "Fish-hook Brand" label is not a valid objection; there can be no confusion arising from the names and the two marks are quite different, and no one could, with the addition of the names, confuse them. Moreover, this mark is not known in the trade, and the firm that is registered as proprietors is believed not now to exist. [*Parker*.—Many other marks have been refused in consequence of that registration and there are many similar marks in the trade.] As to No. 249,747, the owner of the "Scotch Jock" appears to oppose the registration. But it cannot be said that the case is within section 72, for the marks have not such resemblance as to be calculated to deceive. Then, as regards section 73, one must take the two expressions as a whole, one is "Scotch Jock" and the other is "Jock Scott Salmon Fly." There is evidence that there is no probability of deception.

Attwater for *A. H. Wallace*.—I rely on the similarity of sound, the phrases are difficult to distinguish; the "Scotch Jock" mark is in use and there is evidence that the "Jock Scott" mark is calculated to deceive.

Whinney in reply on No. 249,747.—Under section 73 there must be evidence that the use of the words would deceive: there is no evidence that the goods have got to be known by the name "Scotch Jock"; in *Eno v. Dunn* (7 R.P.C. 311), there was evidence that the Opponents' goods were known by the name of "Fruit Salt."

FARWELL, J.—With respect to the "Jock Scott" mark (No. 249,747), in my opinion I cannot interfere with the Comptroller's decision. It seems to me to be clearly within section 73, and on the evidence and on the consideration of the mark, I have no doubt myself that the use of these two words would be calculated to deceive, and consequently the mark cannot be registered.

Parker for the Comptroller.—As to No. 249,746, the idea therein contained is quite old, and other applications have been refused on the same grounds as the present one. There is evidence that the mark applied for under the number 195,135 has been in use since 1896. The Comptroller suggested that the Applicants should make inquiries as to the use of the marks which have been refused registration, but they have not done so. The Comptroller has exercised his discretion; moreover it would be unfair to the owners of the other marks if the Applicants were registered.

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Registration of Trade Marks.*

Whinney in reply.—The mark was rejected by the Comptroller on the specific ground only of the two prior registrations. The fact that other applications have been made and refused ought not to prejudice the Applicants (*König and Ebhardt's Trade Mark*, 13 R.P.C. 449). Section 72 only applies where there is a similar mark already on the Register; in this case it can only be a question of common law rights. [FARWELL, J., referred to the judgment of Lord Herschell in *Eno v. Dunn* (7 R.P.C. 311) as to the Comptroller's discretion.] The Court can exercise a discretion on the facts before it. Under section 73 there must be a right in someone which would be interfered with; a small use is not sufficient. Looking at the marks as a whole there is no probability of deception, and there is not on the evidence any such probability. [FARWELL, J.—Is not the Comptroller entitled to consider the fact that other applications for similar marks have come before him and have been refused?] I submit not. Also under section 73 there must be deceptive words (*Hudson's Trade Marks*, 3 R.P.C. 155), and here there can be no deception in the words. If the mark 195,135 were on the Register, the Applicants' mark ought not to be refused on account of it.

FARWELL, J.—This is an application to review the Comptroller's refusal to register. Now the Comptroller undoubtedly has a discretion—a discretion of course to be exercised judicially like all other judicial discretions. There is an appeal to this Court, but the Court ought not to overrule the judicial exercise of the Comptroller's discretion unless it is clearly of opinion that the discretion was wrongly exercised. In my opinion the Comptroller was perfectly well founded in the way in which he has exercised his discretion here. The Applicants put forward two marks, one, "Salmon Fly Brand," with a salmon fly in colours, and the words "Jock Scott Salmon Fly" underneath, and the other a salmon fly in colours and the words "Salmon Fly Brand" underneath. When the matter came before the Comptroller he pointed out to the Applicants that there had been a number of applications for similar marks, all of which had been refused, and suggested to them that it would be better that they should make inquiries and find out whether the people who had made those prior applications had been using the marks which they had put forward. It is obvious that there were all sorts of matters to be inquired into before the Comptroller gave the advantage of registration to such late applicants as the present Appellants. The Appellants have not availed themselves of that suggestion; they have given him no information at all, and the Comptroller has gone to the trouble of making some searches, and he has put in evidence a certain number of the labels. Now there is one thing very striking, that the application being, as I say, for these two labels, I find a label put forward of *Sir Robert Burnett & Co.*, which was sent in for registration but registration was refused, consisting of the words "Old Blended Glen-Livet Jock Scot," and then a coloured salmon fly very similar to the present, only it is turned the other way, and then the proprietors' name underneath. The next one is simply a salmon fly turned the same way as the present, not coloured, and "Jock Scot Whisky." These are circumstances sufficient to make one suspicious of the present application. I should be certainly very slow to overrule the Comptroller in a case like the present, where he has invited the Applicants to go into evidence and satisfy themselves as to these marks, and the Applicants have not taken the trouble, or, perhaps, have been well advised in not attempting to dispose of them at all.

The Comptroller has, in my view, exercised his discretion wisely, and I dismiss the application with costs—the costs of the Comptroller and of the other Respondent.

N. K. Fairbank Company v. Cocos Butter Manufacturing Company.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE SWINFEN EADY.

November 17th and 18th, 1903.

N. K. FAIRBANK COMPANY v. COCOS BUTTER MANUFACTURING COMPANY.

5 *Action to restrain infringement of Trade Mark and passing off.—Plaintiffs' butter substitute called "Cottolene."—Defendants' called "Cocosoline."—Articles made from different natural products.—Get-up dissimilar.—Absence of fraud.—No probability of deception.—Action dismissed.*

The N. K. F. Co. had for many years prior to 1888 manufactured from cotton-
 10 seed oil and sold in America a butter substitute called "Cottolene." In 1888 and 1899 they registered the word "Cottolene" in Class 42. In 1892 they commenced to sell wholesale in this country, and so continued. In 1902 the Defendant, a member of a firm of cocoa-nut oil manufacturers of Ceylon, commenced to manufacture in England and sell wholesale a butter substitute
 15 made from cocoa-nut oil, and advertised it for sale under the name "Cocosoline." The N. K. F. Co. alleged that the "Co" of "Cocosoline" would be omitted in practice; that, the sound being similar, would cause confusion, and enable the Defendant's goods to be passed off as and for the Plaintiffs'. The get-up of the Defendant's goods was different from the get-up of the Plaintiffs' goods.
 20 Held, that the Defendant had acted honestly in the choice of a name not inappropriate, and that there was no reasonable probability of the Defendant's goods being passed off as the Plaintiffs' by the mere use of the word "Cocosoline." The action was dismissed with costs.

The N. K. Fairbank Company, an American Company, incorporated in
 25 accordance with the laws of the State of Illinois, were the registered proprietors of two Trade Marks, each of which consisted of the word "Cottolene" without addition. The first (No. 77,276) was registered on the 14th of June 1888 in Class 42 in respect of "Butter, lard, oleo, margarine, oil, and other oily or
 "fatty substances used as food," and the second (No. 223,150) was registered
 30 on the 17th of May 1899 in Class 42 in respect of "A substance used as food
 "and as an ingredient in food." For many years the Plaintiffs imported into

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England a butter substitute prepared by them which they sold in large quantities under the name "Cottolene." In May 1903 it was brought to the knowledge of the Plaintiffs that the Defendant *B. F. Khan*, trading as the *Cocos Butter Manufacturing Company*, was beginning to advertise and sell a preparation of his own intended as a butter substitute under the name of "Cocosoline."

On the 29th of May 1903 the *N. K. Fairbank Company* commenced an action against the *Cocos Butter Manufacturing Company* for an injunction to restrain the Defendant, his servants and agents (1) from in any manner infringing the Plaintiffs' said Trade Marks (and two other Trade Marks in respect of which no relief was asked in the Statement of Claim) or any of them; and (2) from selling or offering or exposing or advertising for sale, or procuring to be sold, any butter substitute or similar article not being of the Plaintiffs' manufacture or merchandise under the name "Cocosoline" or any other name which by reason of colourable imitation of the Plaintiffs' name "Cottolene" or otherwise was calculated to represent or lead to the belief that such article was "Cottolene" or an article of the manufacture or merchandise of the Plaintiffs'; and (3) from in manner aforesaid or in any other manner passing off or enabling or assisting others to pass off any such article as aforesaid as and for the goods of the Plaintiffs', and for other relief, including damages or profits, and costs.

The Plaintiffs by their Statement of Claim stated—(1) that they carried on an exceedingly extensive business as manufacturers and merchants of various goods, and an important article which they had for many years imported into this country was a butter substitute prepared by them, which they sold in large quantities under the name of "Cottolene"; (2) that they were the registered proprietors of the two Trade Marks before mentioned; (3) that by reason of their large expenditure in advertising and pushing their said preparation under the name and Trade Mark "Cottolene," and of the energy with which the same had been brought before the public, and of the merits of the preparation, "Cottolene" had become and was thoroughly well known and recognised by the public, and anyone who asked for or ordered a butter substitute under that name intended and expected to receive the Plaintiffs' preparation and no other; that the name "Cottolene" had become of great value to the Plaintiffs, and it was of extreme importance to them that no article, not of their manufacture, should be sold under the name and Trade Mark aforesaid, or any other name or Trade Mark which could be confused with it; (4) that at the end of May 1903 it was brought to the Plaintiffs' knowledge that the Defendant, at 225, Old Ford Road, in the county of London, was beginning to advertise and sell a preparation of his own intended for use as a butter substitute under the name "Cocosoline"; that the Plaintiffs thereupon caused representations to be made to the Defendant with a view to obtaining the discontinuance of the word "Cocosoline" (pronounced "Cocossoline"), but the Defendant had not withdrawn the same; (5) that the word "Cocosoline" was so similar (especially in its pronunciation) to the Plaintiffs' name and Trade Mark "Cottolene" that if it were allowed to be used in respect of a butter substitute such preparation must inevitably be confused with and sold as and for the Plaintiffs' preparation "Cottolene," and it was necessary for the protection of the Plaintiffs and of the public that the Defendant should be restrained by the injunction of the Court from continuing to use the said word as he had been doing; that by means of the use of the said word the Defendant had made profits which ought to belong to the Plaintiffs, and had caused them damage and injury, for which they were entitled to compensation.

The Defendant by his Defence stated—(1) that the Plaintiffs were manufacturers and merchants of various goods which they made from cotton-seed oil and imported into this country, one of such goods being sold by them as a butter substitute under the name of "Cottolene"; that, save as aforesaid, the Defendant did not admit any of the allegations in paragraphs 1, 3, and 5 of the

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Statement of Claim ; (2) that the Defendant was a member of the firm of *Framjee, Bhikhajee & Co.*, of Ceylon, which firm were extensive purchasers of cocoa-nuts and copra (the dried kernel of the cocoa-nut), and had for some years past manufactured therefrom cocoa-nut oil, which they imported into this and other countries ; (3) that oil obtained from the cocoa-nut could by a certain process be converted into a very satisfactory substitute for butter ; that could not, however, be done in Ceylon, the heat there being too great. Accordingly in or about December 1901 the Defendant, under the name of the *Cocos Butler Manufacturing Company*, established a manufactory in this country (at 225, Old Ford Road, London), and in or about June 1902 the Defendant commenced making at his manufactory the said butter substitute from cocoa-nut oil obtained from his firm in Ceylon ; (4) that the butter substitute so made by the Defendant from cocoa-nut oil as aforesaid was of two kinds, namely (1) a hard brittle substance containing a good deal of stearine, and (2) a soft substance containing mainly oleine ; that the former of these two substances could be and was used as a butter substitute in the preparation of any kind of confectionery and other similar articles of food ; the latter substance was used as a butter substitute in the preparation of certain kinds of confectionery ; (5) that in May 1902 the Defendant's agent, *Percy George Archer*, applied for registration of the word "Cocoso" in Class 42, and such registration was obtained on the 28th of November 1902, as of the 17th of May 1902 ; that the registration stood in the name of the Defendant's said agent, but only as trustee or agent for the Defendant ; (6) that at or about the time when registration of the word "Cocoso" was obtained the Defendant adopted and had ever since used the word "Cocosoline" for the softer substance referred to in paragraph 4 thereof, and since the adoption of such last mentioned word the Defendant had confined the word "Cocoso" to the harder substance aforesaid ; (7) that the Defendant by his said agent applied for registration of the said word "Cocosoline" in March 1902, but such registration had not yet been obtained ; (8) that, save as aforesaid, the Defendant did not admit any of the allegations in paragraph 4 of the Statement of Claim ; (9) that the Defendant did not nor did his agent in adopting and using the said words "Cocoso" and "Cocosoline," or either of them, imitate or copy or attempt to imitate or copy the Plaintiffs' Trade Mark "Cottolene" ; that the Defendant had not and had never had any wish that his preparations, or either of them, should be mistaken for or confused with the Plaintiffs' preparation ; on the contrary, the Defendant's preparation was superior to that of the Plaintiffs' ; that, independently of the fact that the get-up of the Defendant's preparation was very different from that of the Plaintiffs' preparation, the Defendant denied that there was any such similarity between the words "Cocosoline" and "Cottolene," that any confusion was probable or indeed possible.

The action came on for trial on the 17th of November 1903 before SWINFEN EADY, J.

Eve, K.C., and *L. B. Sebastian* (instructed by *Janson, Cobb, Pearson & Co.*) appeared for the Plaintiffs ; *Mickleth, K.C.*, and *E. P. Hewitt* (instructed by *Samuel Price & Sons*) appeared for the Defendant.

Eve, K.C., opened the Plaintiffs' case.—For many years prior to 1888 the Plaintiff Company had been manufacturing and selling in America, first as a wholesale business and subsequently on a large scale as a retail business, a butter substitute under the name "Cottolene." It was largely used in the confectionery trade. Desiring to establish a similar business in this country, the Company on the 14th of June 1888 and on the 17th of May 1889, so as to cover all classes of goods in Class 42, registered the word "Cottolene" as a Trade Mark. The sale of this substance under the name of "Cottolene" was commenced in England in 1892. Other persons have attempted to register names similar to "Cottolene"—*e.g.*, "Cocolene." All such attempts to register

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have been successfully opposed. In May 1903 the Plaintiffs discovered an advertisement by the Defendant of a commodity described as "Cocosoline." It stated that it was capable of being used for the same purpose as "Cottolene." The Plaintiffs having endeavoured to induce the Defendant to vary or change the name, and having failed, commenced the present action. The Defendant began to manufacture the article in 1902 for the first time in this country, but no substantial sales came to the Plaintiffs' notice until May 1903. There is no complaint as to get-up except in one small particular, viz., the resultant commodity produced by the process employed by the Defendant is a white substance. The resultant of the Plaintiffs' process is a yellow substance. An artificial colouring is introduced into the Defendant's substance making it a colour very nearly approximating the colour of "Cottolene." An application by the Defendants to register "Cocosoline" has been pending for some considerable time. The Plaintiffs are opposing it, and, the evidence not being complete, it is still under the consideration of the Comptroller. The Plaintiffs doubt the *bona fides* of the Defendant in adopting the name "Cocosoline." At the time of its adoption the Plaintiffs were and had for some time been doing a considerable wholesale trade in this country, and were contemplating opening up a retail trade. Confusion is likely to arise by reason of the similarity of the names.

The following witnesses were called in support of the Plaintiffs' case:—*A. Bigland* (of *Bigland, Sons, and Jeffrys*, Liverpool), sole agent for the Plaintiffs in this country for "Cottolene"; *Dr. Otto Hehner*; *L. E. Turner* (a director of *Turner & Sons, Ltd.*, bakers and confectioners, Nottingham); and *E. F. Pring* (of Bristol); *J. McGregor* (of Leeds); *J. Simcock* (of Manchester); *C. W. Makins* (of Chorley); *J. Williamson* (of Chester), bakers and confectioners; and *W. Mallet* (managing clerk of *Janson, Cobb, Pearson & Co.*).

In the course of *Mr. Turner's* evidence the following question was objected to by *Micklem, K.C.*, on the ground that the question was one for the Court:—"In your opinion is there any confusion likely to arise between the words 'Cottolene' and 'Cocosoline'?"—citing *North Cheshire and Manchester Brewery Company v. Manchester Brewery Company* (L.R. (1899) A.C. 83), per Lord Halsbury. *Eve*, having cited *Addley Bourne v. Swan and Edgar, Ltd.* (20 R.P.C. 105; L.R. 1 Ch. (1903) 224).—The authorities are not clear upon the point. Evidence has sometimes been admitted of persons who have said that they themselves would be deceived. [SWINFEN EADY, J.—That was not the question put to *Mr. Turner*.] The question was put generally—whether he thought it was calculated to deceive. [SWINFEN EADY, J.—It is quite open to you to prove all the surrounding facts and circumstances from which *Mr. Turner* would form his opinion as to the probability of deception upon which you may ask me to come to the same conclusion. I understand no objection is raised to your doing that.]

Micklem, K.C., opened Defendant's case.—The Defendant *B. F. Khan* is a member of the firm of *Framjee, Bhikhajee & Co.*, exporters of cocoa-nut oil from Ceylon. In 1901 he took premises here to manufacture "Cocos" butter. It is a well-known product of cocoa-nut oil, but owing to the great heat it cannot be made in Ceylon. *Mr. Khan* came to this country in June 1902 in order to undertake its manufacture. Between 1901 and 1902 his agent had put the manufactory in working order. On the 28th of November 1902 the word "Cocoso" was registered. The Plaintiffs objected to the registration, but did not proceed with their opposition. Cocos butter was and is sold under the name "Cocoso." It is sometimes sold pure white and sometimes yellow. It is "hard butter." "Cocoso" has no resemblance to the Plaintiffs' goods either in its body or get-up. Prior to October 1902 all the residual oil after the extraction of the stearine in the manufacture of "Cocoso" was sold to soap dealers. In October the Defendants began to refine the pressings or runnings

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and sold the product as "soft butter." In November they began to use the word "Cocosoline." It is always advertised in connection with the words "Cocos Butter" and "Cocoso." Application to register was made on the 28th of February 1903 in Class 42. Objection was taken to it, and the matter is still pending. The soft butter is used for a purpose different from that for which Plaintiffs' article is used. Mr. Archer, the Defendant's manager, invented both the word "Cocoso" and "Cocosoline." He added an "o" to "Cocos," the material, and added "line" to the product of "Cocoso." This practice is a common one. No fraud is suggested by the Plaintiffs and no passing off. As to the yellow colour, this is adopted simply because it is then more like butter. We have not tried to imitate the Plaintiffs' yellow. You may do anything in the lawful exercise of your own trade, so long as you do not do anything to deceive a customer using ordinary caution (*Leather Cloth Company, Ltd. v. American Leather Cloth Company, Ltd.*, 11 H.L.C., 523, per Lord Cranworth, page 535). The law will not protect the man who would really mistake on paper the word "Cocosoline" for "Cottolene."

The following witnesses were called for the Defendant:—*Bhikhajee Framjee Khan*, the Defendant (a member of the firm of *Framjee, Bhikhajee & Co.*, of Colombo); *P. G. Archer* (managing clerk to Messrs. *Leslie and Alderson*, of London, London agents and correspondents of the Colombo firm); *Alfred Walkley* (pastrycook and confectioner, of Upper Holloway); *F. W. Brett* (director of Messrs. *Brett and Beney, Ltd.*, bread and biscuit manufacturers and pastrycooks, of Islington); *F. H. Mears* (manager of the *Standard Bakery*); and *N. B. Walters* (manufacturing confectioner of Poplar).

Eve, K.O., in reply.—This is a case of first impression. But three incidents have arisen in the case tending to alter that impression. Mr. *McGregor* said that at a round table conference of bakers in September last "Cocosoline" was mentioned to him. He did not hear the initial "Co," and thought it was a mistake for "Cottolene." Mr. *Micklem*, on putting a question to a witness, by mistake called it "Cosoline," and that was emphasised when Mr. *Hewitt*, in putting a question, spoke of "Cottolene" as "Cocottolene." By far the largest number of witnesses have come to know of "Cottolene" by personal recommendation. "Cocosoline" may easily be mistaken for "Cottolene" by the persons recommended. Mistakes may arise even in the wholesale trade, but there will be great danger of mistake when the Plaintiffs enter into the retail trade. The action is in the nature of a *quia timet* action, but if Plaintiffs had stood still they would have prejudiced themselves. No doubt the Defendant will also enter the retail trade, and if he should then get his name registered as "Cocosoline" it will be too late to restrain him.

SWINFEN EADY, J.—In this case the Plaintiffs claim an injunction to restrain the Defendant *Bhikhajee Framjee Khan* from infringing the Plaintiffs' registered Trade Mark which is the word "Cottolene," and from passing off or attempting to pass off by reason of colourable imitation the Defendant's product which he has called "Cocosoline" as and for the Plaintiffs'. The case is in my opinion a very simple one. The Plaintiffs do not complain of any get-up or of any fraudulent or other imitation except the use of the word "Cocosoline." It was said, but really only incidentally, that the Defendant prepared his substance in two colours, one was white or cream—which would be colourless or practically colourless—and the other tinted or coloured yellow, but it was not suggested that the Defendant was not quite entitled to do that, and it was merely mentioned by the way, and not that the Defendant had coloured his substance yellow in order, or with a view, to imitate the Plaintiffs' colouring. Practically, the case rests entirely upon the use of the word "Cocosoline."

The two substances are derived from two entirely different natural products. The Plaintiffs' substance called "Cottolene" is made from or largely from

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cotton-seed oil. The Defendant's is practically made entirely from cocoa-nuts and cocoa-nut oil. The cocoa-nut oil is obtained and treated, producing in the first instance the harder substance called "Cocoso," and then a residual product, subsequently refined, and put upon the market as "Cocosoline," which is the subject of this action. So that the articles are different in the sources—the natural product—from which they are obtained. Cocos Butter has been well known for some time, and the Defendant in producing the article now called "Cocoso" adopted the word "Cocos" as the root of his new word adding the termination "o"—"Cocoso." Now, "Cocosoline" is formed from the same root. It is not disputed that the word "Cocosoline" aptly describes the new product that is obtained from a substance known as "Cocos Butter," which again is obtained from cocoa-nut oil, and "Cocosoline" is the softer or more liquid portion of it, containing the oleine, and "Cocoso" the harder portion, containing the stearine. So that the Defendant's word, not inaptly at all events, describes the article which he has produced, in the same way that the Plaintiffs' word is sufficiently descriptive of the origin of their substance "Cottolene." I am quite satisfied that the Defendant has taken both his words "Cocoso" and "Cocosoline" honestly and without the least idea or intention of imitating the Plaintiffs' word. Furthermore, at present both the Plaintiffs and Defendant sell wholesale only, and not only has no instance of deception been proved, but it is not really contended that so long as the two substances are sold wholesale and in the way in which they are now sold, persons buying those substances would be confused or take one for the other. But it is said that the Plaintiffs may, at a future time, follow here the course of trading which has been adopted in the United States, and, instead of selling their substances wholesale only and in quantities of which the smallest is half a hundred weight, put it up in packages of 1 lb., 2 lbs., and so on, and sell it retail in shops—sell it retail to the public. Now, in so far as this action has reference to any such contemplated or future sale, it is purely a *quia timet* action, and there is no evidence before me from which I can in the least draw the conclusion that if the Plaintiffs, and even the Defendant too, were both to put up their products in small quantities and let them be sold through the shops to the public, one would, I will not say necessarily, but even probably, be mistaken for the other. No doubt there is a certain amount of similarity in the words, but when the goods are put upon the market retail it will be quite open to the Plaintiffs as well as to the Defendant to put their goods up in such a way, to prepare them for the market in such a way, to put them in such tins and use such wrappers and labels and colours as to well distinguish and prevent the possibility of deception by one being taken for the other. The two substances are analogous with regard to their use, but not identical. It is clear that for some sweetmeats "Cocosoline" is suitable but "Cottolene" is not. It may be the converse is also true. But they overlap to some extent. There is no doubt that the two substances are also useful to some extent for similar productions. But, having regard to the evidence, I am satisfied that the Defendant, acting honestly, has given a new name, not an inappropriate one, to his substance, and that there is no reasonable probability, by the mere use of the word "Cocosoline," which is all that is complained of in this action, of the one being passed off for the other.

Under these circumstances, I am of opinion that the action fails and must be dismissed with costs.

Brooks v. Hall.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE JOYCE.

November 24th, 1903.

BROOKS v. HALL.

5 *Patent.—Action for infringement.—Defence struck out.—Motion for judgment.—Certificate that the Particulars of Breaches were reasonable and proper given as to part of the same.—Patents, &c. Act, 1883, section 29.*

On the 24th of February 1903 *John Boulton Brooks* commenced an action against *William Hall* for infringement of Letters Patent No. 11,192 of 1894
10 and No. 4120 of 1897, for processes of tapering and shaping metals, claiming the usual relief.

The Plaintiff delivered a Statement of Claim alleging—(1) that he was the registered legal owner of the Patents; and (2) that the Defendant had infringed the same and each of them in manner by the Particulars of Breaches therewith
15 delivered appearing.

The Particulars of Breaches alleged—(1) that the Defendant had manufactured, sold, and offered for sale metallic articles or goods tapered or shaped in accordance with the invention described in the Complete Specifications of both the Patents and in infringement of all the claiming clauses in both the
20 Specifications referred to in the Statement of Claim; (2) that the Plaintiff in particular complained of the sale by the Defendant at 70 Alexandra Road, Edgbaston, Birmingham, on or about the 17th day of February 1903, to one *Albert Howard Scott* of metallic articles known as "Gig Hunters" and "Twig Hunters," manufactured in infringement of both the Patents;
25 (3) that the Plaintiff believed that the Defendant had manufactured, sold, and offered for sale large numbers of articles tapered or shaped in infringement of both the Patents, but was unable until he should have obtained discovery to give further and better Particulars of the said manufacture, sale, and offering for sale, but would, however, claim to recover full
30 compensation from the Defendant for all such infringements.

The Defendant delivered a Defence, but it was afterwards ordered to be struck out. The Plaintiff moved for judgment, and the action came on as a short cause.

A. J. Walter and Sinclair (instructed by *Sharpe, Parker & Co.*, agents for
35 *Newey & Son*, of Birmingham), appeared for the Plaintiffs; the Defendant was not represented.

Sinclair, for the Plaintiff.—This is an action to restrain the Defendant from infringing two Patents. The Defendant does not appear, and therefore I ask

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for judgment in default of Defence, for an injunction in the terms claimed, an inquiry as to damages, and delivery up or destruction of the infringing articles.

JOYCE, J.—I will make the usual Order.

Sinclair.—I ask for a Certificate that the Particulars of Breaches were 5 reasonable and proper.

JOYCE, J.—I do not see how I can give that Certificate unless the Particulars are gone into. Is there any authority for so doing?

Sinclair.—I cannot give a reported case, but in four cases in which I have been personally concerned an Order similar to that for which I am asking 10 has been made by the Lord Chief Justice without going into the Particulars.

JOYCE, J.—I think that I must look at the Particulars of Breaches.

Sinclair.—The Lord Chief Justice did not look at the Particulars, but concluded from the Defendant not appearing that they were reasonable.

JOYCE, J.—How can I certify that they are reasonable and proper unless I 15 look at them?

Sinclair.—It is under section 29, subsection 6, of the Patents, &c., Act, 1883.

JOYCE, J.—Taking the Particulars: the first the Defendant has admitted. His Defence is struck out.

Sinclair.—Yes.

JOYCE, J.—You have alleged I suppose in the Statement of Claim that he has 20 done this?

Sinclair.—Yes.

JOYCE, J.—I do not think there is any difficulty about No. 1. You understand my objection is to certifying Particulars of Breaches without considering them. 25 I see no difficulty about No. 1. What about No. 2? [No. 2 was read.]

Sinclair.—That is the particular instance of the general complaint made in paragraph 1. If there is no difficulty about paragraph 1 there is no difficulty about paragraph 2.

JOYCE, J.—Paragraph 2 goes further. It gives particulars of the sale. Has 30 the Defendant admitted that paragraph by not putting in the Defence? If you can persuade me of that I can see my way.

Sinclair.—Yes, because the Statement of Claim and Particulars of Breaches are one pleading.

JOYCE, J.—I will certify as to 1 and 2, but you cannot get No. 3. There 35 is nothing in No. 3.

Saccharin Corporation, Ltd. v. Skidmore.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE FARWELL.

December 1st, 1903.

SACCHARIN CORPORATION, LD. v. SKIDMORE.

- 5 *Patents.—Action for infringement.—Judgment on default of appearance.—Certificate given that certain of the Particulars of Breaches were reasonable and proper.—Patents, &c. Act, 1883, section 29.*

This was an action by the *Saccharin Corporation, Ltd.*, against *George Enoch Skidmore*.

- 10 The Statement of Claim alleged—(1) that the Plaintiffs were the registered proprietors of the following Patents :—(A) No. 25,273 of 1894 ; (B) No. 5135 of 1895 ; (B) No. 1164 of 1897 ; (B) No. 3680 of 1898 ; (A) No. 9962 of 1899 ; (B) No. 19,629 of 1899 ; (A) No. 4525 of 1900 ; (2) that a certificate of validity had been granted in respect of Patent No. 25,273 of 1894 ; (3) that the Defendant had infringed one of the three Patents marked (A) and one of the four Patents marked (B) in manner appearing by the Particulars of Breaches. The Plaintiffs claimed an injunction to restrain the Defendant from infringing the Patents, or any of them, and the usual consequential relief.
- 15 The Particulars of Breaches were as follows :—“ 1. Prior to the issue of the
- 20 “ writ in this action, and subsequent to the date of the several Letters Patent in “ the Statement of Claim referred to, the Defendant has infringed one of each of “ the groups of Patents marked (A) and (B) respectively in the Statement of “ Claim set out by the importation, sale, offer for sale, and use of saccharin. The “ saccharin so imported, sold, offered for sale, used and dealt in, was manufactured
- 25 “ from toluene sulpho chloride according to the process described in the Specifi- “ cation of one of the four said Patents marked (B) and as claimed in all the “ claiming clauses of the said Specification. The toluene sulpho chloride from “ which the said substances were so manufactured as aforesaid was manufactured “ according to the Specification of one of the three Patents marked (A) in the
- 30 “ Statement of Claim, and as claimed in all the claiming clauses of the said “ Specification. (2) In particular the Plaintiffs complain of the purchase by “ the Defendant from one *John Arthur Hopkinson*, of 9, Malvern Street, “ Bury, between the end of April and the middle of August in the year 1903, “ of between 70 and 80 tins of saccharin ; the said saccharin was partly used
- 35 “ and partly resold by the Defendant to persons whose names are not known “ to the Plaintiffs, and all the said saccharin was manufactured as aforesaid. “ (3) Until discovery shall have been obtained the Plaintiffs are unable to give

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"further and better Particulars of the Defendant's infringements, which have been very extensive, but the Plaintiffs will claim to recover in respect of all infringements."

The action came on upon motion for judgment in default of appearance by the Defendant. 5

Walter (instructed by *J. H. and J. Y. Johnson*) appeared for the Plaintiffs.— I ask for an injunction restraining the Defendant from infringing the Patents; an inquiry as to damages; the costs of the inquiry to be reserved; an Order on the Defendant to deliver up infringing articles; payment of the taxed costs of the action, and, so far as they relate to No. 25,273 of 1894, the costs to be taxed as between solicitor and client. Then I ask for a Certificate under the 29th section of the Act that the Particulars of Breaches are reasonable and proper. Under the Act I have to get a Certificate either that they have been proved, or that they are reasonable and proper. 10

FARWELL, J.—How am I to determine that? 15

Walter.—Would your Lordship look at the Particulars of Breaches. The first is a general paragraph, and the second is, in particular:—"The Plaintiffs complain of the purchase by the Defendant from one *John Arthur Hopkinson*, of "9, Malvern Street, Bury, between the end of April and the middle of August "1903, of between 70 to 80 tins of saccharin. The said saccharin was partly "used, and partly resold by the Defendant to persons whose names are not "known to the Plaintiffs." The practice has been on motions for judgment to certify that the Particulars of Breaches are reasonable and proper. The Court has said that where the Defendant does not appear or does not defend the action, it must be taken as against him that the statements made are correct and that the Particulars of Breaches are reasonable and proper. The Plaintiffs cannot get any costs of the Particulars of Breaches unless your Lordship so certifies. 20

FARWELL, J.—It is a very small matter apparently, if it is only that one paragraph. 25

Walter.—That is all. 30

FARWELL, J.—Very well, as far as I can see it seems reasonable.

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Waldenstein v. Szalay.*

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BYRNE.

October 30th and December 8th, 1903.

SANDOW, SANDOW, LD., BROOKES, and
WALDENSTEIN v. SZALAY.

Patent.—Action for infringement of two Patents.—Injunction granted in respect of one.—Case as to the other not proceeded with.—Costs.

S., Ltd., were the proprietors of a Patent granted to J. R. for "Improvements in dumb-bells for physical culture exercises," and E. S. was the grantee of a Patent for "Improvements in dumb-bells for physical culture exercises." W. B. and E. H. W. were licensees of the right to use and enjoy the Patents respectively. At the trial the Patent of E. S. was not relied upon. The Defendant attacked the validity of the Patent of J. R. on various grounds, and denied infringement. It was decided that the Patent of J. R. was valid, and a certificate of validity was granted. The costs of the action and a Certificate that the breaches were proved were granted, but only in respect of the Patent of J. R.

Held, that the Specification claimed a combination; that it was not a claim for the invention of mere details; that it embodied a new principle or idea, was valid, and that the Defendant had infringed.

This was an action by Eugen Sandow, Sandow, Ltd., and two licensees, commenced on the 29th of June 1903, to restrain the infringement of Letters Patent (No. 17,855 of 1898) granted to Joseph Robinson for "Improvements in dumb-bells for physical culture exercises," and Letters Patent (No. 10,280 of 1899) granted to Eugen Sandow for "Improvements in dumb-bells for physical culture exercises." This Patent was not relied upon at the trial.

The Provisional Specification of Joseph Robinson was as follows:—"My invention relates to improvements in the construction of dumb-bells and consists in the application of one or more springs attached to the dumb-bell,

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" thus causing the dumb-bell to require a firm grip when held in the hand. The
" firm grip of the dumb-bell is intended to, and does cause a continuous tension
" of the muscles of the arms when used for physical culture exercises.

" My invention consists of one or more flat steel springs, steel spiral springs,
" rubber springs, or compressed air springs, or a combination of these several 5
" springs, attached to the interior, or in the handle portion of the dumb-bell in
" such a position and manner as to cause the dumb-bell to be firmly grasped
" when in use.

" My invention consists of a dumb-bell constructed of wood, compressed
" pulp, metal or other suitable material. The usual method of construction I 10
" adopt is to form the dumb-bell in two longitudinal sections and insert the
" steel or other springs between the two sections of the dumb-bells.

" My invention may be constructed by fixing the steel or other springs, by
" screws or other suitable means; a joint or hinge is fixed at one end of the
" inside of section, to allow the dumb-bells to open at one end, the springs 15
" being arranged so as to keep the two sections apart, when not being held in
" the hand. Two pieces of leather or rubber are attached to the open end of
" the sections to prevent the springs extending the sections too far apart.

" The special advantage is that by the application of a combination of springs,
" it causes a continuous tension of the muscles, thereby enabling a person using 20
" these dumb-bells to gain strength and health in a much more efficient manner,
" and with less exertion, causing the person to feel refreshed after such
" exercise."

The Complete Specification was as follows:—" My invention relates to
" improvements in dumb-bells, and consists in the application of one or more 25
" springs to the dumb-bell so as to cause the same to require a firm grip when
" held in the hand. This firm grip of the dumb-bell is intended to, and does,
" cause a continuous tension of the muscles of the arms wrists hands, and
" fingers when used for physical culture exercises.

" The invention consists principally in the application of flat, curved, or spiral 30
" springs, or a combination of several springs, to the interior or to the handle
" portion of the dumb-bell in such a position and manner, that when in use the
" grasp on the handle will cause the spring or springs, to be compressed.

" The dumb-bells may be constructed of wood, compressed pulp, metal or
" other suitable material. 35

" The manner in which my invention is to be performed or carried into
" practical effect will be readily understood on reference to the sheet of
" drawings hereunto annexed and the following explanation thereof.

" It will be obvious that various ways of giving this expansive action to the
" bar or handle may be adopted without departing from the distinctive features 40
" of my invention, but for the sake of illustration I have shown on the drawings
" various different forms which the invention may take.

" In the modification shown at Fig. 1 the bar *a* and the two 'bells' *b* are
" divided into two parts longitudinally, being hinged together at *c* at one end
" and a bow spring *d* fixed between the two to keep the two sections apart when 45
" not being held in the hand, the open hands being prevented from being
" extended too far apart by a band *e* of leather or other suitable material.

" In the modification shown partly in section at Fig. 2, the two sections are
" held together by screws *f* and are distended by coiled springs *g*.

" In Fig. 3 the two sections are separated by a bow spring *d* (as in Fig. 1) 50
" and are kept in place by steady pins *h* and are prevented from expanding too
" much by india rubber rings *e*.

" In the modification shown in longitudinal section at Fig. 4 and transverse
" section at Fig. 5 the 'bells' *b* are hollow and are divided transversely instead
" of longitudinally they are held together by a screw *f*. The handle consists of 55

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" a series of springs bars *a* bowed out in the centre, which must be compressed
" when the handle is grasped.

" The modification shown at Figs. 6 and 7 is somewhat similar, with the
" addition of a spiral spring *i* inside, the tension of which can be increased or
5 " diminished by turning the screw *f*.

" Figs. 8 and 9 resemble Fig. 2 with the exception that two coiled springs *g*
" are used at each end instead of one and the sections are kept from expanding
" too much by india rubber bands *e*.

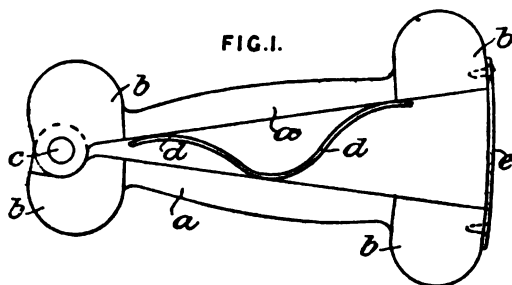


FIG. 2.

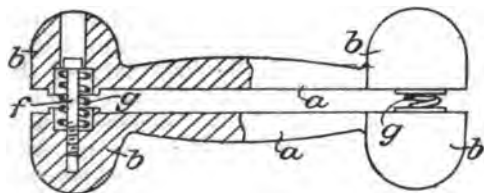
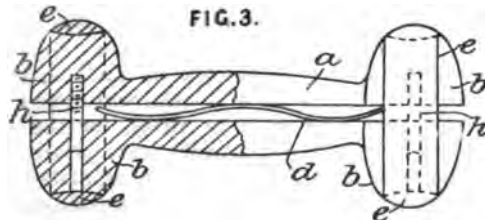


FIG. 3.



" In the modification shown partially in section at Fig. 10 the 'bells' *b* are
10 " made hollow with conical centres *j* inside, the handle is made of a series of
" bars *a* bowed in the centre, and with their ends *a'* beveled to fit against the
" cones inside the 'bells.' The latter are held together by the screwed rod *f*
" and the cones are forced inwards so as to expand the handle by coiled
" springs *g*.

15 " In the modification shown in partial sectional elevation at Fig. 11
" and transverse section at Fig. 12 the interior of each 'bell' *b* is made
" in a box form, and the ends of the curved bars *a* which form the handle
" fit inside the same being expanded by split circular springs *k* inside the
" cranked ends."

20 The Patentee claimed :—"The improvements in dumb-bells for physical
" culture exercises which consist in making the handle or bar (which unites

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"the two bells) compressible and at the same time resilient by means of springs, so that when in use the grasp of the hands compresses the springs thus causing a continuous tension and play of the muscles of the arms wrists and hands, thereby enabling a person using these dumb-bells to gain strength and health in a much more efficient manner and with less exertion than with the ordinary dumb-bells, in the manner substantially as hereinbefore described. 5
2. A dumb-bell having a handle consisting of two or more parts, and resilient means for expanding said parts, adapted to be compressed by the hand, substantially as and for the purpose hereinbefore described."

By their Statement of Claim the Plaintiffs (*inter alia*) stated that—(1) the Plaintiffs, *Sandow, Ltd.*, were the owners of the Patent No. 17,855 of 1898, and that *Joseph Robinson*, the grantee, was the first and true inventor of the invention described in that Patent; (2) that the Plaintiff *Eugen Sandow*, the grantee of the Patent No. 10,280 of 1899, was the owner thereof; (3) the Plaintiffs *Brookes* and *Waldenstein* were licensees from *Sandow, Ltd.*, and *Eugen Sandow* of the right to use and enjoy the Patents above respectively mentioned; (4) that the Defendant had infringed the Patents; (5) and that he threatened and intended to continue such infringements. They claimed an injunction and the usual consequential relief. 10 15

By their Particulars of Breaches the Plaintiffs stated—(1) the Defendant had at various times previously to the commencement of the action, and subsequently thereto, infringed both the Patents "by making, selling, and making profitable use of certain dumb-bells and other appliances being the same, or essentially the same, as the dumb-bells or appliances described in and covered by the above Specifications respectively and claimed by Claims 1 and 2 of the first mentioned Specification and by the first claim of the second." (2) They complained of the sale by the Defendant of two pairs of dumb-bells "only colourably differing from dumb-bells described in and covered by the said respective Specifications"; (3) of the sale by the Defendant of large numbers of such dumb-bells to divers persons whose names were not known on dates not fully known to the Plaintiffs; (4) of the manufacture for sale and the use of a certain dumb-bell, which was produced in Court by the Defendant. 20 25 30

By his Defence the Defendant, in paragraphs 1, 2, 3, and 4, traversed paragraphs 1, 3, 4, and 5 of the Statement of Claim, and stated that (5) the Patents were not new, nor were they ever good or valid, for the reasons given in the Particulars of Objections. (6) The Plaintiffs were aware of and had acquiesced in the acts of the Defendant, and if such acts constituted infringement (which was denied) the Plaintiffs, in so far as the relief consisted of damages or of an account of profits, were barred by laches and acquiescence. 35 40

By the Particulars of Objections the Defendant stated (*inter alia*), (A) As to Letters Patent No. 17,855 of 1898.—(1) The Defendant has not infringed the Patent; (2) the alleged invention comprised therein was not proper subject-matter in that it did not involve the exercise of any invention or ingenuity, and did not point out any sufficient improvement; (3) the second claim was too wide and too general, and comprised more than he had (if anything) invented; (4) the Complete Specification was ambiguous, and did not sufficiently describe the materials or things directed to be used; (5) the alleged invention was not new at the date of the Patent by reason of the following prior publication and prior user; (6) *Publication*.—The publication within the realm in the following Specifications, filed in the Patent Office: (a) *James Brotherhood*, No. 3556 of 1835; (b) *Percival Everitt*, No. 13,259 of 1899; and (7) by three books, deposited in the Patent Office Library in 1897, on physical culture and gymnastics, edited by Colonel *Amoros*, entitled 'Manuel Complet d'Education Physique,' and described in Vol. I., pages 67, 68, and 69, and 50 55

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- "illustrated on pages 11 and 17 of Vol. III.; (8) *Prior user, manufacture, and publication*.—(a) By an appliance known as '*Spencer's Grip*,' manufactured at the works of Messrs. *Gillman and Spencer*, and used in 1895 by the Defendant and others, including the members of '*The Weight Lifting Club*'; (b) the user in 1892 by *A. W. Spencer*, at *F. Galton's* Anthropometric Laboratory in the South Kensington Museum, of a dumb-bell hand-grip or appliance then known as '*Salter's Dynamometer*,' substantially the same as the dumb-bells described and claimed by *Robinson*; (9) for many years prior to *Robinson's* Patent it was common knowledge amongst athletes and in schools of physical culture in England, that tension and play of the muscles of the arms, wrists, and hands was produced by gripping steel springs, and such method was constantly practised. *Robinson's* alleged invention was only an example of this method, and did not possess subject-matter for valid Letters Patent." [Objections to Patent No. 10,280 of 1899 were then given.]

The action came on for trial before BYRNE, J.

Terrell, K.C., and *O. Leigh Clare* (instructed by *G. E. Lewis*) appeared for the Plaintiffs; *P. H. V. Nicolas* (instructed by *E. F. Weldon*) appeared for the Defendant.

- Terrell, K.C.*, opened the Plaintiffs' case.—The Patent of *Robinson* covers the whole of the available field of invention. The object of the motion of compression is not for the purpose of strengthening the fingers, but in order to induce a firm grip whilst developing the muscles of the arms. Figs. 1, 2, and 3 sufficiently show the modifications. The invention has been a great success. Large numbers of the dumb-bells have been sold, consequently other persons have tried to share in the profits, and amongst them the Defendant. The Defendant's dumb-bell is a slavish imitation of Fig. 2. It is a dumb-bell with "bells" on each side and a place for grip in the middle. Instead of using two springs he uses india-rubber balls.

- Evidence was then adduced on behalf of the Plaintiffs and the Defendant.

- P. H. V. Nicolas* for the Defendant.—*Robinson's* Complete Specification is ambiguous in that it does not sufficiently describe the materials and things to be used—*e.g.*, on page 2, line 5, the word "springs" is not defined. "Springs" is a generic term and includes all springs. The second claim is ambiguous and too wide, and is a claim to a principle (*Scott's Patent*, 20 R.P.C. 257; *Booth v. Kennard*, 26 L.J. Ex. 305; *Wegmann v. Corcoran*, L.R. 13 C. D., pages 65, 67, 82). It claims two old things, and the result is not new (*Dowler v. Keeling*, 15 R.P.C. 214). If it is a combination it does not come within *Proctor v. Bennis* (4 R.P.C. 333; L.R. 36 C.D. 741), and therefore the doctrine of mechanical equivalents does not apply, and if it is within *Curtis v. Platt* (L.R. 3 C. D. 135n), and is a claim for an improvement in old things to produce an old result, it must be strictly construed (*Pneumatic Tyre Company, Ltd. v. New Lamb Tyre Company*, 19 R.P.C., pages 384, 389; *Ticket Punch Register Company, Ltd. v. Colley's Patent*, 12 R.P.C. 171). To constitute infringement the substance of the invention must be taken. If "springs" were confined to steel springs then the Defendant would not infringe. The "pith and marrow" is not taken. There is no subject-matter. No invention or ingenuity was required to produce the article (*Harwood v. Great Northern Railway Company*, 11 H.L.C. 654; *Shaw v. Burton and Loudon*, 12 R.P.C. 262; *Longbottom v. Shaw*, 8 R.P.C. 333).

- Terrell, K.C.*, in reply.—Specifications are construed by the Courts as an ordinary person in the trade would construe them on reading the Specification with the knowledge of the state of the art existing at the date of the Specification. The first question is—What is the Patentee's invention? The second question is—Has the Defendant taken it? The invention here is the

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making an article having the capacity of a dumb-bell combined with that of a grip. The Patentee explains the way in which it may be accomplished. "Springs" means any kind of spring known at the time which would have the effect indicated. The knowledge at the date of the Specification is imported into all Specifications. The Patentee is not the inventor of a spring but of a dumb-bell with a spring action. It has been suggested that the doctrine of equivalents applies to one class of case and not to another; but if the Patentee produces a new invention, and shows only a particular way or ways of doing it, all other ways of doing it are infringements.

BYRNE, J.—This is an action for infringement of a Patent. The Plaintiffs' invention relates to improvements in dumb-bells for physical culture exercises. I need only refer to the Provisional Specification for the purpose of noticing that in lines 8 to 12 there is a certain reference made to steel, rubber, and compressed air springs. The words are: "My invention consists of one or more flat steel springs, steel spiral springs, rubber springs, or compressed air springs, or a combination of these several springs, attached to the interior, or in the handle portion of the dumb-bell in such a position and manner as to cause the dumb-bell to be firmly grasped when in use." The Complete Specification states what the Patentee's invention relates to and what it consists of. "My invention relates to improvements in dumb-bells and consists in the application of one or more springs to the dumb-bells so as to cause the same to require a firm grip when held in the hand. This firm grip of the dumb-bell is intended to and does cause a continuous tension of the muscles of the arms, wrists, hands and fingers when used for physical culture exercises." It will be noticed that springs are there spoken of without reference to material or to the precise nature of them. He then proceeds: "The invention consists principally in the application of flat, curved or spiral springs or a combination of several springs to the interior or to the handle portion of the dumb-bell in such a position and manner that, when in use, the grasp on the handle will cause the spring or springs to be compressed." I note there that he states that his invention consists principally in the application of these springs. Then follows a reference to the Drawings which are annexed, and in lines 14 to 17 he says as follows:—"It will be obvious that various ways of giving this expansive action to the bar or handle may be adopted without departing from the distinctive features of my invention; but for the sake of illustration I have shown on the drawings various different forms which the invention may take." The illustrations show various forms of dumb-bells, all having springs more appropriate to the use of steel or metal, but in Fig. 2 the use of india-rubber bands outside is indicated to prevent too great extension. Then he claims—(1) "The improvements in dumb-bells for physical culture exercises which consist in making the handle or bar (which unites the two bells) compressible and at the same time resilient by means of springs, so that when in use the grasp of the hands compresses the springs thus causing a continuous tension and play of the muscles of the arms, wrists, and hands, thereby enabling a person using these dumb-bells to gain strength and health in a much more efficient manner and with less exertion than with the ordinary dumb-bells, in the manner substantially as hereinbefore described"; and (2) "A dumb-bell having a handle consisting of two or more parts and resilient means for expanding said parts, adapted to be compressed by the hand, substantially as and for the purpose hereinbefore described." Claim No. 1 appears to me to refer obviously to page 2, lines 5 to 9,* and Claim No. 2 to page 2, lines 14 to 17.†

* *Ante*, page 34, lines 30 to 33.

† *Ante*, page 34, lines 39 to 42.

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The first point to notice on the Specification is that there is no reference in the Complete Specification to compressed air springs specifically, such a reference having been contained in the Provisional Specification, but reading the two fairly I do not think that it is left out as an abandonment of any form of spring. The Complete Specification leaves out the word "steel" in reference to the flat, curved, or spiral springs spoken of in the Provisional Specification, and it obviously would take in whalebone, cane, india-rubber, compressed air, or metal of any kind, such as copper, aluminium, iron, or anything else in the nature of a spring which would give the effect the Patentee desires to produce.

I think the intention is to enlarge and not to diminish the nature or material of the springs as mentioned in the Provisional. I heard some extravagant suggestions as to the meaning of the word "dumb-bell," as, for instance, that it would include a little bit of stick held in the hands of a runner, but I am content to take the definition which I find in the New English Dictionary, which accords with my previous notion of the import of what I thought a familiar English word as well as with the description given by Mr. *Dugald Clerk*. Passing by the original meaning, which was literally a dumb bell—that is to say, a bell which when pulled gave no sound—I find "(2) An instrument of wood or iron consisting of a short bar or connecting piece weighted at each end with a roundish knob; used in pairs which are grasped in the hands or swung for exercise." Put shortly, the substance of the Plaintiffs' invention is a combination of springs with dumb-bells so as to compel a grip while the dumb-bell is being used. It appears to me to be an ingenious invention and one involving a principle.

I do not think that the second claim is too wide or general, nor do I think that it comprises more than the inventor has invented. It defines a combination with one handle consisting of two or more parts, with resilient means for expanding the parts, adapted to be compressed by the hand, "substantially as and for the purpose hereinbefore described." I find no ambiguity in the Specification beyond the point as to material, which I have dealt with; nor do I think that it does not sufficiently describe the materials or things therein directed to be used. So long as expansive action is given to the bar or handle by means of springs which will give such action, the material or shape of the springs is unimportant.

As to the alleged prior publications I do not find that the Specifications or the passages from the "*Manuel Complet d'Education Physique*" show prior publication. Neither *Spencer's* grip nor *Salter's* dynamometer have any resemblance to dumb-bells. To exercise fingers and wrists and to measure strength of grip are objects quite different from the object of dumb-bells which are to exercise the muscles of the arms as well as of the wrists, hands and fingers. The notion of swinging any of the things referred to in dumb-bell fashion is absurd.

There remains the question of infringement. The Defendant has substituted the use of two india-rubber balls, or in other words, air springs, confined between the longitudinal sections of the dumb-bells for the metal springs used in practice by the Plaintiffs. In effect the only suggestion of novelty or variation in the Defendant's instrument from what the Plaintiffs use in practice, as being the best form of what is patented, is that he has substituted india-rubber balls or air springs for metal springs. Mr. *Nicolas*, who argued the case for the Defendant with care and ability, relied strongly on the point that the Patent being for a combination of parts, to constitute an infringement the whole combination must be taken. There is ample scope for argument in comparison of authorities where observations necessarily made in reference to particular facts are compared with those made in another set of circumstances, but, of course, the only value of

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authorities is as laying down principles to guide the Court, or, as affording illustrations of the effect of applying such principles. From the recent case in the Privy Council of the *Consolidated Car Heating Company v. Came*, reported in the 20th Volume of Reports of Patent Cases, their Lordships' opinion having been given by Lord *Davey*, I read this passage, which begins on page 765. Lord *Davey* said— 5

" Their Lordships cannot adopt the view apparently taken by the learned Chief Justice that the matter is to be determined simply on reading the Specification. " They think that, according to established authority, the Court is bound to " decide, as a fact, whether the alleged infringer has taken the substance of the " invention, and in forming an opinion on that question to have regard to the 10

" evidence as to the existing state of knowledge on the subject at the date of " the Patent, and as to the operation of the machine." He then proceeded to cite the well-known passage, which I will not read again, from *Clark v. Adie* which was cited also in the course of the argument in the present case. Then further down he referred to *Proctor v. Bennis*, and said—" In *Proctor v. Bennis*, Lord 15

" Justice *Cotton* said—" In my opinion omissions and additions may be very " material in considering whether, in fact, the machine of the Defendant is an " infringement of the combination which the Plaintiff claims; but if the " Defendant really has taken the substance and essence of the Plaintiff's com- 20

" bination, the mere fact that certain parts are omitted or certain parts added " cannot prevent his machine from being an infringement of the Plaintiff's " Patent." Then at a later period Lord *Davey* added—" In determining the " question whether the substance of the invention is taken, it is important to " consider the position of the Patent with reference to the previous knowledge 25

" on the subject. For if the merit consists in the idea or principle which is " embodied in it, and not merely in the means by which that idea or principle " is carried into effect, a machine which is based on the same idea or principle " may still be an infringement, although the detailed means for carrying it into " effect may be somewhat different." In my judgment the Defendant has 30

taken the essence and substance of the Plaintiffs' invention, and, as used in practice, apart from some immaterial differences, has only substituted one kind of spring for another.

The invention in the present case is not mere detail, but embodies a new principle or a new idea, and in my view the reasoning applied in *Proctor v. Bennis* applies, and I think the Plaintiffs are entitled to their injunction. 35

Certificates that the validity of *Joseph Robinson's* Patent had come in question, and that the alleged breaches thereof had been proved were granted. The costs of the action were given to the Plaintiffs, except so far as they had been incurred by reliance on *Sandow's* Patent.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE SWINFEN EADY.

December 9th, 10th, and 12th, 1903.

GEIPEL v. LORD MAYOR, ALDERMEN, AND CITIZENS OF MANCHESTER.

- 5 *Patent. — Action for infringement. — Subject-matter. — Combination. — Infringement. — Patent held valid.*

In 1893 a Patent was granted to G. for "Improvements in steam traps." In 1894 another Patent was granted to G. for "Improvements in steam traps." The traps in question were expansion traps. The 1894 Patent was in effect for
 10 *a combination of a lever and spring operating the valve of the steam trap. The Defendants in an action for infringement of this Patent pleaded a number of prior publications, and contended that all that the Plaintiff had done was to take a well known mechanical contrivance and apply it to a subject to which it had not been hitherto applied, and that there was no invention.*

- 15 *Held, that the Plaintiff's invention had not been anticipated, and that the arrangement of his combination required the exercise of considerable ingenuity; that the Patent was valid, and the Plaintiff entitled to succeed.*

On the 18th of April 1893, Letters Patent (No. 7860 of 1893) were granted to William Geipel for "Improvements in steam traps." These Letters Patent
 20 *were the subject of a Petition for revocation by C. H. Berry, which was heard, in June 1903, by Buckley, J. (20 R.P.C. 545). The Provisional and Complete Specifications are there set out, together with the material drawings. The Judge held that there was subject-matter, but that there was disconformity, and Ordered "That the Patent be revoked unless within three months, or such*
 25 *"further time as the Court may allow, the Patentee obtains leave to amend his Specification by disclaiming Fig. 2 and Fig. 6."*

At the date of the trial of the present action an appeal against the decision of Buckley, J., was pending. The writ in this action was issued the 20th of January 1903, and the action was one for infringement of Letters Patent No.
 30 *21,571** of 1894, granted to William Geipel for "Improvements in steam traps."*

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The Complete Specification is as follows:—"This invention relates to improvements in steam traps of the kind known as 'expansion traps' by means of which water of condensation is automatically allowed to escape from steam pipes, cylinder jackets and other receptacles with which the steam traps are connected, whilst any considerable escape of steam is automatically prevented, and it has for object to provide steam traps of this kind which shall be more reliable and durable than those heretofore in use, and which shall also be readily accessible and capable of being easily repaired.

"It is found that in steam traps worked on the expansion principle, such as the traps described in the Specification of my Patent No. 7860 dated 18th April 1893, or that described in Specification No. 995 dated 8th January 1884, or Specification No. 1876 dated 18th July 1871, and others of a like kind, if the valve is set to work with a certain steam pressure and this pressure, and therefore the temperature, happens to be increased, there is consequently extra expansion which causes straining of the trap, or damage to the valve face. Or the trap may in this way have a permanent set imparted to it, so that it requires re-adjustment before it will again operate to prevent the discharge of steam at the lower pressure, otherwise there will be continual leakage of steam.

"Now this invention has reference to improved constructions and arrangements of means designed to obviate this disadvantage, as I will now proceed to explain by reference to the accompanying drawings wherein,

"Fig. 1 is a side elevation showing my present invention applied to a steam trap of the kind shown in and described with reference to Figs. 1, 3 and 6 of my said former Specification No. 7860 of 1893. In this figure k is a lever pivoted at k^1 , one of its arms bearing against the valve spindle a while its other end is acted upon by the coiled spring d which encircles a stud l and is arranged between the body of the trap and the lever. g are adjustable nuts on the stud l to limit the extent of outward movement of the corresponding arm of the lever, and consequently the normal extent of opening of the valve. It will be seen that the spring cannot press the lever further outward than the nuts will allow, so that when the lever is in the outward position, the contraction of the tubes h opens the valve and allows the discharge to take place. Should there be excessive expansion of the tubes, the lever k simply compresses the spring d thus avoiding straining of the trap or cutting of the valve face. The principle upon which motion is given to the free end of the pair of tubes h is not here claimed as new. It is clearly explained in the Specification of my above mentioned former Patent No. 7860 of 1893, and, as will be seen from the drawings, in the application of my present invention, the valve a^1 is placed at the free end of the said pair of tubes h .

"Fig. 2 shows a similar arrangement to that represented in Fig. 1, but in which the lever k is acted upon by a flat spring d^1 instead of a coiled spring.

"The lever k in the arrangement shown in Figs. 1, and 2 may be extended, as shewn at k^2 , to form a handle by depressing which the valve a^1 can be left free to move away from its seat and permit steam to blow through the trap for any desired length of time.

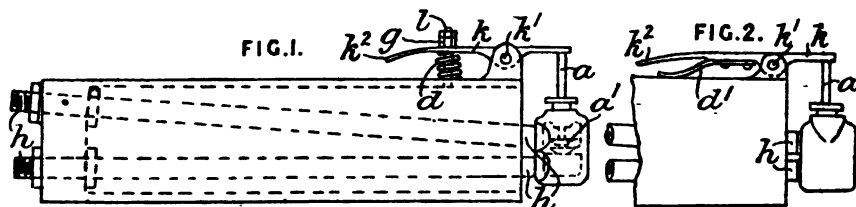
"So far as concerns the steam traps described in my said prior Specification No. 7860 of 1893, I do not limit myself to the use of the helical spring, nor to the combination with the trap of a spring and lever as shown in Figs. 1 and 2, as other forms of springs may obviously be applied, for example the bracket b Fig. 1 may be made so as itself to provide the necessary elastic property.

"It will be obvious that the springs must in each case be of sufficient strength to hold the valve against the pressure of steam for which the trap is required.

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" Having now particularly described and ascertained the nature of the said invention and in what manner the same is to be performed I declare that I do not claim broadly the use in a steam trap of a spring arranged to obviate the straining of the trap or damage to the valve face when the trap is sub-

- 5 " jected to excessive steam pressure, but that what I do claim is :—
 " The combination with the valve of a steam trap of the kind described in the Specification of Letters Patent No. 7860 of 1893, of a lever and spring arranged and operating substantially as hereinbefore described with reference respectively to and shown in Fig. 1 and in Fig. 2 of the drawings
 10 " annexed."



- By the Statement of Claim* the Plaintiff stated (*inter alia*) that (1) he was the registered proprietor of Patent No. 21,571** of 1894, for inventions of "Improvements in steam traps." (2) By a decision of the Chief Examiner, dated the 27th of December 1901, the final Specification of this Patent was
- 15 amended, and the claiming clause of the final Specification was, before amendment, framed in good faith and with reasonable skill and knowledge. (3) The Defendants had infringed in the manner appearing in the Particulars of Breaches. He claimed an injunction, damages or an account of profits, delivery up or destruction of infringing articles, and costs.

- 20 The Particulars of Breaches stated (1) that the Defendants had infringed the Patent by the use of steam traps constructed according to the invention described in the final Specification of the Patent, and claimed in the claiming clause. (2) That in particular the Plaintiff complained of the use by the Defendants, at their electrical power stations in the city of Manchester, in and
- 25 prior to January 1903 and December 1902, of steam traps known as "Berry" traps, constructed according to the Plaintiff's invention.

- The Defendants, by their Statement of Defence, stated that (1) they denied that the final Specification, or the claiming clause thereof, of the Patent No. 21,571** of 1894 was, before amendment, framed in good faith and with
- 30 reasonable skill and knowledge; (2) they had not infringed the Patent; (3) the Patent was invalid upon the grounds set out in the Particulars of Objections.

- The Particulars of Objections were (1) want of novelty; (2) prior publication; (3) want of subject matter; (4) want of utility. The Defendants relied upon a
- 35 number of Specifications, viz., *Brown* (U.S.A., No. 43,090 of 1864); *Turnbull* (No. 6366 of 1893); *Geipel* (No. 7860 of 1893); *Jeffery* (No. 12,513 of 1890); and also upon those set out at page 549 of 20 R.P.C.; and upon the common general knowledge in the trade of the construction and working of steam traps.

* The Statement of Claim as originally drawn included a claim in respect to Letters Patent No. 7860 of 1893, the subject of the Petition, but notice of withdrawal of this claim was given on the 9th of July 1903.

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Bousfield, K.C., and *A. J. Walter* (instructed by *Faithfull and Owen*) appeared for the Plaintiff; *T. Terrell*, K.C., and *J. H. Gray* (instructed by *Frank Evelyn Jones*, agent for *W. T. Hill*, of Manchester) appeared for the Defendants.

Bousfield, K.C., opened the Plaintiff's case.—In the first instance there were 5
two Patents sued upon, viz., *Geipel* (No. 7860 of 1893), and *Geipel* (No. 21,571**
of 1894), an improvement upon the first. Notice of discontinuance was given
with regard to the first Patent. That Patent was the subject-matter of a
decision of *Buckley*, J., in a Petition for revocation. He held that Fig. 2 was
bad because it would not operate, and that Fig. 6 was bad because it was not 10
within the Provisional Specification. That left the main subject of the Patent
untouched, but in regard to Fig. 6 the matter was under appeal. [He then read
and explained the Specification.] The sales of the Plaintiff's apparatus were :
in 1895, 102; 1896, 464; 1897, 600; 1898, 1132; 1899, 1569; 1900, 2062;
1901, 2463; 1902, 2452. For such an apparatus these were large sales. The 15
nominal Defendants were the Corporation of Manchester, the real Defendant
being Mr. *Berry*. He was formerly the Plaintiff's traveller, but left in 1901.
The Petition before referred to against the first Patent was filed by him.

The following witnesses were called for the Plaintiff :—*James Swinburne*
and *William Geipel* (the Plaintiff). 20

Terrell, K.C., opened the Defendants' case.—The invention relied upon
was a combination of a spring with a trap, and its object was to avoid the
jamming or the straining of the valve seating common to all traps. But a
spring had been used prior to the Patent to obviate the difficulty, and so there
was no subject-matter for invention. 25

The following witnesses were called for the Defendant :—*W. W. Beaumont*
and *G. Croydon Marks*.

T. Terrell, K.C., summed up the Defendants' case.—*Buckley*, J., held that
the essence of the invention claimed in the 1893 Specification was the applica-
tion of the principle of differential expansion, and that Fig. 6 of that Specifica- 30
tion was not for differential expansion, but was for controlled expansion, and
therefore there was disconformity. Fig. 2 of the same Specification he decided
was bad because it would not work. That left two Figures, viz., 1 and 3, both
for differential expansion. The Plaintiff contended that the invention in the
1894 Specification was the application of the particular kind of spring and 35
lever to such traps as shown in Fig. 1 of 1894. But the Specification showed
that it would be the same as when applied to Fig. 6 of 1893. Fig. 1 of
1894 was therefore for controlled expansion. The question to be decided was
whether the application of the spring and lever attachment to Fig. 3 of 1893, as
shown in Fig. 1 of 1894, was good subject-matter. The principle to be applied 40
was settled by *Harwood v. Great Northern Railway Company* (11 H.L.C. 654).
What was done in the 1894 Patent was to apply a well known mechanical
contrivance to obviate exactly the same injury that the well known mechanical
contrivance had been used to obviate before.

Bousfield, K.C., in reply.—The construction put upon the Specification by the 45
Defendants—i.e., that it was no more than an application of a spring to the first
Specification—is inaccurate. The Plaintiff had used the principle enunciated
in the first Specification and turned it into a practical working thing. The
claim was for a particular combination, arranged and operating in a specific
manner. The principle laid down in *Harwood v. Great Northern Railway* 50
had no application here. That case was never applied to the case of a mechanical
combination or an apparatus interacting to produce a given result simply
because some separate parts had been used for similar purposes. It was not
so laid down in *Vickers v. Siddell* (7 R.P.C. 292). *Geipel's* claim was for a
combination including a lever, spring valve seat, &c., and the Defendants had 55
infringed it.

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SWINFEN EADY, *J.*—The Plaintiff claims an injunction to restrain the Defendants from infringing his Patent of 1894 for improvements in steam traps, and for damages. The action originally extended to another Patent of 1893, but that portion of the action has been discontinued. The Defendants are
5 the Corporation of Manchester. It is not disputed that they are using a steam trap manufactured by Mr. *Berry*, who was formerly in the employ of the Plaintiff, or of his firm of *Geipel and Lange*, as traveller, and which steam trap is identical with that forming the subject-matter of the Plaintiff's 1894 Patent, as it now stands amended. The only question is whether the Plaintiff's Patent is
10 valid, the Defendants insisting that the invention is not the proper subject-matter of Letters Patent.

Previous to the date of the Patent in question, the Plaintiff had described and specified a steam trap or apparatus for automatically draining the water arising from condensed steam, in cylinders or other steam receptacles. The trap was
15 of the species known as expansion traps—that is to say, was operated by means of the unequal expansion of metals. According as the pipes are hot or cold, the relative lengths thereof alter, and cause movement, which operates a valve; the passage of steam heats the tube possessing the greatest co-efficient of expansion, and causes that tube to expand most; its movement shuts a valve and
20 prevents the further escape of steam; when water has formed in sufficient quantity to again cool the pipe, its contraction opens the valve and allows this water to escape, and the passage of steam then heats the tube again, and the process is repeated.

It was found in practice, that these traps possessed two disadvantages. If the
25 pressure of steam rose beyond that for which the valve was set, the increased pressure, and correspondingly the increased temperature, operated injuriously on the valve and its seat; after the valve had been pushed hard on its seat, the strain continued, and the valves got quickly cut, and the cutting of the valve destroyed the seat, or some permanent set or distortion of the trap was caused,
30 so that when the steam pressure fell again to its normal condition the valve was damaged, and allowed live steam to pass, and the trap would not work properly without readjustment. The other disadvantage was that there was no hand blow-through; that is to say, the valves could not—at all events conveniently—be operated by hand, so as to be opened to allow the steam to blow through,
35 and then closed again, without affecting the seating or adjustment of the valves.

It was to obviate these two disadvantages, that the Plaintiff arranged a combination, which is the subject of his 1894 Patent. He introduced a lever, one of the arms of which bears against the valve spindle, and the other is acted upon
40 by a spring, placed between the body of the trap and the lever, and coiled round a stud, upon which are adjustable nuts, to limit the extent of the outward movement of the arm of this lever. If there is excessive expansion of the tubes, caused by the steam pressure rising above the normal, for which the valve is set, the lever simply presses the spring, which yields, and thus avoids
45 any straining of the trap, or cutting of the valve face. The valve obtains a yielding abutment, instead of a rigid abutment. Moreover, the arm of the lever, against which the steam presses, is extended to form a handle, so that by merely pressing the handle by hand or by foot the valve is opened, and steam may be blown through the trap for so long as may be desired. It is not disputed
50 that this arrangement is a great improvement on the trap of 1893; it has proved commercially successful; while not more than two or three traps of the 1893 pattern have ever been sold, the sales of the 1894 pattern, in this country, are as follows:—1885, 102; 1896, 464; 1897, 600; 1898, 1132; 1899, 1569; 1900, 2062; 1901, 2463; 1902, 2452. The Plaintiff was not cross-examined on his
55 evidence, that his invention has made expansion traps practical and useful, and that there is no other expansion trap in the market which substantially competes

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with his, except the one made by *Berry*, complained of in this action. The Plaintiff's invention is simple, ingenious, and effective, and has made the apparatus more reliable and durable than before. The claim of the Plaintiff is a very restricted one; it is only a claim for the particular combination of a lever and spring with the valve of a steam trap arranged and operating as described 5 with reference to and shown in the drawings Fig. 1 and Fig. 2 in the amended Specification. The Plaintiff states in terms, in his Specification, that he does not claim broadly the use in a steam trap of a spring arranged to obviate straining or damage, when the trap is subjected to excessive steam pressure. It was urged by the Defendants that all that the Plaintiff had done was to take 10 a well-known mechanical contrivance, and apply it to a subject to which it had not hitherto been applied, and that there was no invention in that. In my opinion the arrangement of the new combination required the exercise of considerable ingenuity. In *Hinks v. Safety Lighting Company* (L.R. 4 C.D. 615), Sir *George Jessel* said this:—"On the one hand it was said, you never can 15 "support a Patent by substituting a round wick for a flat wick, as there is no "invention in that. On the other hand it was said, Why not? If it is a combination Patent, the very essence of a combination Patent is that it is a new "combination of known parts, and in fact very few machines are now "invented which contain any new part. As a general rule, every machine 20 "invented is made up of parts which are previously known. A new part of a "machine is very uncommon indeed; consequently that is an objection which, "per se, is not of great weight. But like every combination which is new, it "must have merit, and now how is a Judge to apportion the merit? I do not "know. As far as I can ascertain from the authorities the merit very much 25 "depends on the result produced. Where a slight alteration in a combination "turns that which was practically useless before into that which is very "useful and very important, Judges have considered that, though the invention "was small, yet the result was so great as fairly to be the subject of a Patent; "and, as far as a rough test goes, I know of no better." 30

The Defendants have pleaded a number of prior publications, but it is only necessary to refer to very few of them. With regard to *Royle* (No. 807 of 1877) and *Jensen* (No. 995 of 1884), Mr. *Beaumont*, who was called by the Defendants, stated that these did not contain the yielding spring which is an essential 35 feature of the Plaintiff's combination. In *Johnson* (No. 16,629 of 1884) there is no spring to relieve the pressure when the valve is being forced down on its seat, as Mr. *Swinburne* pointed out. *Stubbs* (No. 592 of 1887), where the spring is inside the steam space, bears no resemblance to the Plaintiff's; in that case it is the contraction and expansion of the spring itself which transmits the motion to the valve. The only other Specification necessary to mention is 40 *Turnbull* (No. 6366 of 1893); in this the spring is inside the steam space; the action of the trap would be probably just the same if the spring were removed, the only purpose of the light spring, as specified, being to keep the top plate bearing on the flange of the bolt, from which it is suspended; and the whole combination, as Mr. *Beaumont* stated, is quite a different combination from the 45 Plaintiff's. None of these publications are anticipations of the Plaintiff's invention.

In my opinion the Plaintiff's invention, the new combination which he claims, is proper subject-matter, and his Patent a valid one. Mr. *Berry* recognises its value by manufacturing an almost exact copy of it, which is used by 50 the Defendants. The Plaintiff is entitled to an injunction, and the costs of the action, with the usual inquiry as to damages or profits, and to a Certificate.

Ashworth v. Horsfall and Bickham.

IN THE CHANCERY OF THE COUNTY PALATINE OF LANCASTER.

MANCHESTER DISTRICT.

Before VICE-CHANCELLOR HALL.

December 21st, 1903.

5

ASHWORTH v. HORSFALL AND BICKHAM.

Patent.—Action for infringement.—Discontinuance of action by Plaintiff after Defence.—Costs of Particulars of Objections.—Certificate that Particulars were reasonable and proper applied for and refused.

On the 31st of July 1902 the Plaintiff commenced this action for damages for
10 alleged infringements, between the 31st of July 1896 and the 8th of December 1900, of his Letters Patent, numbered 16,047 of 1886, which had expired prior to commencement of action.

On the 15th of December 1902 the Defendants delivered their Statement of Defence, whereby they denied the validity of the Patent for reasons appearing
15 in their Particulars of Objections delivered therewith, and by such Particulars they set up a number of Specifications as prior publications, and also alleged want of subject-matter.

At the date of the commencement of this action an appeal to the House of Lords was pending in an action of *Ashworth v. English Card Clothing Company, Ltd.*, which was an action by the Plaintiff in this action for an alleged infringement of the same Patent as that in respect of which the present action was brought.
20

On the 25th of February and the 22nd of August 1903 Orders were made (in each case by consent) that all proceedings in this action should be stayed until
25 judgment in the said action of *Ashworth v. English Card Clothing Company, Ltd.*, should be delivered by the House of Lords.

On the 9th of November 1903 judgment in the said action was delivered by the House of Lords,* reversing the decision of the Court of Appeal† and restoring the judgment of *Joyce, J.*,‡ who had dismissed the Plaintiff's action
30 with costs and had certified, pursuant to section 29 of the Patents, Designs, and Trade Marks Act, 1883, that the Defendants' Particulars of Objections were reasonable and proper.

On the 18th of November 1903 the Plaintiff delivered notice of discontinuance of this action. The Defendants then took out a Summons that the Plaintiff
35 might be ordered to pay to the Defendants their costs of the action, including the costs of and incident to the Particulars of Objections delivered by the Defendants, and that a Certificate be granted pursuant to section 29 of the Patents, Designs, and Trade Marks Act, 1883, that such Particulars of Objections were reasonable and proper.

* 20 R.P.C. 790.

† 19 R.P.C. 463.

‡ 18 R.P.C. 367.

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The Summons came on for hearing before Vice-Chancellor HALL.

Radford (instructed by *Sampson and Price*, of Manchester, agents for *Clough and Crabtree*, of Cleckheaton) appeared for the Defendants; *Grant* (instructed by *Blair and Seddon*, of Manchester) appeared for the Plaintiff.

Radford submitted that the Particulars of Objections were identical in terms with some of the Objections in the action of *Ashworth v. English Card Clothing Company, Ltd.*, in which case the House of Lords upheld the decision of *Joyce, J.*, who dismissed the action with costs, and granted a Certificate that the Particulars of Objections were reasonable and proper, and he tendered in evidence an affidavit which he said showed the nature and course of the action (*Ashworth v. English Card Clothing Company, Ltd.*), and showed also the similarity between some of the Particulars of Objections in that action and those in the present action, but the VICE-CHANCELLOR refused to allow it to be read; referring to *Willcox and Gibbs v. Janes* (14 R.P.C. 523; L.R. (1897) 2 Ch. 71).

Grant was not called upon.

HALL, V.C.—I think this application fails. It is a case of an action for infringement of a Patent, which went as far as Statement of Defence and Particulars of Objections. After that it appears that there was another action against another Defendant pending in the High Court, and two Orders were made in this action in Chambers—and by consent—that proceedings should be stayed in this action until an appeal pending before the House of Lords in the action of *Ashworth v. English Card Clothing Company, Ltd.*, was disposed of, and the effect of those two Orders has been that this action has stood suspended until that appeal has been disposed of. I am told now that that appeal has been disposed of, and the Plaintiff in this action in this Court has discontinued his action as he was entitled to do without leave, and now the Defendants come and ask for the costs of their Particulars of Objections.

I think this case is governed by the observations of Mr. Justice Romer in *Willcox and Gibbs v. Janes* where he said, "I do not think the Court is of necessity bound to make a Certificate, if it is a proper case, at the trial only —it may do it at any time." Therefore I think that I could now, although after discontinuance, grant a Certificate if I thought it was a proper course to take. But Mr. Justice Romer said, "But it can only do it when, by reason of some application having been made to it or some sort of procedure having been taken before the Court in reference to the Patent, the Court comes to the conclusion that it knows enough about the case to be able to make a Certificate." Now if there had been an interlocutory motion before me or something of that kind where there were materials so that I could go into the matter and see what the nature of the case was then I could come to the conclusion that I knew enough about the case to be able to make a Certificate. Then his Lordship said, "In the present case I have no such materials." In this case I have no materials before me whatever. The only thing, as I have said, was the Order, by consent apparently of the solicitors, in Chambers that it should stand over until after another case against another Defendant in another Court had been disposed of.

I do not know anything about the Objections in that case. I refused to allow evidence to be gone into to see how far that action was identical with this action; and I do not know how far the Objections in that case were identical with the Objections in this case; therefore it seems to me that this Summons fails and it is dismissed with costs.

Radford.—I do not know whether your Honour thinks it is a case in which leave to appeal ought to be given.

HALL, V.C.—Yes, I think it is a hard case; but I am bound by the authorities. I give you leave to appeal if you want it.

Gonville v. Hay.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BUCKLEY.

December 4th, 1903.

GONVILLE v. HAY.

5 *Patent.—Licence belonging to partnership.—Dissolution of partnership.—Arbitration award.—Whether partner assigning his share in licence should covenant not to manufacture under the Patent.—Whether question within Arbitrator's jurisdiction.—Construction of terms of submission.—Motion to set aside award dismissed.*

- 10 *The owner of a licence under a Patent executed a declaration of trust of it in favour of a firm of which he was a member. A partnership action was commenced by G., one of the partners, and an Order was made for a stay of proceedings on certain terms, including an assignment by G. to his partners of his share in the partnership at a price to be fixed by arbitration, and a term*
- 15 *that the form of deed of dissolution and assignment and any other question arising in respect thereof should be referred to the Arbitrator. On a motion by G. to set aside the Arbitrator's award,*

Held, that on the construction of the submission to arbitration the Arbitrator had not exceeded his jurisdiction in inserting in the deed of dissolution

20 *prohibiting G. from manufacturing according to the Letters Patent.*

The assignor of a licence under a Patent is not entitled as against his assignee to dispute the validity of the Patent. Chambers v. Crichley (33 Beav. 374) followed.

- 25 *In 1898 Letters Patent (No. 22,765 of 1898) were granted to William McCowan. By a Deed dated the 27th of May 1901, the Patentee granted a licence under the Patent to Edward James Hay, who, on the same day, executed a declaration or acknowledgment of trust of the benefit of such licence in favour of a partnership firm of E. J. Hay & Co., in which Cyril Herbert Koszelski Gonville, Edward James Hay, William McCowan, and Frederick Masters were the*
- 30 *partners, the partnership being a partnership at will without Articles. E. J. Hay gave notice to determine the partnership on the 30th of July 1903, and on the 25th of July 1903, C. H. K. Gonville commenced an action against E. J. Hay, W. McCowan, and F. Masters, claiming the usual relief in a partnership action.*

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On a motion by the Plaintiff in this action an Order was made on the 7th of August 1903, that all further proceedings should be stayed on the terms set out in the schedule annexed thereto except for the purpose of enforcing that Order. The terms in the schedule provided (1) for the dissolution of the partnership as from the 31st of July 1903; (2) for the sale by the Plaintiff of his share of the partnership at a price to be fixed as hereinafter directed; (4) that the Plaintiff should be at liberty to deal in caramels and other brewers' requisites and things which had hitherto been dealt in by the partnership firm; (7) that the form of Deed of dissolution and assignment, and any other question arising in respect thereof, should be referred to the final arbitrament of the arbitrator therein named, who should also settle the amount of the price which, under all the circumstances, ought to be paid under clause 2, with liberty to call in experts and valuers, it being admitted that the licence dated the 27th of May 1903 belonged to the partnership for the continuance of the term of the Patent, or any extension thereof, and that the Plaintiff, as a partner, was entitled to one-sixth of the value thereof. The Arbitrator made his award, and finally settled the form of the Deed of dissolution of partnership. By the Deed so settled the Plaintiff (*inter alia*) assigned to the Defendants all his part or share and interest in the invention, Patent, and privileges by the Deed of the 27th of May 1901 expressed to be granted, and all other the interest, benefit, or privilege, equitable or otherwise, of him, the Plaintiff, under and by virtue of the acknowledgment of the same date, and covenanted with the Defendants "that he would not at any time, either alone or jointly with, or as agent or manager for, any person or persons whomsoever, either directly or indirectly, exercise "or carry on, or be concerned in, the trade or business of manufacture of caramels manufactured under or by virtue of the process protected by the aforesaid Patent during the term granted by the said Letters Patent or any extension thereof," with a proviso that the Plaintiff should be at liberty to deal in caramels and other brewers' requisites and things, and to manufacture caramels (other than those protected by the aforesaid Patent) and other brewers' requisites and things. On the 20th of November 1903 the Plaintiff gave notice to move that the award might be set aside so far as regards the insertion in the Deed of dissolution of partnership of the above-mentioned covenant, on the ground that the Arbitrator in making the award had exceeded the jurisdiction conferred upon him by the submission; or, alternatively, that upon the like grounds all matters referred to the said Arbitrator might be remitted to him for reconsideration, with a direction to the said Arbitrator that the covenant inserted by the Arbitrator in the draft Deed of dissolution of partnership, whereby the Plaintiff was prohibited from manufacturing caramels according to Letters Patent No. 22,765 of 1898 should be omitted from the Deed, and that so much of the proviso following upon the said covenant as was not in accordance with the terms of the said submission should also be struck out of the Deed, and that the costs of and occasioned by this application, and of and relating to any further proceedings before the said arbitration, should be paid by the Defendants to the Plaintiff.

The motion was heard on the 4th of December 1903.

Buckmaster, K.C., and *A. J. Walter* (instructed by *Dalston, Son and Elliman*) appeared for the Plaintiff; *Asbury*, K.C., and *A. Jolly* (instructed by *Dennis and Gray*) appeared for the Defendants.

BUCKLEY, J.—This is a motion to set aside a certain part of the award of an Arbitrator on the ground that it was in excess of his jurisdiction. Nobody disputes that it was competent to the Arbitrator to decide all questions of law and of fact that were referred to him, but it is said that this particular matter was not referred to him, and that in deciding upon it he was acting in excess of his jurisdiction. *McCowan*, a patentee, in May 1901, executed a licence to one *Hay*. He on the same day executed a declaration of trust for a partnership

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consisting of *McCowan, Hay, Masters* and *Gonville*, the Plaintiff, who is the Applicant on this motion. The licence became part of the assets of a partnership constituted between those four. There were no written Articles of Partnership. It was a partnership at will. One of the partners, *Hay*, gave a
5 notice to determine it on the 31st of July 1903, and it was dissolved. He gave his notice on the 4th of July for the 31st of July, and this action was brought on the 25th of July, asking for the ordinary relief in a partnership action. On the 7th of August 1903 an Order was made staying further proceedings in the action upon the terms set out in the schedule, except for the purpose of
10 enforcing such Order, and the terms of the schedule provided for the arbitration which has taken place.

The first question is what is the true construction of the terms contained in the schedule?—The words are:—"The form of Deed of dissolution and assign-
15 "ment, and any other question arising in respect thereof to be referred to the "final arbitrament of"—a person named. The Deed of dissolution and assignment of course is the Deed of dissolution of the partnership and the necessary consequential assignment to carry out the term previously contained, which was that the Plaintiff should sell his share, so that there would be an assignment of the Plaintiff's share to the other three, of course including an assignment of
20 the licence which formed part of the partnership assets. In my judgment the words:—"and any other questions arising in respect thereof," mean any other question arising in respect of the dissolution, and of the assignment to be executed to carry out the terms as to the sale by the Plaintiff of his share. It is suggested by the Applicant that "thereof" means of
25 the form. I do not think that is so. If the clause ran:—"The form, and "any other question arising in respect of the form should be referred," it would be meaningless. The form is referred as a whole—the whole of the form, and "any other question arising in respect thereof" must be, therefore, some question arising in respect of something other than the form. It is not:—
30 "arising in respect of the Deed," meaning by that the form of the Deed; it must be a question arising in respect of the dissolution which is to take place, and the assignment which is to be executed pursuant to the dissolution for the purpose of carrying out the dissolution. That, therefore, as it seems to me, was the matter referred to the Arbitrator.

35 Then what are the limits of that? That must mean any other question not hereby already provided for. It would be in excess of the Arbitrator's jurisdiction to alter the terms of the Agreement. His decision must be consistent with the terms of the Agreement. I think that any other question, not otherwise provided for by the terms, which arises in respect of the dissolution
40 and the assignment is referred to him.

The particular point which has arisen in this—the four being entitled to the licence, the one has to assign the licence to the three. To express the point of the covenant which is called in question—ought the assignor of his interest in the licence to be left in a condition in which he can, as against his purchasers,
45 the other three, dispute the validity of the Patent? Of course it is familiar law that a licensee who takes under a Patentee cannot, as against the Patentee, dispute the validity of the Patent. That is not the question here. The question is whether, when there are four people interested in a licence, the existence of which of course depends on the validity of the Patent, the vendor can as against
50 his purchasers, say—"That which I have sold you is worth nothing, because I "am going to dispute the validity of the Patent." If there is no Patent of course there is no licence. I think not. *Chambers v. Crichtley* (33 Beav. 374) shows that that is so. It is consistent with common sense, and I think common sense is generally good law.

55 But whether that be so or not, is it provided anywhere in the terms how this question of the right of the purchasers to be protected by covenant shall

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be disposed of? It seems to me that they are silent. The terms are that the Plaintiff is to sell his share, and by paragraph 4 that the Plaintiff is to be at liberty to deal in caramel, and other brewers' requisites, all things which have hitherto been dealt in by the partnership firm of *Hay & Co.*, and to be at liberty not only to do business with, but to canvass past and present customers of the firm. How far that term—"to deal in" is to go, and what is the true meaning of it is, I think, a matter for the Arbitrator. The construction of the Agreement I think must be for the Court; but there is nothing in the terms which provides, either one way or the other, how the purchaser of the licence shall be protected, as against the vendor of a share in the licence, by a covenant not to dispute the validity of the Patent, which is the particular point. Was that referred to the Arbitrator? It seems to me it was. I agree that it is a question to be determined, in settling—not the form of the Deed. It is not form. It goes to contents no doubt, as to what covenant ought to be in. It is a question arising in respect of the assignment of the licence, and that was referred to him to determine.

Under these circumstances the motion fails, and I must dismiss it with costs.

Buckmaster, K.C.—I do not know whether the Plaintiff will want to go further, but if he does it will be necessary for him to obtain your Lordship's leave to appeal, and I ask for it at once?

BUCKLEY, J.—Yes, I give leave.

Dunlop Pneumatic Tyre Company, Ltd., and Pneumatic Tyre Company, Ltd. v. David Moseley & Sons, Ltd., and India-rubber and Tyre Repairing Company. Same v. David Moseley & Sons, Ltd.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE SWINFEN-EADY.

December 4th, 7th, 8th, and 15th, 1903.

DUNLOP PNEUMATIC TYRE COMPANY, LD., and PNEUMATIC TYRE COMPANY,
5 LD. v. DAVID MOSELEY & SONS, LD., and INDIA-RUBBER AND TYRE
REPAIRING COMPANY.

SAME v. DAVID MOSELEY & SONS, LD.
(Consolidated Actions).

*Patent.—Action for alleged infringement.—Right to manufacture and sell
10 one element (not separately claimed) of a combination.—Alleged intent by
several persons to sell separately the elements for the purpose of infringement.—
Action dismissed.*

*A Company, the owners of two Patents—(1) (Bartlett), for "Improvements in
"tyres or rims for cycles and other vehicles," and (2) (Welch), for "Improve-
15 "ments in rubber tyres and metal rims or felloes of wheels for cycles and
"other light vehicles," brought two actions against the Defendants for infringe-
ment. The Patents were for combinations. The Complete Specification of
Bartlett claimed:—"(1) The combination of a grooved rim or metal tyre, and
20 "an arched tyre of india-rubber or other flexible material held in the groove by
"the pressure of an inflated tube within the arch, which forces its edges against
"the sides of the groove, substantially as described. (2) Tyres or rims for
"cycles and other vehicles consisting of the parts a, b, c, combined and arranged
"substantially as described and shewn in the drawings." The Complete
Specification of Welch claimed by the fourth and ninth claims respectively:—
25 "(4) A rubber or elastic tyre having the form of a saddle or arch in section.
"lined with canvas, in combination with two wires or sufficiently inelastic
"cores for securing the same to the rims or tyres, substantially as herein
"described. (9) A rubber or elastic tyre having the form of a saddle or arch
"in section, provided with endless wires or cores fitted or vulcanised within
30 "each side for the purpose of securing the same to the rims in combination with
"an inflatable inner tyre or tube, substantially as described and shewn with
"reference to Figs. 15 and 18 of the drawings." The Company alleged that the
Defendants had infringed by selling tyres or parts thereof, and pleaded at*

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the Bar and sought to prove that the Defendants had manufactured and sold the outer tyre or cover (one of the elements of the combinations) with the intent that it should be used by the purchaser (not being a licensee of the Company) for the purpose of making one or other of the combinations. The Defendants denied infringement, and claimed that they were lawfully entitled to sell the cover; that they had done so bonâ fide and in the ordinary course of trade, and they contended that intent was immaterial. 5

Held, that (the Patents having previously been held to be for combinations) as the cover was not new and was not separately claimed, the Defendants respectively were lawfully entitled to make and sell or sell the cover; that consequently intent was immaterial; and, further, that the Defendants had not infringed. 10

These were consolidated actions by the *Dunlop Pneumatic Tyre Company, Ltd.*, and the *Pneumatic Tyre Company, Ltd.*, commenced on the 29th of January, 1903, to restrain the infringement of Letters Patent (No. 16,783 of 1890) granted to *William Erskine Bartlett*, and Letters Patent (No. 14,563 of 1890) granted to *Charles Kingston Welch*. 15

The Complete Specification of *Bartlett* is set out at page 245 of 15 R.P.C., and that of *Welch* at page 533 of 16 R.P.C. The claims so far as at present material are set out in the head note above. 20

By their Statement of Claim the Plaintiffs stated that—(1) they were the proprietors of the Patents sued upon; (2) that *Welch's* Patent was good and valid, and had been so certified by *Kekewich, J.*, in an action of the *Pneumatic Tyre Company v. Casswell*; also that the Letters Patent of *Bartlett* had been so certified by *Romer, J.*, in an action of the *North British Rubber Company, Ltd. v. Mackintosh*, and that *Welch* and *Bartlett* respectively were the first and true inventors of the inventions described in the Patents respectively; (3) that the Defendants had infringed in the manner by the Particulars of Breaches appearing. They claimed an injunction to restrain infringement, an account of profits or damages, delivery up of all tyres and parts of tyres made in infringement of the Patents, and costs as between solicitor and client. 25 30

The Particulars of Breaches stated that—“ (1) the Defendants had infringed, “ and by advertisements, circulars, and the continuous offer for sale threatened “ to infringe, the Letters Patent by making, selling, and offering for sale pneumatic “ tyres and parts thereof made in accordance with the inventions claimed in the “ Letters Patent. (2) The Plaintiffs complained of the manufacture, sale, and “ offer for sale of beaded-edge and other tyres by the Defendants, *David Moseley & Sons, Ltd.*; also of the sale and offer for sale of similar beaded-edge and “ other tyres by the Defendants, the *India-rubber and Tyre Repairing Company*, “ which tyres had been manufactured by the Defendants, *David Moseley & Sons, Ltd.*, and supplied by them to the *India-rubber &c. Company*. (3) They “ also complained of the manufacture by the Defendants, the *India-rubber &c. Company* of tyres infringing both the Letters Patent, and which were in the “ said Defendants' price-list described as ‘re-lined,’ but which were in fact “ re-made tyres. They also complained against the said Defendants of the sale “ of infringing tyres described in the wholesale price-list as second-hand covers “ with endless wires, all of which covers were re-made in infringement of the “ Letters Patent. (4) The said tyres were not of the Plaintiffs' manufacture, “ and were made in accordance with the inventions claimed in all the claiming “ clauses of the Letters Patent.” 35 40 45 50

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By their Defence *Moseley & Sons, Ltd.*, stated that—(1) they made no admission with regard to any of the allegations in paragraphs 1 and 2 of the Statement of Claim; (2) they denied that they had ever infringed or threatened to infringe either of the Letters Patent; (3) they made no admission with regard to any of the allegations in paragraphs 1, 2, and 3 of the Particulars of Breaches; and (4) they submitted that as against them the action ought to be dismissed.

The Defendants, the *India-rubber and Tyre Repairing Company*, traversed the allegations contained in the Statement of Claim.

The actions came on for trial before Mr. Justice SWINFEN-EADY.

10 *Moulton, K.C., Terrell, K.C., J. C. Graham, and A. J. Walter* (instructed by *J. B. and F. Purchase*) appeared for the Plaintiffs; *Cripps, K.C., Eve, K.C., and O. Leigh Clare* (instructed by *Rowcliffe, Rawle & Co.*, agents for *F. A. Woodcock*, of Manchester) appeared for *David Moseley & Sons, Ltd.*; *Macnaghten, K.C.*, and *Mark Romer* (instructed by *Emmett & Co.*, agents for *A. and G. W. Fox*, of Manchester) appeared for the *India-rubber and Tyre Repairing Company*.

Terrell, K.C., opened the Plaintiffs' case.—The Patents are for combinations. Their validity is not now in issue. The question is, have the Defendants infringed? The point of law is: assuming a valid Patent for a combination of parts, A, B, and C, are persons entitled to sell the one part, A, another part, B, and a third part, C, to the same purchaser, not being a licensee of the Patentee or of his assignees, so as and with the intent that the same shall be used to make a combination in infringement of a Patent? *Welch*, in Claims 4 and 9, claims a combination of (a) an arched india-rubber or elastic outer tyre, with looped edges for the insertion of wires; (b) the wires; and (c) the rim or tyre in the manner described and illustrated; and *Bartlett* claims a combination of (a) an outer tyre of india-rubber or other elastic material; (b) a metal tyre or rim; and (c) an air-tight tubular chamber, in the manner described and illustrated. *Bartlett's* tyre is secured in the groove by the pressure of an inflated inner tube, and *Welch's* by means of wires in combination with an inflated inner tube. The Defendants, *David Moseley & Sons*, make and sell covers of both kinds. The Defendants, the *India Rubber and Tyre Repairing Company*, sell rims, wires, inner tubes, and, sometimes, *Moseley's* covers. The covers so made and sold are of no use except for (a) the combination claimed by the 4th and 9th Claims of *Welch*, or (b) the combination claimed by *Bartlett*. They are made and sold with the intent that they should be so applied. This is contrary to the spirit of the Patent law. The grant of the Patent states that the Patentee "shall have and enjoy the whole profit" and advantage from time to time accruing by reason of the said invention." 40 If persons are to be allowed to sell the separate elements of a combination Patent with such intent the grant will become valueless. If three people so sell to the same purchaser, or sell with the intention that they shall be so used, they are all joint tort-feasors and liable for the infringement. The parts of the combination are not all old. The cover and rim were new at the date of the Patent. 45 The combination is the only thing claimed and the invention is the combination. As to the person actually infringing intent is immaterial, but with regard to the question whether a person is a joint tort-feasor it is material. Proof of intent is here essential to the Plaintiffs' contention. On this point we refer to (A) a sale since the writ by the *Manchester Machinist Company, Ltd.*, to a Mr. 50 *Webb* of a rim and an inner tube, with an order on Messrs. *Moseley & Sons* for a "beaded-edge cover," to be paid for by bearer; (B) correspondence between the secretary of the *N.A.C.T.* and Messrs. *Moseley & Sons*, the former inquiring—consequent upon a warning advertisement by the *North British Rubber Company*—concerning the beaded-edge cover, "whether 55 "there is any liability of a law suit for infringement by our method

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"of selling these goods," and the latter responding (*inter alia*) that the House of Lords had held that *Bartlett's* Patent was for a combination of three elements, viz., an inturred rim, a thickened-edge cover, and separate air tube, and that the *Fleuss* tyre with an inturred rim and thickened-edge cover did not infringe, since it consisted of two elements only; and that there was no Patent they were aware of that they could infringe by using *Moseley's* beaded-edge cover; (C) a purchase from the *India Rubber and Tyre Repairing Company* of a *Moseley* cover with wires fitted therein; (D) the purchase of a *Clydesdale* cover made for the *Black Pneumatic Tyre Company*, whose price-list contained a reference to *Westwood* rims "for wired or beaded edges." The *Fleuss* was a tyre which required no inner tube. It is contended by the Plaintiffs that *Moseley's* cover cannot be used with a *Fleuss* tyre. *Moseley & Sons'* contention in their letter was that, inasmuch as they were selling only a cover and not also a rim and inner tube, they were not infringing. The *Westwood* rim referred to in the price-list of the *Black Pneumatic Tyre Company* is the subject-matter of a Patent for rolling only. It can be made for either wired or beaded edges, but is made under licence from the *Dunlop Company*. It is sold as a separate article, and is only one of the elements of the combination. By itself it is not an infringement of *Bartlett's* Patent. It can be used with various tyres quite independently of *Bartlett* or *Welch*, e.g., the *Fleuss*. But the *Moseley* beaded-edge cover in combination with the *Westwood* rim is an infringement of the *Bartlett* combination.

The following witnesses were called in support of the Plaintiffs' case:—*Dugald Clerk, F. G. Baisley, James Swinburne, C. V. Boys, E. T. Cheer, Charles Sangster, M. S. Foley, F. Webb, W. Truscott, W. M. Hawnt, and F. B. Bale.*

Cripps, K.C., for David Moseley & Sons.—The defence is a legal one. If all that has been alleged were true there would be no cause of action. There is no proof of it in the evidence called. The right in relation to the combination is the only one that can be infringed, and the principle of law is that to sustain an action the claim must have been infringed. What the Defendants have done they have done in perfect *bona fides* and in the ordinary course of trade. It has extended over a long period of years, and they have the right to do it. A great many of the covers sold are sent abroad. It is not admitted that the cover and rim were new at the date of the Patents. Even with the intent alleged there can be no infringement; but there is no evidence of intent. Intent is really immaterial. There is no obligation in law upon the Defendants to follow the covers in order to see what is done with them. If persons use them in infringement of the combination, the right of the Plaintiffs is against such infringers. The Patents are for combinations. For the nature of the combination see *Dunlop Pneumatic Tyre Company, Ltd. v. New Lamb Tyre Company* (19 R.P.C. pages 384, 388), for the *Welch*; and for that of *Bartlett, Gormully and Jeffery Manufacturing Company v. North British Rubber Company, Ltd.* (15 R.P.C. page 245, and page 254, lines 40 to 50). The element of the inextensible wire was an essential part of the combination claimed by *Welch*, and the cover, inner tube, and rim made the combination of *Bartlett*, the principle being the keeping the cover in place by an "air-strut." [SWINFEN-EADY, J.—Supposing the cover were only capable of being used as part of the patented combination?] That is putting the case too high. The purchaser so using it would be infringing, but in law the person selling would not infringe. Many of the covers that were sold were no doubt used for the combination, many by licensees, and many for repairs, and with regard to the last there may be a question whether the person "repairing" is setting up a new combination. But the manufacturer is not to hold an inquiry into the Patent law as regards every cover he sells, nor is he to inquire whether the purchaser is purchasing

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or acting under the terms of a licence. The case is governed by authority, and the article may lawfully be manufactured and sold. The earliest case on intent is *McCormick v. Gray* (7 H. & N., pages 25, 32, 38, 39) :—"If a man may do a thing he may do it with whatever intent"—per *Bramwell*, B. Knowledge that the article is to be used for the purpose of infringing does not make the vendor an infringer of the combination (see judgment of *Fry*, J., in *Sykes v. Howarth*, L.R. 12 C.D. 826, and also *Townsend v. Haworth*, L.R. 12 C.D. 831n, 48 L.J. Ch. 770n). The present case is not that of an invitation to infringe as in *Innes v. Short and Beale* (15 R.P.C., 449). There the injunction granted was to restrain the sale of powdered zinc by the Defendant with an invitation to his purchasers to use it so as to infringe the Plaintiffs' Patent, and *Bigham*, J., distinguished *Townsend v. Haworth*. [SWINFEN-EADY, J.—The cases referred to do not contain illustrations of a part that can only be used with the combination.] No; but if anyone sold the article knowing that it was going to be used it would be quite as strong (see *Sykes v. Howarth*, *ubi supra*). But that is not sufficient. Anyone may make the cover irrespectively of the Patent. The cover might have been manufactured twenty years before the Patent for the combination. In that case could the Plaintiffs have restrained its manufacture? *Dunlop Pneumatic Tyre Company v. Neal* (16 R.P.C. 247; L.R. 1899 1 Ch. 807) deals with the question of repairs.

The following witnesses were called for the Defendants Messrs. *Moseley* :—*O. G. Moseley*, and *W. Beaumont*.

Eve, K.C., summed up the evidence.—The file put in shows that there are licenses of the *Dunlop Company* actually manufacturing the tyre. A general injunction therefore could not be granted. Again, a large portion of the trade is perfectly legitimate, *i.e.*, the export trade.

Macnaghten, K.C., for the *India Rubber and Tyre Repairing Company*.—In the amended Particulars a case was suggested within *Dunlop v. Neal* (*ubi supra*). That case was not opened and no evidence was tendered upon it. The only question is as to the alleged sale by the Defendants of a tyre-cover and wires. Mr. *Markus*, the manager of the Company, will deny it.

John Markus then gave evidence.

Macnaghten, K.C.—The proceedings against the *India Rubber and Tyre Repairing Company* are oppressive. Whether *Moseley & Sons* are entitled to make and sell the covers is the main question.

Terrell, K.C., in reply.—Are the making of the cover and the putting it on the market acts which amount to infringement? Infringement may be divided here into two heads—either it is an infringement because the article is itself new although it is only an element of the combination or the manufacture and sale of the article amount to an act constituting part of the infringement, and the person so acting joins with the purchaser in an act of infringement. The result is a breach of a franchise and therefore a tort. They are joint tort-feasors and are jointly and severally liable. There is no difference between what the Defendants are doing and what was done in the *Dunlop Pneumatic Tyre Company v. Neal* (*ubi supra*). The Court will regard the substance of the combination claimed. It is none the less infringement where the substance is taken if something immaterial is omitted. (*Clark v. Adie*, L.R. 2 App. Cas. 315). If the parts are separately sold so as to enable the public to make the combination it is still an infringement (*United Telephone Company v. Dale*, L.R. 25 C.D. 778). The present case cannot be distinguished from *Innes v. Short and Beale* (15 R.P.C. 449). The relief here sought is to restrain the infringement of the Patent and not the sale of the covers. The Plaintiffs do not object to the covers being made for licensees. The Defendants are inviting purchasers to use the article so as to infringe. Invitation may be as well by act as by writing.

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Besides, the method of applying the covers is well known, and instructions are not required as in *Innes v. Short*. [SWINFEN-EADY, J.—The Defendant in that case was restrained from inviting other people to infringe. He himself was not infringing the Patent by selling powdered zinc. What injunction do you ask?] The difficulty is merely one of words. In substance the injunction should be that they are not to sell the covers in such a way that they can only be used in infringement of the Patent. They are inviting purchasers to use the cover by putting on the market an article that cannot be used for any purpose other than the combination. It is not an article of commerce like a key that may be used for many purposes.

Graham (by leave of the Court).—The covers made and sold by Messrs. *Moseley* are an infringement of the Patent, although the claims in the Specification are not infringed. The decision in *Clark v. Adie* is consistent with the argument that a subordinate integer of a combination, although not claimed, if new, may be infringed. The decision there was that the subordinate integer was old, but if it had been new Lord *Cairns* would have decided whether taking it was taking the pith and marrow of the invention.

SWINFEN-EADY, J.—In this action the *Dunlop Company* are the Plaintiffs and Messrs. *Moseley* and the *India-rubber and Tyre Repairing Company* are the Defendants, and the action is to restrain the Defendants respectively, from infringing two Patents held by the Plaintiffs, which are known respectively as the *Welch* and the *Bartlett* Patents. I think it will be convenient to deal with the cases of the Defendants separately. Generally there is no dispute as to the facts with regard to what the Defendants, Messrs. *Moseley*, are doing. They are making and selling what is known as the cover, that is, the outer detachable cover, and they are selling it with a lining suitable for the insertion of wires, so that the cover, as sold by them, is adapted for use in the manner described in *Welch's* Specification, but not necessarily for use solely in that manner. They are also making and selling a cover with beaded edges, but without pockets for wires, which cover is capable of being used in the manner described in *Bartlett's* Specification, the beads or lugs of the cover engaging in the inturned angle of the rim. Now the Defendants have been doing that for a considerable period, but the actual period is not material. According to the evidence of Mr. *Moseley* with regard to the *Bartlett* they have done it since the year 1892, and with regard to the *Welch* since the year 1894. He gave those dates in re-examination. There was some doubt as to whether originally he had not sold the rubber portion separately from the canvas portion. I think he had, but at a later date he sold the two parts effectually joined together. The actual length of time during which these sales had been taking place is not material. It appears that there was some correspondence between the parties, and it was alleged that what the Defendants, Messrs. *Moseley*, were doing was, at all events, with the knowledge and concurrence of the Plaintiffs. I do not think it is necessary to consider that because no question of leave or licence is set up; it is not the case of the Defendants, "Yes, we are infringing the Patent, but we have the consent of the Plaintiffs to do what we are doing." The issue which I have to try is a very short and simple one—infringement or no infringement—are the Defendants infringers? It appears that a large proportion of the trade of Messrs. *Moseley* is an export trade, that is to say, they make and sell covers intended to be exported from this country as covers. They are intended to be sent out to countries abroad, and it is not even suggested that the selling of covers only for export, not intended to be used in this country in either of the combinations together making up the *Welch* or the *Bartlett*, would be an infringement. The Defendants also make and sell large quantities of these covers to persons, some of whom it now appears are licensees of the Plaintiff Company.

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Now reference has been made to the files of the Patent Office relating to the *Welch* and the *Bartlett* Patents, and I am told that the result of an inspection of the file is that there are something like 12 licences to various persons and companies, but there may be other licences beyond those appearing on the file.

- 5 At all events there are a considerable number of persons, companies or firms who are licensees of the Plaintiffs under the *Welch* and the *Bartlett* Patents, and it is not suggested that making and selling the covers to those persons would be an infringement of any rights of the Plaintiffs. But the case is much pressed with regard to a third class, that is the covers not sold for
10 export, not sold to licensees, but which are yet sold in considerable numbers to the public, and it is said that those can only be used in one or other of the patented combinations, as the case may be, and that the sale of those covers alone is an infringement of the Plaintiffs' Patents.

- I can add nothing to the construction of these two Patents which have been
15 the subject probably of as much litigation as any Patent since the Statute has been in operation. With regard to the *Welch* Patent, the construction ultimately put upon it appears from the case of the *Dunlop Pneumatic Tyre Company v. New Lamb Tyre Company*, reported in 19 Patent Cases, page 384. At page 388, and at the top of page 389, the judgments of Lord *Lindley*, Lord *Macnaghten*,
20 and Lord *Davey* with regard to this Patent are quoted. Lord *Lindley* described *Welch's* Specification. He said: "His (*i.e. Welch's*) objects are to procure rubber "tyres which will be very easy running, which will reduce vibration, and which "will be securely fastened to the metal rims. . . . The peculiarity of
"the invention consists in the arrangement of rubber and wires over a convex
25 "surface, the rubber tyre being stretched over its convex support and being "kept in its place by the wires in the edges of the rubber without any other "support or fastening. The wires themselves grip nothing, but they make "the rubber between them, and everything between that and the metal rim, "grip that rim very securely." Then Lord *Macnaghten* defined the invention
30 as "an application to a wheel of a saddle-shaped tyre held in position by two "inextensible wires"; and then Lord *Davey* said: "The pith and marrow "of this invention I take to be this—the use of one arched rubber tyre secured "on the rim or felloe of the wheel by inextensible rings which form the edge "of the cover." Now, it is manifest, from those descriptions of what the inven-
35 tion consists, that the invention is an invention for a particular combination. Then the *Bartlett* Patent was dealt with by Lord *Watson* in the case of *Gormully and Jeffery v. North British Rubber Company*, reported in 15 Patent Reports, and at page 254 Lord *Watson* said: "The leading, and in this question the only, impor-
40 "tant claim made by the Patentee is for 'the combination of a grooved rim or "metal tyre and an arched tyre of india-rubber or other flexible material held "in the groove by the pressure of an inflated tube within the area which "forces its edges against the sides of the groove substantially as described.' "That, as I construe it, is a claim for the method shown in the Specification, or "for any method substantially the same, of so connecting the ends of the outer
45 "cover with the metal rim that the ends of the cover are firmly held or "detained, and that part of it which comes in contact with the ground is kept "in its proper position as the outer part of the tyre of the wheel. "And on a fair consideration of the terms of the Specification, taken as a whole, "the claim so made appears to me to embody the pith and substance of the
50 "invention. I do not think that the Patentee claims to have invented the use "of a metal rim, an outer cover, or an inner pneumatic tube constructed of cloth "and india-rubber, either singly or as forming in combination the tyre or felloe "of a wheel for cycles or other vehicles. In my apprehension what he does "claim as a novel invention is the mode which he has described of making
55 "such an attachment between the ends of the cover and the edges of the metal

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"rim as will serve, if I may use the expression, to consolidate these three
 "component parts of the tyre whilst the wheel is in motion, by retaining both
 "the cover and the inner tube in their right positions." That is the construction
 of the Specifications respectively, which is binding upon me, and which shows
 that both are Patents for particular combinations. Now, it was settled 5
 certainly by the decision of the House of Lords in *Clark v. Adie*, that if the claim
 is solely for a combination, there is no infringement unless the entire combination
 is taken, and, moreover, that in order to protect a subordinate part, it is necessary
 to claim it even when it is new and material, and that a subordinate part must
 be new and useful and patentable *per se* in order to be protected. It appears 10
 that rims suitable for both the tyres in question are, and have for many years
 past been, openly and publicly made and sold, that inner tubes have been made
 and sold, and are still; and that wires suitable for use in *Welch* tyres form an
 ordinary article of commerce—wires with a nut containing a right and left
 handed screw suitable for fastening together the ends of the wire. All that has 15
 been done for many years, and is not complained of, but it is said that the
 Defendants, Messrs. *Moseley*, infringe by selling the covers. Now, although
 the covers probably in most cases would form part of either a *Welch* or
Bartlett combination—that is to say, although most covers would probably 20
 ultimately be used in one or other of those methods, I am of opinion that those
 are not exhaustive of the purposes to which the covers may be put, and that
 they would be useful for other purposes in connection with other tyres, as Mr.
Beaumont pointed out. But as a matter of law I am of opinion that the
 Defendants are not themselves infringing either of the Patents in question.
 They only make and sell the outer covers; they may also make inner tubes; 25
 but no reference to that has been made. They are rubber manufacturers. They
 do not sell the wires, and they do not sell the rims—that they have nothing to do
 with; and by merely making and selling these outer covers they do not
 infringe either of the Patents. It would be difficult, indeed, to see from a
 practical point of view, if that were not so, how the Defendants could carry on 30
 their business. Selling these covers for export is a lawful trade. Selling these
 covers to persons who have licences from the *Dunlop Company* to use them
 is a lawful trade, and to say that the ultimate purpose to which the purchasers
 might put the covers, whether having obtained them for export, they did
 export them, or whether they afterwards used them in this country so as to 35
 put upon the Defendants the burden of ascertaining whether the persons to
 whom the articles were sold were intending lawfully to use them, would be
 imposing a burden upon them which, in my opinion, the law does not impose.
 The Defendants may not, of course, infringe the Patent, but the mere manu-
 facture and sale of one of the component parts of the entire combination is not, 40
 in my opinion, an infringement; and if that is so with regard to the *Welch*
 case it is *a fortiori* with regard to the *Bartlett*.

Mr. *Terrell* pressed upon me the case of the *United Telephone Company v. Dale*, but there was only there a *dictum* of Mr. Justice *Pearson* that selling all the
 component parts—that is a sale of all the component parts of a knife, for instance, 45
 that any schoolboy could put together—might be an infringement of the Patent,
 and he asks me then to say that the sale of any component part, that is to say
 one part, is sufficient—that the *Welch* tyre being made, say, when put together
 of a combination of a cover, tube, wire, and rim, that the sale of one of those
 four component parts, the cover only, is an infringement of the Patent. 50
 Certainly the decision in the case of the *United Telephone Company v. Dale* did
 not decide any such thing.

Then my attention was called to the case before Mr. Justice *Bigham* of *Innes v. Short and Beale*. There there was a zinc powder capable of being used in
 connection with steam boilers; and what the Defendant was doing, and what 55

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he was restrained from doing, was not the sale of the powder but from selling it with an invitation to the purchasers to infringe the Patent. That is far removed from the present case. Then Mr. *Terrell* insisted in his opening that the intent with which the Defendants sold these covers was an essential part of his case, and that his case was that they could only be used for a purpose which would be an infringement of the Patents, and, therefore, that the Defendants must be presumed to have the intent to infringe.

- It was pointed out by Baron *Bramwell* in the case of *McCormick v. Gray* (7 Hurlstone and Norman 25) that a person may not infringe a Patent; but he says, "I am satisfied that there is no difference between making a thing with one intent and another. If a man may do a thing he may do it with whatever intent." So that if the Defendants may lawfully make and sell this cover, the intent with which they may make and sell it is not material. There are also two cases in which a question has arisen as to whether a sale of one component part of a combination is an infringement of the entire combination. In 12 Chancery Division, at page 831, there is an extract from the case before the late Sir *George Jessel* of *Townsend v. Haworth*, which was affirmed by the Court of Appeal. After drawing attention to what a person is prohibited from doing by the terms of the Patent Sir *George Jessel* said:—"He is prohibited from making, using or vending the prohibited articles, and that, of course, includes in the case of machinery the product, if I may say so, of the machinery which is the subject of the Patent. It is that which is produced by the Patent. But has anyone ever dreamt before this case that that extends to the component articles which enter into the Patent? So far from that being the law, it has been decided that in cases of what they call combination Patents it is only the combinations claimed that may not be used; the other elementary combinations may be used. No doubt there has been a good deal of litigation as to what were the combination claims, that is, whether in claiming the entire combination you claim the subsidiary combinations or not. But you cannot even complain of the use of subsidiary combinations unless they are within the purview of your claim." His observations are strengthened by a passage which occurred a little earlier where he said that—"No Judge has ever said that the vendor of an ordinary ingredient does a wrong if the purchaser coming to him says, 'I want your compound, because I want to preserve my cloth from mildew, I wish to try the question with the Patentee.' No one would doubt that that sale would be perfectly legal." The learned Judge there was dealing with an article the sale of which might be innocent, which might be used for lawful purposes, yet if the purchaser came and said—"I am buying the article for the particular purpose of using it to try the question of the validity of the Patent, or for using it for the purpose covered by a Patent"—that even then the sale would be legal. Mr. Justice *Fry* took the same view in *Sykes v. Howarth*. He said, "I entirely agree, if I may say so, that selling articles to persons to be used for the purpose of infringing a Patent is not an infringement of the Patent."
- Now, the only other case which was referred to was the case before Mr. Justice *North* of the *Dunlop Company v. Neal*. There the point of the decision was that the person there had made and sold that which was really a new tyre, that is to say, it was the particular combination which was protected by the Patent. Mr. *Graham* pressed upon me *Clark v. Adie*, but I am satisfied that when Lord *Cairns* was considering the details of what he had previously referred to as the "subordinate integer" he was only doing so for the purpose of the case and not in the least departing from the principle of law which he had previously laid down which appears at page 321 where the subordinate integer is alleged to be infringed and protection for it is claimed. He said, "the invention must be described in that way—it must be made plain to ordinary

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"apprehension upon the ordinary rules of construction that the Patentee "has had in his mind, and has intended to claim, protection for those "subordinate integers; and, moreover, he is, as was said by the Lords "Justices, at the peril of justifying those subordinate integers as them- "selves matters which ought properly to form the subject of a Patent of 5 "invention."

The result is that, as regards the Defendants, Messrs. *Moseley*, they are not infringing either Patent, and they are doing nothing of which the Plaintiffs can complain.

Now, the case of the *India-rubber and Tyre Repairing Company* is a 10 different one, and there is some conflict of fact. With regard to that I am of opinion that the Plaintiffs have not made out the case that they alleged, and I accept Mr. *Markus's* version of what took place. I do not believe that the wires and tyres were sold together, or on the same day, and I certainly do not consider the exhibit that was identified by Professor *Boys*, as proved—that is to 15 say, as having been proved to my satisfaction, that that was sold by the *India-rubber Company*. I did not receive from the Plaintiffs' witness a full account of what had taken place until he had been cross-examined, and with regard to the two words written on this invoice with regard to the wires, "two pairs," written and scratched out, I accept the Defendants' version. The only 20 difference between the case of Messrs. *Moseley* and the case of the *India-rubber and Tyre Repairing Company* is that the *India-rubber and Tyre Repairing Company* are not manufacturers; they sell only, and they are alleged to have sold on one occasion wires with tyres and on another occasion wires actually inside the tyres. I do not consider either of those sales proved, and I believe 25 with regard to the two pairs of wires that were sold, that those were sold on the first occasion and separately from the tyre covers. It was not a sale to a stranger, in the sense that it was a sale which was the subject of a visit by officials from the *Dunlop Company*, and I do not attach the importance to the incidents which they have spoken of which I otherwise should, when I find it 30 is coupled with an allegation that they are for a friend in Ireland, and some bogus telegram being produced to carry out that sale. It may be that in order to detect infringers the Plaintiff Company have to resort to various expedients, but when they do so the evidence requires to be very carefully scrutinised, and it will be sufficient for me to say that in the present case the Plaintiffs have 35 not proved to my satisfaction either of the two incidents on which they rely, and I entirely accept the Defendants' version, or, rather, that of Mr. *Markus*, who seems to have been managing and carrying on the india-rubber business in the name of his wife.

Perhaps before parting with the case I ought to add this:—The Plaintiffs 40 alleged that the cover was a new thing in itself which was claimed as a part of the combination and separate property. I am of opinion that it is not, and the difficulty in which the Plaintiffs are placed became more manifest when I pressed counsel as to the form of the injunction which he really wished to obtain. He suggested an injunction to restrain the Defendants from 45 selling covers in such form—that is to say, so constructed—that they might only be used by purchasers for infringing the Patents. But what about the sale for export? So, again, with regard to the sale to persons who might lawfully use them as having the *Dunlop Company's* licence. Counsel recognised that there would be a difficulty in taking an injunction in that general form having 50 regard to those persons, and ultimately I was not able to obtain any further assistance. I think the short answer to it is that any injunction granted would restrain the lawful sale of articles which may lawfully be made and sold, and that what the Defendants, Messrs. *Moseley*, are doing is not infringement; and that the Defendants, the *India-rubber and Tyre Repairing* 55

Dunlop Pneumatic Tyre Company, Ltd., and Pneumatic Tyre Company, Ltd. v. David Moseley & Sons, Ltd., and India-rubber and Tyre Repairing Company. Same v. David Moseley & Sons, Ltd.

Company, have not in any way infringed. The result must be that the action fails, and must be dismissed with costs.

On the 15th December *Walter* stated that the Plaintiffs were appealing, and that the solicitors for the *India-rubber and Tyre Repairing Company* had been
 5 asked to give the usual undertaking as to repayment of costs in the event of the Appeal succeeding. They said they could not do so, but they would raise no objection, if an Order were made, that the costs should be paid into Court pending the appeal.

SWINFEN-EADY, *J.*—When the taxation of the costs has been completed, if
 10 the costs are in jeopardy the Plaintiffs must take the ordinary course, but I will not give any direction at present. I have no evidence before me which justifies me in making any Order.

IN THE COURT OF SESSION IN SCOTLAND.

OUTER HOUSE.

15 *Before* LORD KYLLACHY (Lord Ordinary).

January 22nd, February 3rd and 5th, March 4th, May 28th, October 3rd, and November 10th and 21st, 1903.

WOOLLEY & SON v. MORRISON.

Trade name.—Name embossed on bottles.—Alleged passing off and deceit.—
 20 *Action to restrain.*—Interdict refused.

W. & S. and also M. were beer bottlers and possessed bottles on which, as in the case of other Edinburgh bottlers, their respective names were embossed, and in which they bottled beer or aerated waters which they did not brew or make. Prior to the institution of a "Bottlers' Exchange" in March 1902 (which
 25 *"Exchange," however, did not comprise all the members of the trade), the practice of the trade justified the retention by individual bottlers of other bottlers' bottles, returned in exchange for their own, and filling them and sending them out again as if they were their own. After March 1902 each bottler was supposed to get back and fill only his own bottles, and individual bottlers tried to prevent*

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their rivals filling bottles embossed with any but their own names. In December 1902 *W. & S.* found in a grocer's shop seventeen of their bottles marked with their name, bearing also the name of the brewer but not of the name of any bottler, although they had been filled by *M. W. & S.* thereupon sought to interdict *M.* from filling their bottles and sending them on the market, on the ground that 5 by doing so *M.* represented that the beer so bottled and sold by him was beer of *W. & S.*'s bottling.

Held, by the LORD ORDINARY, that *W. & S.* had failed to prove that the Respondent's use of their bottles deceived the trade or the public, or was in the circumstances fitted to deceive the trade or the public. Interdict was refused 10 with expenses.

This was an action of suspension and interdict, the Note being presented to the Court on the 22nd of January 1903. The Complainers were *Charles Woolley & Son*, beer bottlers and aerated water manufacturers, 49 Elm Row, Edinburgh. The Respondent was *William Morrison*, wholesale bottler, 2 King's Road, 15 Portobello. Both dealt (*inter alia*) in beer, ales, and stout, which they obtained from the brewers in bulk in barrels or otherwise and drew off from the barrels into bottles, which they sold to their customers and the public generally. Along with the beer, ale, or stout the brewers sent adhesive labels printed with the brewer's name, which were gummed on to the bottles before 20 they were sent out. These printed labels sometimes had the bottler's name on them as well as the brewer's; sometimes they bore the brewer's name only. The Complainers also manufactured mineral waters, but they did not manufacture beer, ale, or stout, or any other liquor in which the Respondent traded. The Respondent did not manufacture or bottle mineral waters. The Com- 25 plainers, for the purposes of their business, owned a large number of bottles upon which their name was marked. The name was, in most instances, moulded on to the bottle in the process of manufacture, but in many cases it had been engraved, sand-blasted, or otherwise put upon the bottles by a subsequent process. 30

There was a contract between wholesale bottlers in Edinburgh and district, whereby they formed themselves into an association called the *Edinburgh and District Aerated Water Manufacturers Defence Association, Ltd.* The members of the said association were, by the terms of their said contract, permitted to lift each other's beer, ale, stout, and aerated water bottles, from which they 35 selected those branded or marked with their own name. They then sent those which did not belong to them to the bottle exchange or clearing-house of their said association, in order that those might then be sent to their respective owners. The contract was based on the expectation that each bottler would receive back the whole of his own bottles through the medium of the bottle 40 exchange. The Respondent was not a member of the bottle exchange, and had never received authority to lift or use the Complainers' named bottles.

The Complainers averred that "The Respondent has in the past been using "for beer, ales, stout, or aerated waters of his own bottling or manufacture "bottles bearing the Complainers' name, and the Respondent may continue the 45 "practice to the detriment of the Complainers' business. The Complainers "object to their name being used as if they were the bottlers or manufacturers "in sales of beer, ales, stout, or aerated waters which are not bottled "by them." They said that they had expended great industry, care, skill, and capital in the development and extension of their trade as bottlers, which 50 could not be maintained unless their trade name moulded on their bottles was protected. Their reputation depended on the bottles bearing their

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name being really filled by them. In particular they averred that the Respondent had sold beer bottled by him in bottles moulded with the name of the Complainers to *James Smith*, grocer, 160 Morrison Street, Edinburgh, on the 6th and 12th of December 1902. They asked that the Respondent should

5 be interdicted from "selling or exposing for sale, or from having in his possession for sale or for any purpose of trade, beer, ales, stout, or aerated waters, or any other alcoholic or non-alcoholic drinks, not bottled or manufactured by the Complainers, contained in bottles which bear the name of the Complainers either impressed, embossed, engraved, sand-blasted, moulded, or

10 "otherwise marked thereon, or which have the Complainers' said name in any way exhibited thereon." They also asked for interim interdict.

The Respondent in his Answers explained that when he sent out his bottled beer a charge was made for the bottles, a rebate being given for their value if and when they were returned. "This is the invariable

15 "rule in the wholesale trade, and it is the rule followed by the Complainers. In the course of business it occasionally happens that certain of the bottles returned to the Respondent are not plain bottles, but bottles marked with the names of other wholesale traders who use bottles stamped with their name. It is admitted that the Respondent may have sold

20 "to retail traders beer or stout bottled by his servants in a bottle or bottles so marked, and that some of such bottles may have been marked with the name of the Complainers. Such cases are, however, accidental and exceptional. The name of the manufacturer of the beer, which is stated on the label, is the only matter of the slightest importance to, or which is in any way regarded

25 "by, members of the public in purchasing same. The name, moulded or otherwise, placed upon the bottle is not understood by the public as in any way referring to the bottler of the contents, and the public are in this respect in no way misled or deceived." The Respondent said that "had any complaint been made to him by the Complainers with regard to their marked bottles, or

30 "had he been asked not to use their marked bottles, he would have been quite willing, and he hereby expresses his willingness, to take every reasonable precaution against receiving into his premises any bottles marked with the Complainers' name, or selling beer or other liquors in bottles thus marked." There was no averment on the part of the Complainers that any warning had

35 been given to the Respondent except that the *Edinburgh and District Aerated Water Manufacturers Defence Association*, the "Bottle Exchange" to which the Complainers belong, had advertised repeatedly in the "Scotsman" newspaper that its members objected to the illegal use of their trade names. The first of these advertisements was inserted the 1st of March 1902.

40 On the 5th of February 1903 Lord *Pearson*, Lord Ordinary on the Bills, having heard Counsel upon the Note and Answers, passed the Note from the Bill Chamber to the Court of Session, but refused interim interdict.

The Record was closed on the 4th of March 1903, and the case was sent to the Procedure Roll. On the 29th of May 1903 Counsel were heard on the

45 relevancy of the action.

C. D. Murray and *J. H. Henderson* (instructed by *Kelly, Paterson & Co.*, S.S.C.).—The case as laid is irrelevant. The alleged conduct of the Respondent, if actionable at all, should have been proceeded against under the Merchandise Marks Act. But there was no complaint under that Statute, and the action must

50 be taken as one at common law. In cases of trade name (as distinguished from Trade Mark) the designation used must be such as to deceive the public (*Montgomery v. Thompson* ("Stone Ale" case), 8 R.P.C. 361; L.R. 1891 A.C. 217). But the public do not look at the name sand-blasted or moulded on the bottle, and there is no averment here of specific cases of deception.

55 This case is just similar to *Welch v. Knoti* (4 K. & J. 747), where an injunction was refused. There were three objections to relevancy; that there was no averment of presumable deception of the public; that there was no complaint

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prior to proceedings being taken; and that there was no reasonable averment of anticipated future injury to the Complainers.

McClure and A. A. Fraser (instructed by *George Arnot Eadie, S.S.C.*).—Intent to defraud purchasers is not a necessary ingredient in the offence (*Wood v. Burgess, L.R. 24, Q.B.D. 162*). It is enough that the Respondent has used the Complainers' name without their authority; they need not aver that the Respondent has deceived the public thereby. The Respondent may sell the bottles to a person who knows they have not been filled by the Complainers, but there is always the risk that, perhaps after having changed hands several times, they may ultimately be sold to the deceit of the public. The Respondent may not use the Complainers' name, though innocent of fraud (*Rose v. Loftus, 47 L.J. Ch. 576*); *Montgomery v. Thompson (ubi supra)* is distinguishable; there was an attempt to obtain a monopoly of a place-name. It is now too late to open up the matter of want of intimation. That should have been done in the Bill Chamber. Besides there was sufficient intimation by advertisement in the "Scotsman" on the 1st of March 1902. As to apprehension of future injury, it is averred that the Respondent may continue the practice to the detriment of the Complainers' business.

Ultimately Counsel for the Complainers adjusted the Record so as to meet the Respondent's objections. The amendments are shown in italics in the following quotations:—With regard to the deception of the public: "the name" upon the bottles, "besides assisting the owners to retrieve their property, is put upon the bottles as a trade name or trade description to inform the public (*and the public so understood*) that the contents are beer, ales or stout bottled by the Complainers." With regard to intimation: "The said *Edinburgh and District Aerated Water Manufacturers' Defence Association, Ltd.*, and the members, including the Complainers, have advertised repeatedly in the "Scotsman" newspaper that its members objected to the illegal use of their "trade names."

After these amendments had been made, the case was sent to Proof, which was taken on the 3rd of October and 10th of November 1903. From the Proof it appeared that, prior to the institution of the "Bottle Exchange" in March 1902, the practice was for bottlers who had sent out full bottles to receive back an equal number of empty ones in exchange, without regard to whether these empties were plain glass bottles or were stamped with their own name or with the name of another bottler. They would then fill these returned empties and send them out again. After the institution of the "Exchange" a kind of clearing house was established for the benefit of its members, to which all the bottles were sent to be sorted out, each bottler receiving back those marked with his own name. Many members of the trade were not members of the "Exchange." These could get their bottles from it on payment of a small commission. The Complainers themselves, before the institution of the "Exchange," were indifferent what bottles were returned to them, but after it was formed they endeavoured with its aid to obtain the return of, and to get control over, all their own bottles, yet they still accepted plain-glass bottles in exchange for their own. Suspecting that their bottles were being used by other bottlers they sent round to various shops, and found in that of *James Smith*, grocer, 160 Morrison Street, Edinburgh, three bottles stamped with their name, but filled by the Respondent and delivered by his servants to *Smith* on the 6th of December 1902, and fourteen, similarly stamped, filled by the Respondent and delivered to *Smith* on the 12th of December, 1902. Ten of these bottles were marked "*C. Woolley & Son, 49 Elm Row, Edinburgh*," and the remaining seven "*C. Woolley & Son, Edinburgh*." They had all conspicuous adhesive labels giving the name of the brewer of the beer they contained but no bottler's name. On the bottles being produced in Court, objection was taken to their production on the ground that by the Act of Sederunt of the 31st of May 1902 they should have been lodged on the 6th of November, four days

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before the proof, but were not lodged till the morning of the 7th of November. Lord KYLLACHY gave permission for their production on payment of 3l. 3s. expenses.

- McClure and A. A. Fraser for the Complainers.—There is here a misrepresentation to the public; the trade is an important part of the public; it supplies customers to the Complainers; the case depends on the question of fact whether there is misrepresentation (*Cowan v. Millar*, 22 R. 833; Lord Kyllachy's opinion). The Complainers may be injured in reputation by persons being led to suppose that ale was bottled by them which was really bottled by the Respondent. Bottling is a delicate operation requiring skill. [Lord KYLLACHY.—The question is whether the name embossed on the bottle if *primâ facie* the same thing as or is proved the same thing as the bottler's name on the label. The case of the bottler's name being on the label would be clear. If it found its way into any other dealer's hands and became his property he would be bound to tear the label off. But here it is impossible to sever the label.] We cite *Jenkinson v. Neilson Brothers* (2 F Justiciary Cases 13) and *Haddow v. Neilson Brothers* (2 F Justiciary Cases 19). The last proved that intent to defraud is not necessary. [Lord KYLLACHY.—That was a statutory charge under the Merchandise Marks Act.] The Merchandise Marks Act simply declares the common law. It is useless to say that the buyer in any particular case is not deceived provided the behaviour of the Respondents is calculated to deceive (*Rose v. Loftus (ubi supra)* and *Bayer v. Baird* ("C.B. Corset" case) 15 R.P.C. 615; 25 R. 1162).

- C. D. Murray and J. H. Henderson.—All law relating to the Merchandise Marks Act is here out of the question; there is no complaint under the Statute. Nor has any question of invasion of proprietary right been raised. The question is—Has the Respondent made a representation reasonably calculated to be injurious to the Complainers? Prior to March 1902 people filled the bottles indiscriminately. Before that time there could be no deception. The Complainers were barred by taking in bottles not marked by them in exchange for their own. It was not a case for interdict, as the Respondent was willing to give an undertaking not to use the Complainers' bottles in the future.

Lord KYLLACHY made avisandum with the cause, and on the 21st of November 1903 gave judgment refusing the suspension.

- Lord KYLLACHY.—The question in this case, as presented at the discussion, is not a question as to unlawful appropriation of the Complainers' property or as to infringement of the Complainers' Trade Mark. The facts, as they have come out, may suggest such questions. But they are not raised in this action, nor does the proof contain materials for their decision.
- The Complainers' case, as presented, is rested on a different ground, viz., that the Respondent, being, like the Complainers, a bottler of beer and ale, he (the Respondent) has bottled and put into the market beer contained in bottles embossed with the Complainers' name, and has thereby, as the Complainers say, represented that the beer so bottled and sold by him is beer of the Complainers' bottling. It is said that he (the Respondent) has thus deceived or attempted to deceive the public, and has done so to the Complainers' prejudice.

- Now it may be conceded that, if the bottles in question had been embossed not merely with the words "*C. Woolley & Co.*" but with the words "Bottled by *C. Woolley & Co.*" there would have been strong grounds for holding that this *primâ facie* involved a use of the Complainers' name, which, if it did not in fact deceive, was at least fitted to deceive the trade and the public. Further, even taking the words as they stand, it is probably true that it might be established by evidence that they bear, or have come to bear, the secondary sense which the Complainers attach to them. The questions, however, are whether they necessarily bear that meaning, and, if not, whether there is sufficient evidence that they are fitted to convey that meaning to the trade and the public.

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Having considered the proof, I find myself obliged to answer both questions in the negative. It is impossible, I think, to hold that necessarily, or even *primâ facie*, the sale of beer in bottles embossed with the Complainers' name involved a representation that the beer was bottled by the Complainers any more than it involved a representation that the beer was brewed by them, or that the bottles were made by them. *Primâ facie*, embossment of the name would seem only to indicate that the Complainers were owners of the bottles. And the evidence, if we are to appeal to the evidence, goes to show that, in point of fact, such was the main and primary object of the embossment—the object in view really being to secure the property of the bottles, and to facilitate their recovery when they became empty. 5 10

It therefore requires to be shown affirmatively that the understanding of the public, or at all events the understanding of the trade is, and in December 1902 was, that in the business of bottling the bottler is always the owner of the bottles used by him, and that such a thing as, for instance, the hiring of bottles, or the more or less promiscuous exchange of bottles, is a thing unknown. All this, I say, requires to be proved. And that being so, it is perhaps enough to say that the Complainers' proof appears to me to be insufficient. The evidence which they adduced did not, I must say, strike me, as, at the best, very convincing. But it involved, besides, several difficulties, which I think serious. In the first place, it seems clear that, prior to the institution of the "Bottle Exchange" in March 1902, there was a practically promiscuous usage by traders of the bottles of other traders. It further, I think, appears that from that date to the date of the acts complained of, less than a year had elapsed, a period I think hardly sufficient for any contrary usage to be recognised by the trade and the public. And then, lastly, I cannot overlook that, even in the Complainers' own practice—their practice down to the present time—there has been such an amount of looseness as to make it really impossible to affirm that their embossed bottles once put into the market may not quite in ordinary course pass by exchange into the possession and use, if not the ownership, of persons like the Respondent, persons taking such bottles in exchange for their own bottles, and proceeding to use them. 15 20 25 30

On the whole, therefore, I am of opinion that the Complainers have failed to prove that the Respondent's use of their bottles deceived the trade or the public, or was in the circumstances fitted to deceive the trade or the public. The result is that I must refuse the suspension, with expenses. 35

Burroughs, Wellcome & Co. v. Thompson and Capper.
In the Matter of the Trade Marks Nos. 36,154, 36,155, 42,378, 42,379, 225,812,
225,813, 225,814, 225,815, 225,816,
and
In the Matter of the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BYRNE.

November 20th, 21st, 23rd, 24th, 25th, 26th, 27th, and December 14th, 1903.

BURROUGHS, WELLCOME & CO. v. THOMPSON AND CAPPER.

5 IN THE MATTER OF THE TRADE MARKS Nos. 36,154, 36,155, 42,378, 42,379,
 225,812, 225,813, 225,814, 225,815, 225,816,

and

IN THE MATTER OF THE PATENTS, DESIGNS, AND TRADE MARKS
 ACTS, 1883 to 1888.

10 *Trade Mark.—Alleged infringement.—Passing off.—Motion to expunge Trade Mark from the Register.—Motion dismissed.—Fancy word.—Patents, Designs, and Trade Marks Act, 1883, section 64, subsection 1 (c).*

In and previously to the month of March 1884 the Plaintiff's firm B. W. & Co. were manufacturing and selling compressed drugs in a solid form and of a
 15 *lenticular or bi-convex shape. In 1884 B. W. & Co. registered the word "Tabloid" in Classes 3 and 42, and in 1885, in the same classes, a device consisting of a frame with the word "Tabloids" inside. H. S. W., the Plaintiff (who was the surviving partner of the firm of B. W. & Co.) claimed to have invented the word "Tabloid." The acts of the Defendants complained of by the*
 20 *Plaintiff consisted in selling goods not of the Plaintiff's manufacture in response to orders and prescriptions for drugs under the designation of "Tabloids," or "Tabloids—B. & W.," or "Tabloids—Burroughs, Wellcome & Co.," preceded or followed by the name of the particular drugs required. The Plaintiff's contention was that "Tabloid" and "Tabloids" were fancy*
 25 *words and that they meant exclusively the goods of B. W. & Co. The Defendants denied any passing off, and as to the Trade Marks moved to expunge them from the Register. They submitted that "Tabloid" was not a fancy word; that its nominal definition was "Tablet" and its real definition "solid compressed*
"drugs made up in a bi-convex or lenticular form and of small size," and

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that it was so particularly used by B. W. & Co. in 1884 and onwards to denote the various articles so sold; and, further, that it had not acquired an exclusive meaning as denoting the goods of B. W. & Co., but, on the contrary, had acquired a meaning connoting any compressed medicine made up in a bi-convex or similar shape, and denoted as well the goods of other 5 manufacturers as those of B. W. & Co.; and that it had also acquired an extended meaning by analogical transfer—e.g., “tabloid knowledge.”

Held, that “Tabloid” was a fancy word as applied to the goods for which it was registered, and that the Motion to rectify failed and must be dismissed; and that, to those who constituted that portion of the public, who were primarily 10 concerned in the matter, the words “Tabloid” and “Tabloids” meant and denoted, and had always meant and denoted, the goods of B. W. & Co.; that the Plaintiff had made out his case and was entitled to an injunction to restrain the Defendants from using the word “Tabloid” or “Tabloids” so as to pass off goods not manufactured by the Plaintiff as or for the goods of the 15 Plaintiff.

A Certificate was granted under section 77 (a) of the Patents, &c. Act, 1883, that the right to the exclusive use of the Trade Mark came in question.

Field v. Wagel Syndicate (17 R.P.C. 266) followed.

The Plaintiff H. S. Wellcome, a manufacturing chemist, the surviving partner 20 of the firm of Burroughs, Wellcome & Co., on the 17th of January 1903 commenced this action against the Defendants Thompson and Capper, who were chemists carrying on business at Manchester and elsewhere. He claimed—(1) an injunction to restrain the Defendants, their servants and agents, from in any manner passing off, or attempting to pass off, any preparation not of the manu- 25 facture of the Plaintiff as or for a preparation of the Plaintiff; (2) and from selling or offering, or exposing or advertising for sale, or procuring to be sold, any such preparation as aforesaid under the name of “Tabloid” or “Tabloids,” or “Tabloid B. W. & Co.” or “Burroughs, Wellcome & Co.’s Tabloids,” or 30 under any other name which by reason of colourable imitation thereof or otherwise was calculated to represent or lead to the belief that such preparation was a preparation of the Plaintiff; (3) and from selling or supplying any such preparation in response to orders for “Tabloid” products or a preparation of 35 Burroughs, Wellcome & Co.; (4) and from in any manner infringing the Plaintiff’s registered Trade Marks Nos. 36,154, 36,155, 42,378, 42,379, 225,812, 225,813, 225,814, 225,815, and 225,816, or any of them; (5) an Order for delivery up, &c.; (6) damages, or an account of profits; and (7) costs.

By his Statement of Claim the Plaintiff stated that his was an old-established and extensive business, and that (2) in the year 1884, or prior thereto, he was desirous of inventing and adopting a new and distinctive Trade Mark and trade 40 designation for goods of his which should effectively distinguish them from the goods of all others engaged in a similar business, and to this end he invented and adopted as his Trade Mark and trade name the word “Tabloid,” which had never existed before and was absolutely new and unknown. (3) On or about 45 the 14th of March 1884 he applied for and in due course obtained, in the name of his firm, the registration as of that date of the word “Tabloid” as his Trade

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- Mark No. 36,154 in Class 3 in respect of chemical substances used in medicine and pharmacy. He further subsequently, on or about the 27th of January 1885, applied for and in due course obtained similar registration as of the last mentioned date of the word "Tabloids" in a frame as his Trade Mark No. 42,378 in
- 5 respect of the same goods in Class 3. Both the registrations had been duly renewed and were standing in the name of the Plaintiff. (4) On or about the 14th of March 1884 he applied for and in due course obtained, in the name of the firm, the registration as of that date of the word "Tabloid" as his Trade Mark No. 36,155 in Class 42 in respect of preparations of food for human use.
- 10 He further subsequently, on or about the 27th of January 1885, applied for and in due course obtained similar registration as of the last mentioned date of the word "Tabloids" in a frame as his Trade Mark No. 42,379 in respect of the same goods in Class 42. Both the registrations had been duly renewed and were standing in his name. (5) At or about the date of the first registration he
- 15 began to use, and had ever since used, the word "Tabloid" as his distinctive Trade Mark in respect of a very great variety of goods of his manufacture. Such user had been on an enormous scale within the United Kingdom, and had been both on the bottles and receptacles in which the goods were sold, and also in numberless advertisements and other documents circulated among the trade,
- 20 the medical profession, and the public, for the purpose of advertising and popularising his goods. In addition to the British trade the mark had also been used most extensively in connection with goods exported by him to all parts of the world. (6) By reason of such user and of the novelty and distinctiveness of the Trade Mark and trade name, and of the very great expenditure of the Plaintiff in advertising and making it known, the same had become
- 25 and was very familiar to the trade and the medical profession and also to the public as indicating exclusively that any preparation to which it was applied or in respect of which it was used was a preparation of the Plaintiff's, and anyone who ordered or asked for any preparation by that name intended and expected
- 30 to receive a preparation of a particular make—i.e., the Plaintiff's make and no other. (7) The Defendants carried on business as chemists in Manchester at two shops, No. 51, Piccadilly, and No. 39, Deansgate, respectively, and were in the habit of supplying preparations not being the Plaintiff's preparations in response to orders for "Tabloids" or "Tabloid" preparations, even when the
- 35 name *Burroughs, Wellcome & Co.* or "B. W. & Co." was expressly mentioned. Amongst the Particulars given were the following:—(1) a verbal order for "*Burroughs, Wellcome & Co.'s Cascara Sagrada Tabloids*"; (2) a written order for "Tabloid Potassi Chlorate—B. W. & Co."; and (3) a written order for "Cascara Sagrada Tabloids—B. W. & Co.," and nine other orders, written and
- 40 verbal, for "Tabloids" of various kinds. (8) The goods supplied in response to such orders were in no single instance the Plaintiff's goods, and the Defendants were deliberately and knowingly selling other preparations in place of the Plaintiff's preparations and in response to orders for the Plaintiff's preparations, and were thereby representing that they were in fact the Plaintiff's
- 45 preparations, and were by so doing deceiving the public and injuring the Plaintiff, and unless they were restrained by the Order and injunction of the Court from continuing so to do they would still further deceive the public and injure the Plaintiff. The Plaintiff claimed—(1) An injunction to restrain the Defendants, their servants and agents, from in any manner passing off, or
- 50 attempting to pass off, any preparation not of the manufacture of the Plaintiff as or for a preparation of the Plaintiff; (2) and in particular from selling or offering or exposing or advertising for sale, or procuring to be sold, any such preparations as aforesaid under the name "Tabloid" or "Tabloids," or

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and
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"Tabloid—B. W. & Co." or "*Burroughs, Wellcome & Co.*—Tabloids," or under any other name which by reason of colourable imitation thereof or otherwise was calculated to represent or lead to the belief that such preparation was the preparation of the Plaintiff; (3) and from selling or supplying any such preparation in response to any order for "Tabloid" products or other preparations of *Burroughs and Wellcome*; (4) and from in any manner infringing the Plaintiff's registered Trade Marks Nos. 36,154, 36,155, 42,378, and 42,379, or any of them; (5) an Order for delivery up, &c.; (6) damages or an account of profits; (7) costs.

By their Defence the Defendants stated that—(1) the word "Tabloid" was not a new word or an invented word, but was merely the word "Table" with the common suffix "oid." The word was not distinctive of the Plaintiff's goods, but was a word commonly used in the medical and pharmaceutical professions and in ordinary literature to indicate shape or form; (2) they admitted the registrations set out in paragraphs 3 and 4 of the Statement of Claim. Such registrations were improperly made, and the Defendants were moving to rectify the Register by removing such marks therefrom. The Defendants had not infringed such Trade Marks or any of them; (3) they admitted that the Plaintiff had largely used the word as a descriptive word upon and in connection with medical preparations put up in tabloid form. Save as in the Defence admitted the Defendants denied that the said word had been used by the Plaintiffs; (4) they denied all the matters alleged in paragraph 6 of the Statement of Claim; (5) save as to the sales referred to in paragraph 7 of the Statement of Claim to *W. H. Sykes*, to *W. B. Davies*, and to *T. Smith*, the Defendants had no knowledge of the sales referred to in such paragraph, but as they claimed the right to sell medical preparations in tabloid form under their ordinary description of "Tabloids," they were prepared for the purposes of the action to admit the sales referred to in such paragraph other than the sales to *Sykes, Davies*, and *Smith*; (6) they did not supply to *Sykes, Davies*, or *Smith* any goods not of the manufacture of the Plaintiff as and for the goods of the Plaintiff. As to *Sykes and Davies*, both such purchasers were in terms informed by the Defendants' salesman that the goods supplied to them were not the goods of the Plaintiff but the goods of the Defendants. As to *Smith*, the Order was not in writing, but was given verbally, and no mention was made by *Smith* that the goods of the Plaintiff were required, nor was any written order given for such goods; (7) they admitted that the word "Tabloid" coupled with the letters "B. W. & Co." and the name "*Burroughs, Wellcome & Co.*" meant goods of the Plaintiff and no others. They had not supplied, and were not in the habit of supplying, any goods other than the goods of the Plaintiff under orders in which the word "Tabloid" was coupled with such letters or name; and they were and always had been ready to give any undertaking not to sell under orders so given any goods other than those of the Plaintiff. No notice of any such claim, or any notice at all, had been given to the Defendants prior to the issue of the writ in the action; (8) they denied each and every of the facts alleged in paragraph 8 of the Statement of Claim; (9) save as specifically or impliedly admitted they denied each and every of the allegations in the Statement of Claim as if the same had been specifically denied.

The Particulars of Objections upon which the Defendants relied in support of their motion to rectify the Register were as follows:—(A) As to all the "Trade Marks—(a) the word 'Tabloid' is not an invented word; (b) the word 'Tabloid' has reference to the character and quality of the goods to which it is applied; (c) the word 'Tabloid' does not consist of or contain any of the essential particulars specified in section 64 of the Patents, Designs,

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- “and Trade Marks Act, 1883; (d) the word ‘Tabloid’ was prior to the date of
 “the registration of the marks the word commonly and generally used to
 “describe small tablets or pilules. (B) As to Trade Marks Nos. 42,378 and
 “42,379—(a) the marks were registered without any disclaimer under
 5 “section 74 of the Patents, Designs, and Trade Marks Acts of the word
 “‘Tabloid.’ And the Applicants claim that such marks should be removed,
 “or, alternatively, that the Register should be rectified by the addition to the
 “Register of a disclaimer of any right to the exclusive use of the word
 “‘Tabloid’; (b) the marks are not used by the Respondents”; (c) the
 10 “Objections set out in paragraph (A). (C) As to the Trade Marks Nos. 225,812,
 225,813, 225,814, 225,815, and 225,816—(a) the Objections set out under para-
 graph (A); (b) none of such marks have been used upon any of the goods in
 Classes 1, 2, 39, 44, or 48, in respect of which the mark has been registered.
Moulton, K.C., Ralph Neville, K.C., Levett, K.C., L. B. Sebastian, and D. M.
 15 *Kerly* (instructed by *Markby, Stewart & Co.*) appeared for the Plaintiffs;
A. J. Walter and J. H. Gray (instructed by *Sharpe, Parker & Co.*, agents for
Alsop, Stevens, Harvey, and Crooks, of Liverpool) appeared for the Defendants;
R. J. Parker (instructed by the *Solicitor to the Board of Trade*) appeared for
 the Comptroller-General.
 20 *Neville, K.C.*, opened the Plaintiff’s case.—In 1884 the Plaintiff invented the
 word “Tabloid.” In the same year it was registered in Class 3 (drugs) and
 Class 42 (foodstuffs). In 1885 he registered a new mark, “Tabloids,” with a
 picture of a box, the latter being necessary because an accompanying device is
 25 essential to registration in Germany. The marks were registered for a number
 of other classes. The action is for infringement of Trade Mark and for passing
 off. The Defendants have a motion to expunge from the Register all marks
 for “Tabloid” and “Tabloids.” *Burroughs, Wellcome & Co.* have a “world-
 “wide” reputation as vendors of compressed medicines—both for the quality
 30 of the drugs and the accuracy of the doses. It is the practice of medical men
 to prescribe “Tabloids” of specific drugs, meaning *Burroughs, Wellcome &*
Co.’s drugs. The Plaintiff has no retail place of business. He neither deals
 with nor does he advertise to the public. It is well known in the medical
 profession and in the drug trade that “Tabloid” is the Plaintiff’s registered
 35 mark. From 1898, in consequence of occasional attempts to infringe the mark,
 warning circulars have been issued continually to the trade. There has been
 no standing by or toleration of infringement. In the only three known cases
 of infringement actions were commenced, and the Defendants therein consented
 to injunctions. [BYRNE, J., referred to the use of “oid” to denote form—
e.g., “ovoid.”] “Oid” is not exclusively used to designate form. “Tabloid”
 40 has not been used by *Burroughs, Wellcome & Co.* to connote a little medical-
 article of a particular shape, nor to signify that it is made in a particular way.
 There are fifty or sixty other dealers and manufacturers of compressed medicines,
 and in none of their price-lists is the word “Tabloid” used except to describe
 the Plaintiff’s goods. If the popular notion of the word had been that it
 45 connoted a small medicine and the trade notion had been the same it would
 have been adopted generally. The leading medical men, when prescribing, have
 sometimes used the word “Tabloid” alone, and sometimes to avoid mistake.
 “Tabloid B. & W.” or “Tabloid *Burroughs & Wellcome*,” meaning on each
 occasion *Burroughs, Wellcome & Co.’s* goods. The marks were registered as
 50 distinctive fancy words not in common use under the Act of 1883, and
 “Tabloid” is a fancy word. It has, however, been held under the Act of
 1888 which amended the Act of 1883 that the essential particulars under
 heads (d) and (e) of section 10 (subsection 1 of the Act of 1888), *i.e.* (d),

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"an invented word or invented words; or (e) a word or words having no
 "reference to the character or quality of the goods and not being a geo-
 "graphical name," are not to be read together, and the Act of 1888 says that
 the Act of 1883 is to be read as if section 64 stood in the amended form
 subject to the conditions in section 27 of the Act of 1888. Rectification of 5
 the Register is a matter within the discretion of the Court. If this word
 "Tabloid" is an invented word capable of registration to-day the Court
 would not order its removal only because it was incapable of registra-
 tion as a fancy word when actually registered. Assuming this construc-
 tion of the Statute to be right, the question is—Ought it to be 10
 registered to-day? If it ought, the Register ought not to be rectified. The
 view of the Comptroller of the Patent Office appears to be not contrary to this
 construction, for, rightly or wrongly, registration is refused under the Act of
 1888 if the mark is already registered under the Act of 1883. Again, *Re Batt* 15
 (15 R.P.C., p. 534) is not quite consistent with the universal proposition that the
 test is the right to register at the date of registration. It is, I submit, a good
 mark if it is either a fancy word or an invented word. And an invented word
 must necessarily constitute a fancy word, for until you apply it to the article
 it has no meaning; and a fancy word may be either an invented word or a dis-
 tinctive word not in common use provided that as applied to the goods in 20
 question it is obviously meaningless. The "Somatose" case (*In re Farben-*
fabriken Application, 11 R.P.C. 84; L.R. 1894 1 Ch. 645), which decided to the
 contrary, is no longer good law. A name registered as a Trade Mark very soon
 acquires a meaning, and the improper application of the name to other things
 is not material to the consideration of the issue. "Kodak," which was 25
 held to be a good mark, applicable both to a camera and its accessories, had
 acquired a general meaning apart from the particular goods to which it was
 applicable (*Eastman Photographic Company, Ltd. v. John Griffith Cycle Cor-*
poration, Ltd., 15 R.P.C. 105). To the people who use the name improperly it
 means a type. [BYRNE, J.—Like "Singer" type.] Yes, or "Demon" racquet 30
 —i.e., a racquet of a particular type. As to "Tabloid" being a fancy word under
 the Act of 1883, if it was so applied for the first time in respect to the particular
 trade of *Burroughs, Wellcome & Co.*, and was distinctive and not in common
 use, it is a fancy word within the Act (*Re Bouvil Trade Mark*, 13 R.P.C. 382;
 L.R. (1896) 2 Ch. 600). The decision in that case supports the argument, and is 35
 inconsistent with the decision as to "Somatose," a word with a less obvious
 reference to the article than "Bouvil." The House of Lords has placed the
 matter on a satisfactory basis. Their Lordship's speeches in *Eastman Photo-*
graphic Materials Company v. Comptroller-General (the "Solio" case)
 (15 R.P.C. 476; L.R. 1898 App. Cas. 571), and the reference therein to the 40
 report of Lord *Herschell's* Departmental Committee, show that the object of the
 Legislature was, on the one hand, not to make it difficult to get a distinctive
 mark on the Register, and, on the other, not to allow such latitude as to enable
 traders to infringe public rights or, to use the language of *Fry, L.J.* in *Re Dunn's*
Trade Mark (6 R.P.C. 386; L.R. 41 Ch. D. 455), "to enclose and appropriate 45
 "as private property certain little strips of the great common of the English
 "language." That is the principle of construction, and the "Solio" case decided
 that that object was given effect to by the Legislature in the Act of 1888. It
 was not intended that an invented word should be treated as an invention is 50
 treated under the Patent law—that is, as dependent on the sufficiency of its
 merit. It must not be a known word translated, but if it does not exist in any
 vocabulary it satisfies the Statute (*Re Densham's Trade Mark* ("Mazawattee"),
 12 R.P.C. 271; L.R. 1895 2 Ch. 176). [BYRNE, J.—"Oomo" was allowed

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- to be registered, although "Emu" was on the Register.] Yes, in *Burgoyne's Trade Mark* (6 R.P.C. 227). It was so remote from our language as not to be likely to deceive, and referred to nothing made from the emu. The objections to Trade Marks had been carried too far. The decision as to "Mazawattee" marked the turn in the tide. *Lindley, L.J.*, in the "Bovril" case (*ubi supra*) said:—"It is admitted that the word was new. It is admitted that it was one that was never heard before. If such a word as that is not to be deemed a fancy word it is difficult to say what is." If a word is an invented word *a fortiori* it is a fancy word, for it is not in common use and cannot be said to be descriptive. A word never known before can have, when found out, no meaning in the English language. It is true that you may discover, subsequently to its application to the article, by its derivation what meaning was in the mind of the inventor. But that is immaterial. It may come to have a meaning, but not until applied to the article. Lord *Macnaghten*, in the "Solio" case, seems to throw doubt on the definition of *Lopes, L.J.*—*i.e.*, "obviously meaningless." Decisions under the Act of 1883 upon words in common use like "Electric" and "Melrose" (*Van Duzer's Trade Mark*, 4 R.P.C. 31; L.R. 34 C.D. 623) are not authorities with regard to invented words. The public cannot be injured by the adoption of a word, as distinctive of a particular maker's goods, which never was before part of the English vocabulary. There has been continuous use of the word "Tabloid" since 1884 with the acquiescence of the whole trade. That is evidence that the word was one which did not interfere with the existing rights of the trade. Every reasonable intendment ought to be made after a long and uninterrupted user (*In re Registered Trade Marks of Bass, Ratcliff, and Gretton, Ltd.*, 19 R.P.C. 529). If "Tabloid" is not a good Trade Mark, it nevertheless has been known for a great many years as representing the manufacture of the Plaintiff. If it had at its inception any meaning at all other than *Burroughs, Wellcome & Co.*'s goods it has since acquired a secondary meaning—*i.e.*, *Burroughs, Wellcome & Co.*'s goods.
- As to infringement. Where a trader has for a Trade Mark a name applied to a thing, the goods of others may not be sold by them under that name. If they are so sold it constitutes infringement. The particular acts complained of in breach of the Plaintiff's rights are that, in response to verbal and written orders or prescriptions for particular drugs coupled with the words "Tabloid," or "Tabloids—B. & W.," or "Tabloids—*Burroughs, Wellcome & Co.*," the Defendants sold goods other than those of the Plaintiff's manufacture.

Evidence was then adduced on behalf of the Plaintiff.

- Levett, K.C.*, summed up the Plaintiff's case.—The Plaintiff has called London doctors, doctors and chemists from the principal provincial towns, representatives of London and country wholesale houses, representatives of the photographic trade, newspaper editors, and also manufacturers. These have spoken to the knowledge of "Tabloid" denoting the Plaintiff's goods. There were three cases spoken to of passing off under orders or prescriptions for "Tabloids—B. W. & Co." or "Tabloids—*Burroughs, Wellcome & Co.*" The other nine cases were sales in response to inquiries for "Tabloids." It is admitted by the Defendants that goods other than the Plaintiff's have been supplied in answer to orders for "Tabloids." Assuming that the Trade Mark is good, this is sufficient to constitute infringement. It is unnecessary for infringement that the word "Tabloid" should be placed upon the bottles. Upon the hypothesis that the Trade Mark is bad, four points have been conclusively proved in support of the action for passing off—(1) that the word "Tabloid" was not known before 1884; (2) that it came into knowledge as associated with the Plaintiff's goods; (3) that it has never been employed in association with the

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goods of anyone else ; (4) that so far as the "trade" is concerned it has been and is accepted as meaning the Plaintiff's goods. As to (1) there was no cross-examination, and as to (2) no trade list, advertisement, or circular was put in evidence which contained the word "Tabloid" except in reference to the Plaintiff's goods. No case was suggested in cross-examination of Plaintiff's 5 witnesses of any user by the "trade" of the word "Tabloid" in any sense differing from the Plaintiff's user. [BYRNE, J.—You say the primary meaning of the word is your goods and nothing else, and that so far as those goods were made in a particular shape a secondary meaning may have been more or less acquired by it?] As to the second point, we say there was an association of 10 ideas. It is from knowledge of the original article acquired through advertisement that the association of ideas, if at all, has taken place. That which originally has a definite meaning cannot lose it by reason of the association of ideas causing transfer of meaning to other things—e.g., "Tabloid knowledge," "Tabloid form," &c. The mere consequence of abstraction cannot make the 15 word a word of public right. It is said whatever the original meaning of "Tabloid" was it has come to mean a compressed drug of a certain shape. But the Plaintiff has had a continuous user, and to the trader "Tabloid" has had only one meaning—viz., *Burroughs and Wellcome*. The Defendants cannot say that the inaccurate public has made the word "Tabloid" mean a definite 20 shape. The word is a good fancy word. There is no such word as "Tabl," and if "Tabloid" is "oid" added to "Table" as suggested—meaning "like a table," then, assuming compressed tablets to be bi-convex in form, there is no such thing as a bi-convex table.

A. J. Walter opened the Motion to rectify and the Defendants' case in the Action. 25 —First, as to the Motion to rectify the Register : The Plaintiffs admit that they come under the Act of 1883, but seek to say, by way of appeal *ad misericordiam*, that they come under the Act of 1888. The validity of the registration must be determined under the Act of 1883, section 64. This is shown by sections 10, 27, and 28 of the Act of 1888, and section 90 of the Act of 1883. The word 30 was registered under section 64 (1) (c) of the Act of 1883 : "A distinctive device, "mark, brand, heading, label, ticket, or fancy word or words not in common "use"; and the "liability incurred" referred to in section 27 of the Act of 1888 is to be struck off under section 90 of the Act of 1883. Unsuccessful attempts have been made in the past to monopolise English words by adding 35 to them an ordinary suffix. *Hannay's Trade Mark* (7 R.P.C. 46) is an illustration. "Electroid"—the word there disallowed—was not in the dictionary. *Van Duzer's Trade Mark* (*ubi supra*) is the best authority on "fancy word" under section 64. "Tabloid" transgresses against the tests there laid down. It is so descriptive that it has been recognised by seven or eight dictionaries. 40 At its inception it could have had no other meaning than "Table," plus "oid"—"of the nature of a table." "Oid" in English has become a substitutive and not an additive suffix—e.g., rhomboid, fungoid, &c. It is said the Plaintiffs taught the public the meaning of "Tabloid." That is not the test. The test is—What would any ordinary person accustomed to the English language 45 think it meant? It must be tested in relation to that in respect of which the Trade Mark is registered. When the Plaintiffs were using "Tablet" registered as a Trade Mark, they had threatened to restrain its user by other persons. Finding they could not succeed they tried "Tabloid." "Tablet" is manifestly derived from "Table," and "Tabloid" is a mere substitution for 50 "Tablet." Even assuming that the Act of 1888 applies, the mark is bad and must be struck off. If the Plaintiff was the inventor, the authorities are opposed to the proposition that it is necessarily a fancy word. It is not an

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invented word within the rules laid down in the "Solio" case. It trespasses against every distinctive characteristic of an invented word there laid down. That the word has not appeared in the same form before is not the test of invention. A mere variation of the termination of a word will not suffice if to the eye or ear the original idea of the word is conveyed. "Bovril" differs from "Tabloid." There is no suffix "ril" in English. No meaning could have been attached to "Bovril" at the date the word was invented. Could it be said in 1884 that, applied to articles in the shape of tablets, "Tabloid" was non-descriptive and meaningless? The test as laid down is that the word must be non-descriptive and meaningless as applied to the article to which it was intended to be applied. [BYRNE, J.—Suppose it were applied to a liquid medicine?] It has not been so used. It has been used solely for compressed tablets, and was registered for that class. It is a word signifying an article. The word must be regarded not at large but in view of that to which it is applied (*Waterman's Trade Mark*, 5 R.P.C. 368; L.R. 39 C.D. 29). *Meaby & Co., Ltd. v. Triticine, Ltd.* ("Triticumina") (15 R.P.C. 1) confirms the principle laid down in *Van Duzer's* case with regard to such words—i.e., the word must be obviously not intended to be descriptive; it also establishes that a mere suffix will not take the word out of the descriptive category. *Grossmith's Trade Mark* (6 R.P.C. 180) illustrates the application of the principle. *Field v. Wagel Syndicate* (17 R.P.C. 276) follows the decision in "Solio." Secondly, as to infringement of Trade Mark: There is no evidence of infringement of Trade Mark. Neither by labels placed on the goods, by description in writing, nor in any similar way have the Defendants used the word "Tabloid." Infringement of Trade Mark consists in applying the mark to goods, or a substantial part of the goods, or something connected with them. It has never been decided otherwise (*Rugby Portland Cement Company, Ltd. v. Rugby and Newbold Portland Cement Company*, 8 R.P.C. 241; 9 R.P.C. 46). Thirdly, as to passing off: The Plaintiff's case is that not the public but the medical profession and wholesale and retail chemists know that "Tabloid" means their goods, and consequently that he has done nothing to teach the public that it was connected with his goods. The *ratio decidendi* of every case has been the protection of the great public, and that the ultimate purchaser shall not be deceived. The Plaintiff in the first instance used the word descriptively—i.e., of compressed drugs in tabloid form (see the "Chemists and Druggists' Diary" of 1885, at page 116; of 1887, at page 112; and of 1888, at page 119). Later "Tabloid" was placed in inverted commas with the words "Trade . . . Mark" placed on either side, and then it became "Tabloid . . . products" and then "Trade Mark." The case now made is that it means, not compressed drugs, but the goods of *Burroughs, Wellcome & Co.* It was known in the trade that "Tabloid" was registered as the Trade Mark of *Burroughs, Wellcome & Co.*, and that they had a right which they might seek to enforce. But the fact that the people did not care to incur the expense of a law suit is no evidence of a valid monopoly right. People were frightened, and acquiesced in a monopoly based on a Trade Mark to which the Plaintiff was not legally entitled. To the public the word means an article simply. To succeed the Plaintiff must show that the word has lost its primary descriptive meaning of an article so that all and several know that it means the goods of *Burroughs, Wellcome & Co.* It has not such a secondary meaning. In both *Wotherspoon v. Currie* (L.R. 5 E. & I. App. 508) and *Reddaway v. Banham* (13 R.P.C. 218; L.R. 1896 App. Cas. 199) the finding on the evidence was that the words had ceased to have any meaning except that of the goods of particular persons. In the *Cellular Clothing Company, Ltd. v. Maxton and*

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Murray (16 R.P.C. 387 ; L.R. 1899 App. Cas. 326) conflicting evidence was given and the decision was adverse. With regard to the use of the word "Tabloid" in connection with "B. W. & Co." or "*Burroughs and Wellcome*," no notice was given to Defendants prior to the issue of the writ.

Evidence was then adduced in support of the Defendants' case.

Walter summed up the Defendants' case.—The Defendants' evidence shows that "Tabloid" has no signification whatever of the Plaintiff's goods, and the Plaintiff has produced neither prescriptions nor orders from which it might be seen whether or not the word had been used in a broader sense than that imputed to it by him. "Tabloid" and "Tablet" are used interchangeably to denote a compressed drug. [BYRNE, J.—What is the earliest use of the word "Tabloid" other than as indicating *Burroughs, Wellcome & Co.*'s goods?] In *Hoblin's* "Dictionary of Terms," dated 1887, and the "Practitioner" of April 1887. The earliest prescription was in 1893. Had *Burroughs, Wellcome & Co.* taken out a Patent in 1884 for an invention of a thing and called it "Tabloid" they could not have claimed the exclusive use of the term "Tabloid" after the expiration of 14 years. Where there is a monopoly claim based on a Trade Mark protected by threats of legal proceedings the alleged exclusive user must be closely scrutinised on the question of passing off. The principle of the right of action as to passing off is that you may not afford to one person the opportunity of passing off on the public goods which they do not intend to purchase. The public do not mean by the use of the word "Tabloid" *Burroughs, Wellcome & Co.*'s goods. The trade alone recognises the right of *Burroughs, Wellcome & Co.* to the word "Tabloid." The doctors called for the Plaintiff admitted that their patients asked for medicine in tabloid form. "Tabloid" is an English word. This is an attempt to prevent a legitimate development of the English language. The breadth of meaning of some words increases day by day, so that it becomes desirable to vary them to express refinements of meaning. Particularly is this so in English, and "Tabloid" in the same way is only the variant of a well known word. It had a primary meaning *ab initio*, e.g., a compressed drug, and did not require to have one attributed to it by association of ideas—the result of user. There was no "invention" in the proper sense of the term. "Tabloid" was first used as a descriptive word, and at once took its place in the English language. As to the specific allegations of passing off, five months have elapsed since the alleged sales and no notice was given. The evidence is not satisfactory.

Neville, K.C., in reply in the Action and summing up the Plaintiff's case on the Motion to rectify.—The Defendants' witnesses say they would not sell anything but *Burroughs and Wellcome's* products to the public under the term "Tabloid" unless it should appear clearly that an error had been committed. This puts an end to their case that they are justified in infringing because the public do not attribute to "Tabloid" the meaning "*Burroughs and Wellcome*." They have no right to assume that the public attribute a meaning different from their own. [BYRNE, J.—Putting on one side the question as to the orders given under "B. W. & Co." &c., and assuming that the Trade Mark is not valid, must not you show that "Tabloid" has acquired a secondary meaning, i.e., *Burroughs, Wellcome & Co.*'s goods, to the exclusion of all others?] There is no conflict of evidence as to its meaning in the trade. On that evidence it would be a fraud on the Plaintiff for the trader to sell under "Tabloids" any other maker's goods. Exceptions may always be found to the general use of a term in a population of 42,000,000. The proposition that the law protects the public and not the trader is inconsistent with the authorities. Unless "Tabloid" has come to connote secondarily a compressed

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drug simply, and ousted the original meaning of *Burroughs, Wellcome & Co.*, the Defendants and others are not entitled to act upon it. "Tabloid" never had any meaning but that of the Plaintiff's goods. It was originally distinctive of their goods, and was not an ordinary English word. To succeed the Defendants must prove a secondary (generic) meaning, and that "Tabloid" never in any substantial number of cases means the Plaintiff's goods (*Faulder & Co. v. Rushton*, 20 R.P.C. 477). As to infringement, the *Ruby Portland Cement Company, Ltd. v. Rugby and Newbold Portland Cement Company* (*ubi supra*) does not support the Defendants' proposition, that there is no infringement of a Trade Mark unless it is attached in some way to the goods. [BYRNE, J.—Is there any case where on Trade Mark alone an injunction has been granted except in respect of the user of the mark by the application of the word or device to something?] To send back the order with a stamp on is sufficient. The question was discussed but not specifically dealt with in *Kodak, Ltd. v. London Stereoscopic and Photographic Company* (20 R.P.C. 337). There goods were supplied together with an invoice. Where the goods have acquired a name from the Trade Mark, you may equally restrain the use of the name (*Re Trade Mark of La Société Anonyme Des Verreries De l'Etoile*, 11 R.P.C. 142; L.R. 1894 2 Ch. 26). If the word "Tabloid" is used in an order for goods it is then adopted by the vendor. It is the wrong to the Plaintiff and not the fraud on the public that gives the Plaintiff his right of action (*Webster v. Webster*, 3 Swanston 490). The distinction is that a member of the public cannot sue except in an action of deceit. He must base his relief on fraud, but the trader need not. As to rectification: whether "Tabloid" was a distinctive fancy word not in common use in 1884 is a question of fact. You may not take the article sold under the Trade Mark, compare this with it, and see if you can discover a meaning descriptive of the article. The Defendants' interpretation is *post hoc ergo propter hoc*. You must not get the meaning of the word inferentially. In *Re Cheseborough Manufacturing Company's Trade Mark* (18 R.P.C. 190) "Vaseline" was applied to a newly invented article (*see* 19 R.P.C. 342). This is distinguishable, for in the present case anybody was entitled to sell compressed drugs in the same shape and form. They were so sold before "Tabloid" was registered.

R. J. Parker for the Comptroller.—The crucial date in considering the Trade Mark is the date of registration. What has happened since is irrelevant. This view has been confirmed by the Court of Appeal. The Comptroller's practice is to refuse to register a mark under the Act of 1888 if it has been already registered under the Act of 1883, except on the terms that the earlier mark is taken off the Register. There might be cases where registration would be possible under the Act of 1888 although the registration was wrong under the Act of 1883. It is not admitted in the Trade Mark Office that the validity of a mark under the earlier Act may be maintained while at the same time registration is sought under the later Act. It is unfortunate that the Motion for rectification and the Action for passing off should come on together. The evidence in each case is very different. The question in one relates to the date of the acts complained of, while the question in the other has reference to an earlier date. The essential thing to be proved in the old action for infringement, as distinguished from that arising under the Statute, was that at the time the acts complained of were committed the mark used did have the effect of distinguishing the goods of the Plaintiff from those of the person said to have infringed. The sole question under the Statute is whether anything has been done in infringement of a mark rightly on the Register. It is not whether the mark still distinguishes the goods of the particular manufacturer. Under the

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old system it was advantageous to choose a mark which would at the moment and in the future naturally distinguish the goods of its proprietor from the goods of all others. It seems now to be conceded that the best sort of mark to register is one which at first may be said to distinguish the goods of a particular manufacturer from all others, but which will soon become popular and be identified with the goods themselves. In *Re Chesebrough Manufacturing Company's Trade Mark* (19 R.P.C. 342; L.R. (1902) 2 Ch. 1) "Vaseline" was used as a Trade Mark before 1875, and registered under the Act of 1875. It now denotes a particular substance. The changed meaning has not affected the validity of the mark. This monopoly value is an accidental result of the Trade Mark Acts, and has nothing to do with Trade Marks at common law. [BYRNE, J.—The adoption into our language of a Trade Mark, good when originally registered, does not invalidate the Trade Mark?] No, the manufacturer or trader advertises his Trade Mark and hopes that in the course of time it will become identified with the goods. It is an important consideration in relation to the exercise by the Comptroller of his discretion under the Statute, but it does not affect the question when considering whether it was properly put on the Register. Under the Act of 1883 the word must be not only a fancy word but also distinctive, and evidence that in 1884 "Tabloid" was a generic term might naturally affect the question.

Walter in reply on the Motion.—The question is not—is "Tabloid" a distinctive word, but was it at the date of registration as applied to the goods for which it was intended to be used? "Tabloid" is a variant of "Tablet." "Tablet" is the English form of the French "tablette"—a little table—the "ette" being a diminutive. It denotes a small dose. "Tabloid" is an English word, meaning "of the nature of a table," though not strictly a table.

BYRNE, J.—I have to deal with an Action to restrain passing off of goods not of the manufacture of the Plaintiffs as or for their goods, and particularly from selling, or offering for sale, any such goods under the name "Tabloid" or "Tabloids" and from infringing the registered Trade Marks, and with a Motion on the part of the Defendants to expunge the Trade Marks in question from the Register.

It will be convenient to deal first with the Motion. In and previously to the month of March 1884, the Plaintiff firm were manufacturing and selling compressed drugs in a solid form and of a lenticular or bi-convex shape. On the 14th of March 1884, they registered in Class 3 in respect of substances, not included in Class 1, used in medicine and pharmacy the word "Tabloid," and on the 27th of January 1885, they registered in the same class the representation of the top of a box with the word "Tabloids" upon it. It was explained that this latter registration was in order to be able to register the word in Germany, where such registration would not be granted, except in connection with a device and previous registration in England. These registrations have been renewed, and are in force. The Plaintiff firm have continuously made and sold compressed drugs ever since the date of the original registration of the word "Tabloid." These drugs have always been made and sold of the original shape and size, but they have also been sold of various other sizes, and of different shapes, chiefly, however, of a form more or less bi-convex. The list of drugs and compounds of drugs so made and sold has been extended from time to time, but the Plaintiff firm have always sold their solid compressed drugs in connection with the word "Tabloid" or "Tabloids." The registration was under the Act of 1883, and, having regard to the terms of section 64, subsection 1 (c), the question is whether or not the word "Tabloid" was a distinctive fancy word not in common use at the date of registration—namely, the 14th of March 1884. It is

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important to keep the date in mind in considering the matter, and this was forcibly brought home to me in the present case by the fact that when the word "Tabloid" was first mentioned I quite thought it was a common dictionary word in the English language long before 1884, but I am satisfied that this was really
5 due to my acquaintance with the word as used in connection with the compressed drugs of the particular shape I have described which have become so well known since the year 1884. The words "Table" and "Tablet" were, of course, well known, and the latter in reference to solid drugs at least as early as the time of Lord Bacon. I find in the 1848 Quarto Edition of *Johnson's*
10 Dictionary the definition of "Tablet" is:—"First, a small level surface; 'secondly, medicine in a square form.'" And then there is a quotation from Lord Bacon: "It hath been anciently in use to wear tablets of arsenic as 'preservatives against the plague as they draw the venom to them from the 'spirits.'" In the Imperial Dictionary of 1868, I find this definition (No. 4) of
15 "Tablet": "A medicine in a square form. Tablets of arsenic were formerly 'worn as a preservative against the plague. A solid kind of electuary or confection made of dry ingredients, usually with sugar, and formed into little 'flat squares, called also lozenge and troche, also applied to anything made up 'in a flat square shape as a tablet of soap.'" The word "Tablet" had also been
20 used to denote compressed drugs made up in the bi-convex shape in question by the Plaintiff firm in connection with *Wyeth's* tablets and by some other persons. The Plaintiff firm had registered the word "Tablet" for the same class intending to use it as their Trade Mark, but finding that it could not be sustained, Mr. *Wellcome* set about finding a new word and invented the word
25 "Tabloid." This word was certainly not in common use, for it was unknown before and was used by this firm for the first time.

The case of the *Trade Mark Bovril*, before the Court of Appeal in 1896, relieves me from a close examination of earlier cases, and gives me a guide in endeavouring to determine whether or not "Tabloid" was a fancy word. The
30 earlier leading cases of *Van Duzer's Trade Mark* and *Leaf's Trade Mark* were cases in which, as pointed out by Lord *Lindley* in the "*Bovril*" case, a coined word was not under consideration at all, but ordinary English words. "Where," says Lord *Lindley*, "you have got a fanciful use of a known word you must 'have a word which is obviously non-descriptive.'" Further, he said: "But I
35 'agree that a word which describes the article will not do. To my mind it is 'not descriptive, notwithstanding Mr. *Bower's* very ingenious argument. He 'tries to make it out to be a descriptive word, not by taking the word, but a 'little bit of it, and he says that because 'Bov' may have some relation to 'ox,' therefore, 'Bovril' describes what? I do not see that it describes any-
40 'thing at all.'" I think I also get this from the "*Bovril*" case, that it is not necessary that the word should be absolutely unsuggestive. The word "*Bovril*" was suggestive of "ox," but, as a whole, was held not to be descriptive.

The argument in the present case for the Applicants was, that there is a word to be dealt with compounded of "Table" or "Tablet" with a common suffix
45 "oid." To the last Mr. *Walter*, with his accustomed skill, would not pin himself to one or other. There were, he says, the words "*Tabellæ*," "Table," "Tablet" in common use, and "Tabloid" must be taken from part of one or other of them, and the rest of the word is made up by adding a common suffix, "oid" meaning "in the form of" or "like" or "allied to," used in a great
50 many English words, and especially in connection with scientific nomenclature, and though part of the root or suggesting word is left out the word "Tabloid" means something like or allied to things denoted by one or other of the old words. On the other hand, it was forcibly urged that the only attribute common

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to the things denoted by the words "Table" and "Tablet" is the suggestion of flatness on one side or other, or on both sides, of the object, without any notion of convexity. Suppose "Tablet" be the word supposed to have the common suffix appended, it is to be noticed that the new word is not "Tabletoid" but, "Tabloid," a possible, but not the most obvious formation, 5 while, if "Table" be the word, though "Tabloid" would probably be a natural way of adding the suffix by analogy to other words constructed in a similar form, the word so constructed would mean allied, not to a "Tablet" but to a "Table," but though solid drugs in certain form were known as "Tabellæ" or "Tabulæ," there is nothing that I can find to denote convexity or 10 compression in the word.

I think the case is near the line, but treating it as a matter of fact, I come to the conclusion that in March 1884 the word was not "really intelligibly" describing the thing sold," which is the way in which Lord *Lindley* in the "Bovril" case puts the form of direction to a Jury. I agree that there is a 15 suggestion or atmosphere of description about the word as used, but I do not think that it can be said to have been other than a "fancy word" as applied to goods in the class in which it was registered. The Motion must, therefore, be dismissed.

I now come to the other part of the case. It is clearly proved that since the 20 registration of the words "Tabloid" and "Tabloids" the Plaintiff firm have continuously and to an enormous extent advertised, sold, and denoted their goods in connection with the registered words. They deal only wholesale. That portion of the public to which they appeal directly is mainly composed of doctors, chemists, nurses, and those concerned in the ordering, preparation, and 25 administration of drugs; and it is to these that their advertisements, trade lists, and trade documents are directed. To every medical practitioner, to every chemist and qualified chemist's assistant, and to every known nurse in the empire, diaries are, and have for many years been, sent annually, in which Messrs. *Burroughs and Wellcome's* goods are referred to and denoted as "Tabloid" or 30 "Tabloids." I had the evidence of a very representative body of medical men and chemists, which convinces me that to those who constitute that portion of the public who are primarily concerned in the matter, the words "Tabloid" and "Tabloids" mean and denote, and have always meant and denoted, the goods of the Plaintiff firm. All that could be done by owners of a trade name 35 to protect it has been done. The Plaintiff firm has been vigilant, even to the extent of persuading compilers of modern dictionaries to correct, and to undertake to correct, their definitions of the word "Tabloid."

There is one peculiarity in the case I must mention. The word "Tabloid" has become so well known and appreciated in consequence of the use of it by 40 the Plaintiff firm in connection with their compressed drugs that I think it has acquired a secondary sense in which it has been used, and may legitimately be used so long as it does not interfere with their trade rights. I think the word has been so applied generally with reference to the notion of a compressed form or dose of anything, from literary education and household 45 dwellings, and sometimes also, perhaps, as denoting a bi-convex form of drug, and various works, including numbers of "Punch," have been referred to showing such use of the word.

Mr. *Walter* ingeniously suggested that the Plaintiff firm have sought to rob the English language by preventing its natural development in endeavouring to 50 appropriate such a word as "Tabloid," which he puts as being a natural development of the word "Table" or "Tablet"; but I think it is more correct to say that the Plaintiff firm have made a gift, such as it is, to the language, while

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reserving a special use of it to themselves. The trade lists employed in the drug trade are unanimous in their testimony, as well negative as positive, to the true meaning of the word as applied to compressed drugs. A large number have been produced, not one of which uses the word in reference to the goods of anyone except the Plaintiff firm, and all of which refer to their goods in connection with the words "Tabloid" and "Tabloids."

I am satisfied as a result of the evidence of the medical men and chemists, who have given their testimony, that, speaking generally (though there are exceptions) to doctors who prescribe and use the word "Tabloids" the word means and intends the goods of the Plaintiff firm; to the chemists and others concerned in the drug trade who dispense and sell the drugs the word has the same meaning. Sometimes doctors add to the word "Tabloids" the name of the firm or the letters "B. & W.," but this is by way of extra caution to ensure against the substitution of drugs of a less reliable or lower standard than that of those prepared by the Plaintiffs.

I quite agree that there is a considerable section of the public knowing and using the drugs, who have not noticed or observed the distinction between "Tablets," under which name a very large number of compressed drugs of bi-convex shape are, and have for a long time past been sold, and "Tabloids," so as to identify the latter with the manufacture of the Plaintiff firm. When, given in pursuance of a prescription the "Tabloids" are often, perhaps generally, so put up as not to disclose the name of the maker. This, I suppose, is to protect the chemist and to entitle him to charge as for medicine made up to prescription. Besides this, although the Plaintiff firm supply their goods to chemists in their own small bottles and tin boxes to be retailed, they sometimes supply them in bulk, and then the chemists may, and sometimes do, put them into small bottles and sell them in connection with their own name with labels, calling them "Tablets" not "Tabloids," and supplying them in answer to a request for either "Tablets" or "Tabloids." Though this is not complained of, it must have some effect in preventing the retail customer from having his attention so pointedly called to the fact that the words "Tabloid" and "Tabloids" denote the goods of a particular firm as would be the case if the "Tabloids" were always retailed under that denomination in connection with the Plaintiffs' firm name or initials. Nevertheless, though I have evidence of mistakes in ordering goods as "Tabloids" when the goods of other makers are really wanted, I consider the evidence does show, again speaking generally, that members of the public, when they ask for "Tabloids," mean and expect to get the goods of the Plaintiff.

Upon this part of the case I think that the Plaintiffs have discharged the obligation referred to by Lord *Herschell* in the "Two D" case (*Leahy, Kelly, and Leahy v. Glover*, 10 R.P.C., at page 155) when he says that, "The foundation of a passing off case is that the party alleging it should prove in the first instance that any name which he claims as his trade name has been so extensively used in connection with his manufacture or with the goods which he sells that his goods have come to be known in the market by that name, that anyone using that name would intend to refer to his goods, and that anyone to whom the name was used would understand that his goods were referred to."

The Defendants are manufacturing and retail chemists carrying on a large business. They have businesses at several different places, including two shops in Deansgate and Piccadilly, Manchester. They have sold in response to orders

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for "Tabloids" goods not of the manufacture of the Plaintiff firm. Until about the middle of last year the great bulk of the compressed drugs sold by the Defendants at their Manchester shops were of the manufacture of the Plaintiff firm. The Defendants and all their assistants knew that "Tabloids" denoted the goods of the Plaintiff firm. Since the date in question the Defendants have stocked compressed drugs of other makers, and they have sold, in bottles labelled "Tablets" in connection with their own name goods of the Plaintiffs as well as goods of other manufacture. The bottles and labels are not distinguishable, and they are as a rule kept in one glass case, though it is said that they are, or ought to be, on different sides of it. It has been proved that on the 10th of September 1902 the Defendants supplied to *Winifred Davies*, in fulfilment of a prescription "Tabloid Potassii Chlorate—B. W. & Co.," things which were not the Plaintiffs'. On the 12th September 1902 Mr. *Thomas Smith* was supplied with "Cascara Sagrada" in similar shape and form to the "Tabloids" of the Plaintiff firm in response to a request for "Cascara Sagrada Tabloids," which were described on a list shown to and read by the assistant as "Cascara Sagrada Tabloids—B. & W." On the 13th of August 1902 Mr. *W. H. Sykes* was served with goods not the Plaintiff's, they having been represented to him as the Plaintiff's goods in reply to an express inquiry whether they were *Burroughs and Wellcome's* goods. I have specially mentioned these three cases, because there was a passing off where the goods were not denoted as "Tabloid" or "Tabloids" only, but in such a way as to make it absolutely certain that the goods of the Plaintiff firm were referred to by the use of their name or initials. There were nine other cases where the goods were referred to as "Tabloid" or "Tabloids." In all twelve cases were proved, seven taking place at the Piccadilly shop and five at the Deansgate shop. One was in August 1902, five in September, one in October in the same year, and five in January 1903. Nine were accompanied by the production of writing showing what was wanted. The witnesses gave their evidence well, and I believe them. Some point was made that they were, with, I think, two exceptions, clerks in the office of a firm of Manchester solicitors, who were instructed by the Plaintiff's solicitors, and some point was also made of the fact that no notice was given of the occasions until after the issue of the writ in the action. The orders were all what are called trap orders, and the Court is always careful to see that traps when set are fairly set, and in some cases to refuse to attach weight to evidence of casual transactions where the matter depends upon the effect of some exchange of remarks made weeks or months before the trial, and where notice has not been given within reasonable time after the event of the intention to rely upon what is alleged to have taken place. In each case the circumstances must be considered, and in the present case I think that the traps were fair, and that the instances given in the Particulars have been proved. I think the Plaintiff is entitled to an injunction independently of the question of registered Trade Mark.

There is one point in the form of the Order. There are several marks referred to. I think I only heard argument with respect to the marks for this particular class? Is not that so? There were some general observations made about the others, but I have not even got the details of them—there are several.

Levett, K.C.—The Statement of Claim is confined to four, but the notice of Motion went to several more.

BYRNE, J.—If there is any special argument founded on any of these—

Walter, K.C.—No, I think not.

Levett, K.C.—It is the same word in different classes.

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An injunction was awarded in accordance with the second claiming clause in the Statement of Claim, with 40s. damages and costs, and (following *Field v. Wagel Syndicate*, 17 R.P.C. 266) a Certificate that the right to the exclusive use of the Trade Mark came in question.

5

IN THE HIGH COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, and STIRLING.

November 9th, 1903.

FELS v. CHRISTOPHER THOMAS & BROTHERS, LD.

Trade Name.—"Naptha."—*Action to restrain passing-off.*—*Name associated*
 10 *with Plaintiffs' goods by public for two years.*—*Descriptive word.*—*No right of*
action in Plaintiffs, who are unable to claim such a name as their own, to an
injunction restraining its use even where it is not properly descriptive.—*Appeal*
dismissed.

The Plaintiffs, Fels & Co., were manufacturers in America of a cold water
 15 *household soap which from its commencement in 1894 they had sold under the*
name "Fels-Naptha," naphtha being in fact an important ingredient in the
soap from its special cleansing qualities. They commenced substantial sales
of their soap in England in February 1900 under the above name, but it
appeared that dealers and customers had frequently, while the Plaintiffs' soap
 20 *was the only soap of the kind on the market, designated this soap by the simple*
names "Naptha" or "Naptha Soap." In the latter part of 1902 the Defendants
commenced to manufacture and sell a similar soap, which was put upon the
market as "Christopher's Naptha Soap—Christr. Thomas & Brothers, Ltd.,

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"Bristol." There was a conflict of expert evidence of analysts with respect to the presence of naphtha in the Defendants' soap, all the analysts called for the Plaintiffs alleging that it did not contain naphtha but only contained a distinct chemical substance called naphthaline. Judgment was given for the Defendants. The Plaintiffs appealed. 5

Held, that, the word being a descriptive term as applied to the Plaintiffs' soap, the Plaintiffs had not discharged the onus of proving the identification of the name "Naphtha Soap" with themselves, which they must do in order to ask the Court to find that the Defendants had intended passing-off; and that the presence of naphtha in the Defendants' soap was irrelevant. 10

This was an appeal by the Plaintiffs from a decision of Mr. Justice Kekewich* dismissing the action. The general facts as to the Appellants' trade will be found in the report of *Fels v. Hedley & Co., Ltd.*† In this case the Respondents were the actual manufacturers of the soap complained of. Their soap was a cold water household soap similar to the Appellants', and was sold in wrappers, but there was no claim made by the Appellants in respect of "get-up." In their Statement of Defence the Respondents, amongst other things, had alleged as follows:—"The Defendants say that they are selling a soap made with naphtha, and of their own manufacture, under the name of 'Christopher's Naphtha Soap—' 15
 " 'Christr. Thomas & Brothers, Ltd., Bristol, and with a statement that the 20
 " same 'is of first-class English make,' and they claim to be entitled so to
 " describe their said soap, and thereby to inform the public what is the character
 " of their said soap, and who are the makers thereof and where it is made.
 " There is no single particular in the manner in which the Defendants' said
 " soap is got up for sale or sold which bears any special resemblance to any 25
 " particular in the manner in which the Plaintiffs' said soap is got up for sale
 " or sold." The Statement of Defence concluded as follows:—"This action is
 " brought by the Plaintiffs for the purpose of preventing the Defendants and
 " the soap trade generally from describing soap made with naphtha as 'Naphtha
 " 'Soap,' and the Defendants submit that the Plaintiffs are not entitled to 30
 " prevent them from so doing, and that this action should be dismissed with
 " costs." With regard to the presence of naphtha in the two soaps there was
 again a conflict of evidence between the chemical experts. Whereas in *Fels v. Stephenson Brothers, Ltd.*,‡ the dispute was as to the amount of naphtha which was in fact contained in the Defendants' soap, and as to its detergent efficiency, 35
 in the present case it was contended for the Appellants that the Respondents' soap contained no naphtha at all, but only a distinct product called naphthaline, not belonging to the same chemical family as the naphthas, possessing no detergent or cleansing qualities, and not soluble in water. The analyst called by the Respondents said that he had found 1 per cent. of the naphthaline, 40
 but had also found $\frac{1}{2}$ per cent. of naphtha in the Respondents' soap, which amount of the latter he admitted might not have any practical cleansing effect.

The Plaintiffs appealed, and the appeal was heard on the 9th of November 1903.

Moulton, K.C., Neville, K.C., J. Cutler, K.C., and Waggett (instructed by 45
 Campbell and Baird) appeared for the Appellants; Warmington, K.C., Warrington, K.C., and Sebastian (instructed by Field, Roscoe & Co.) appeared for the Respondents.

* 20 R.P.C. 447.

† *Post*, page 91.

‡ 20 R.P.C. 443 and *post*, page 89.

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Neville, K.C., for the Appellants, stated the facts of the case, and laid stress on the evidence that there was no naphtha at all in the Respondents' soap. [ROMER, L.J.—There was an interval of two years between *Fels*' invention and introduction on to the market of a new kind of soap containing naphtha, and called

5 "Naphtha," and the beginning of the Respondents' trade. Does the evidence justify our finding that what was clearly descriptive had during that period come to have a secondary meaning?] Yes, because the name "naphtha" is so wide in connotation that it does not lead the mind to the article itself; but when it had become identified with the Appellants' trade, the Respondents

10 came, not to put a good new detergent soap on the market, but to steal that trade if they could. This case is really within *Powell v. Birmingham Vinegar Brewery Company* (14 R.P.C. 720; L.R. (1897) A.C. 710).

Moulton, K.C., followed for Appellants.—The Court will infer from the Respondents having taken the name "Naphtha," when there is in fact none in

15 their soap, that they knew the term had a special meaning in the market, as was inferred in *Reddaway v. Banham* (13 R.P.C. 218; L.R. (1896) A.C. 199). [VAUGHAN WILLIAMS, L.J.—But, if "Naphtha Soap" means naphtha soap, you have no case.] The decision of Lord Westbury in *M'Andrew v. Bassett* (4 De G. J. & S. 380), where the antecedent user was only about two months,

20 was right. If the Appellants can show that their manufacture is ordinarily called by a name, whether it be descriptive, nickname, or any other, then the Court will stop any other being passed off under that name. The basis of the case is that the public are deceived.

Counsel for the Respondents were not called on.

25 VAUGHAN WILLIAMS, L.J.—In my judgment this appeal ought to be dismissed. The question which we have to determine here is a simple question of fact. I do not for one moment deny that, quite apart from any property which has been created by Statute in registered Trade Marks, a trader

30 may practically get property in a mark or name which is placed on his article, although he has no registered Trade Mark, and even although the name which is given to the article, which he manufactures and vends, may be a name which he has not himself given to the article, but one by which the public have come to call the article vended by him. If once you arrive at the conclusion that there is some name or other by which those who use it always mean to designate

35 an article of particular manufacture, then you have to look at the evidence to see whether the Defendant in using that name, did so with the intent of passing off his goods as being the goods of the manufacture of the person whose articles had come to be generally indicated by that name. But before you can come to the conclusion that there has been imitation, you must

40 first come to the conclusion that the Plaintiff's articles have come to be known by the particular name which it is suggested is used by the Defendant for the purpose of imitation with the object of passing off his goods as the Plaintiff's goods. Now I do not think here that has been established at all. I think that the words "Naphtha Soap" have not in fact come to be used by the public as

45 indicating especially the Plaintiffs' soap. The Plaintiffs called their soap, originally, "Fels-Naphtha," and that was the name they intended to attribute to their soap. They introduced it into this country. No doubt it had a rapid success. It seems to have been the first naphtha soap which was introduced into this country, and I am not surprised that for a long time—not a very

50 long time—a good many customers who came into shops to buy soap did not say "Fels-Naphtha Soap," but they said "Naphtha Soap." I do not myself think that the evidence in any way establishes that when they said "Naphtha Soap" they meant naphtha soap according to any particular receipt, made in any particular fashion. I think that they asked for "Naphtha Soap" because

55 they wanted soap with naphtha in it, and that they merely omitted the name, because, at that time, when only one person was using this new invention, it was very natural that the buyers should merely ask for the popular "Naphtha

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"Soap—soap with naphtha in it. Presently there came other soaps on the market—I do not mean the Defendants' soap, but "Rock Oil Soap" and some other soap—I forget what the name of it was. The evidence is that as soon as ever these other soaps came into the market, then, when the retailers dealing in that soap were asked for "Naptha Soap," they would say to their customers, 5
"Which 'Naptha Soap' would you like—*Fels*'s, *Thomas*'s, or *Stevenson*'s? This shows conclusively that in the minds, at all events, of those retailers, "Naptha Soap" had not become especially appropriated to soap of the Plaintiffs' manufacture. The moment that one comes to that conclusion, the next conclusion that follows on that is almost consequential. If the name had 10
not become so appropriated, imitation for the purpose of passing of goods becomes proportionately improbable, and, under these circumstances, I have no hesitation whatever myself in finding the fact, which, as I understand Mr. Justice *Byrne* and Mr. Justice *Kekewich* both found, that the name "Naptha" was not used by the Defendants for the purpose of imitation of the Plaintiffs' 15
soap, with the object of passing off the Defendants' soap as being of the Plaintiffs' manufacture.

I do not know that there is any need to read any judgments in other cases upon the subject. There was read to us in the course of the argument a passage from Lord *Davey*'s judgment in the *Cellular Clothing Company v. Maxton* (16 R.P.C. 397; L.R. 1899 A.C. 326), in which, whilst pointing out that it is possible in the case of a descriptive name to have imitation and passing-off, he points out that it is always a difficult case to prove, and I should think, *a fortiori*, a difficult case to prove where the Plaintiffs have another and specific name, which, by advertisements all over the world—advertisements which we 25
have been told cost an enormous sum of money—they have tried to get their wares known by another name—not as "Naptha Soap," but as "*Fels-Naptha Soap*."

In my judgment the decision of Mr. Justice *Kekewich* was perfectly right. There was nothing in this case at all, like the celebrated letter in *Reddaway*'s case, in the slightest degree to support the allegation that the giving of this descriptive name in this case was done for the purpose of imitation and passing-off. 30

ROMER, *L J.*—I am of the same opinion. Really to my mind this is a very simple case, and I shall confine myself to saying that the term "Naptha," as applied to soap by the Plaintiffs, was clearly a descriptive term. It was applied to soap by them, the original manufacturers, because the soap which they sold under that name contained naphtha and was a good detergent, and apparently because, at the time their soap was first put upon the market, or first manufactured, naphtha, as an ingredient in soap, was somewhat of a novelty, if not an absolute novelty. Then the Plaintiffs put their soap on this market 40
somewhere about the year 1900, but they sold it here as "*Fels-Naptha Soap*," that is to say, as naphtha soap manufactured by *Fels*; it is largely advertised, and the Plaintiffs are fortunate enough to have no other naphtha soap put on the market in this country for some two years, and so they get a large sale. During that time, before other manufacturers in this country prepared and sold 45
naphtha soap, the customers, who knew the Plaintiffs' soap and liked it, not unnaturally then asked for it as "Naptha Soap" simply, and, of course, there being no other manufacturer's soap on the market, when they spoke of the soap as "Naptha," they meant the Plaintiffs' and nobody else's soap. Of course they could at that time have meant nobody else's soap, but such evidence as that, 50
and the evidence generally that we have in this case, is to my mind wholly insufficient to enable this Court to say that what was originally a purely descriptive term has acquired a secondary signification, so as to give the Plaintiffs a sort of proprietary right in the term—a right to say that nobody else can, without risk of having their goods said to be calculated to deceive, sell 55
soap under the name "Naptha" in this country. No such secondary signification of the term "Naptha" has been proved to exist in this case, and that being

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so the basis on which the Plaintiffs' case in this action was framed falls to the ground. I need scarcely say there is nothing in the case, to my mind, which would enable the Plaintiffs' case to acquire a different position, because they seek to make out, with more or less success, that the Defendants' soap contains
 5 very little, if any, real naphtha in it. It appears to me that that is an irrelevant factor under the circumstances.

STIRLING, *L.J.*—I am of the same opinion. In my judgment the word "Naphtha" in "Naphtha Soap" was from the first, and still remains, simply a descriptive word.

10

IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, and STIRLING.

November 24th, 1903.

FELS v. STEPHENSON BROTHERS, LD.

Trade name.—"Naphtha."—*Action to restrain passing-off.*—*Name associated*
 15 *with goods by public.*—*Naphtha an actual ingredient in Plaintiffs' and Defendants' goods.*—*Descriptive word.*—*Injunction refused.*

The Plaintiffs, Fels & Co., were manufacturers in America of a cold water household soap, which from its commencement in 1894 they had sold under the name "Fels-Naphtha," naphtha being in fact an important ingredient in
 20 *the soap from its special cleansing qualities. They commenced substantial sales of their soap in England in February 1900 under the above name, but it appeared from the evidence given in this action that dealers and customers had frequently, while the Plaintiffs' was the only soap of the kind on the market, designated this soap by the simple names "Naphtha" or "Naphtha*
 25 *"Soap." In the latter part of 1902 the Defendants, who were wholesale and retail grocers, commenced selling a similar soap made by certain manufacturers,*

Fels v. Stephenson Brothers, Ltd.

which was put upon the market as "Rock Oil Naptha Soap." Apart from the general trade evidence, the expert evidence of analysts was adduced, which showed that only a small amount of naphtha, far less than in the Plaintiffs' soap, was contained in the Defendants' soap. Judgment was given for the Defendants. The Plaintiffs appealed. On the appeal coming on for hearing, 5 an Order was simply taken dismissing the appeal with a view to the consolidation of this and two similar actions for the purposes of an appeal to the House of Lords.

This action was very similar to that of *Fels v. Christopher Thomas and Brothers, Ltd.*, reported above;* the general facts were common to both cases, 10 and the Plaintiffs' claim was based only on the name of the soap and on the secondary meaning of "Naptha." They made no claim in respect of "get-up."

Mr. Justice Kekewich dismissed the action,† and the Plaintiffs appealed.

The appeal was heard on the 24th of November 1903, shortly after the 15 Plaintiffs' appeal in their action against *Christopher Thomas and Brothers, Ltd.*, had been dismissed.

Waggett (instructed by *Campbell and Baird*) appeared for the Appellants; *Sebastian* (instructed by *Field, Roscoe & Co.*, agents for *Bateson, Warr and Wimshurst*, Liverpool) appeared for the Respondents. 20

Waggett, for the Appellants.—This Court has heard the evidence in this action when hearing the appeal in *Fels v. Christopher Thomas and Brothers, Ltd.*, and it would not be respectful to argue this case here having regard to the judgments of this Court in that case. It has been arranged that if these cases are taken to the House of Lords there may be consolidation of the actions; but 25 your Lordships will simply dismiss this appeal with costs.

VAUGHAN WILLIAMS, *L.J.*—Yes.

* *Ante*, page 85.

† 20 R.P.C. 413.

Fels v. Hedley & Co., Ltd.

IN THE COURT OF APPEAL.

Before THE LORD CHIEF JUSTICE and LORDS JUSTICES VAUGHAN WILLIAMS
and ROMER.

November 30th, 1903.

5

FELS v. HEDLEY & CO., LD.

Trade name.—"Naphtha."—*Action to restrain passing-off.*—*Name associated with goods by public.*—*Descriptive word.*—*Get-up.*—*Injunction refused.*

The Plaintiffs, Fels & Co., were manufacturers in America of a cold water household soap, which from its commencement in 1894 they had sold under the name "Fels-Naphtha," naphtha being an important ingredient in the soap from its special cleansing qualities. They commenced substantial sales of their soap in England in February 1900 under the above name, but it appeared that, while the Plaintiffs' was the only soap of the kind on the market, it had extensively become the popular practice for dealers and customers to designate their soap by the simple names "Naphtha" or "Naphtha Soap," and the Plaintiffs therefore contended that those names denoted their soap. In August 1902 the Defendants Thomas Hedley & Co., Ltd., put upon the market a similar soap also containing naphtha, under the name "Ladybird Naphtha Soap," the word "Ladybird" being their registered Trade Mark and used for all their goods. It appeared that the Defendants' soap had also been supplied in response to orders for "Naphtha" or "Naphtha Soap," and was sold in wrappers similar to the Plaintiffs' (but bearing the Defendants' Trade Mark "Ladybird" and also a registered device), of which the Plaintiffs also complained. Held, at the trial, by Mr. Justice Byrne—(1) that the get-up of the Defendants' goods, apart from the use of the words "Naphtha Soap," was not calculated to deceive; (2) that as applied to the goods in question the name "Naphtha" was a descriptive word, denoting an ingredient contained in them; (3) that the Defendants had done no more than they were legally entitled to do. The action was accordingly dismissed. The Plaintiffs appealed.

Fels v. Hedley & Co., Ltd.

Held, on appeal, that, the decision of Mr. Justice Byrne on the absence of secondary meaning in the words "Naphtha Soap" being correct, there was no evidence of deception by similarity of "get-up." The appeal was dismissed accordingly.

This was an appeal by the Plaintiffs from a decision of Mr. Justice Byrne. 5

The Plaintiffs, *Samuel Simeon Fels* and *Joseph Fels*, carrying on business under the style of *Fels & Co.*, were American manufacturers of soap who had carried on their business at Philadelphia for upwards of twenty years past. At a time prior to 1894 they had commenced to manufacture and sell household soap of an improved and special variety with exceptional cleansing powers, and it became their sole product. From the first they had applied to their soap the name "Fels-Naptha" so spelt. It appeared during the trial that the spirit called "naptha," or "naphtha" was in fact an ingredient in the Plaintiffs' soap, and gave to the soap its deterative or cleansing quality. The amount of this ingredient did not appear in evidence in this action, but a special 10 characteristic of the soap was that it could only be properly used with cold or tepid water, thereby saving the expense of copper fires and the inconvenience of steam. 15

From 1894 to 1899 small quantities of sample packets were imported to England for gratuitous distribution. In February 1900 the Plaintiffs made 20 their first large consignment to their agents in this country for commercial purposes; from that date onwards the Plaintiffs by extensive advertising and otherwise had widely promoted the reputation and sale of their soap, with the result that a large and increasing demand for it was created.

It was alleged by the Plaintiffs that, "notwithstanding that the Plaintiffs 25 'themselves gave to their said soap the longer name of 'Fels-Naptha,' it has 'for some time past been the common and popular practice for dealers and for 'members of the public applying as retail customers to be supplied with the 'said soap to designate and refer to the said soap by the shorter designation 'Naphtha,' and in consequence of this practice the name 'Naphtha' has become, 30 'and is, the popular name for the said soap, and has become identified with 'that soap, and customers at retail shops as well as dealers themselves mean 'and intend in asking for or referring to 'Naphtha Soap' to ask for or refer to 'the said soap of the Plaintiffs and no other.'"

From the time of its first introduction and without variation the 35 Plaintiffs' soap had been made up only in the form of oblong bars of one uniform size and put up in paper wrappers, which are more particularly described below.

In August 1902 the Defendants, *Thomas Hedley & Co., Ltd.*, soap manu- 40 facturers at Newcastle-upon-Tyne, put upon the market a household soap containing naphtha, sold in bars of the same shape and size at 2d. a bar. Wrappers were used for the Defendants' soap, which was called "Ladybird "Naphtha Soap," the word "Ladybird" being a fancy name registered as a Trade Mark by the Defendants, and used by them for the articles of their manufacture; another registered Trade Mark of the Defendants, consisting of a 45 circular device, also appeared on the wrapper among the letterpress. The Defendants' wrapper is more particularly described below.

On the 23rd of October 1902 the Plaintiffs commenced this action against the Defendants, claiming—"(1) An injunction to restrain the Defendants, their 50 'directors, officers, servants, and agents from selling or offering for sale, or 'advertising or procuring or enabling to be sold or offered for sale, any soap 'not of the Plaintiffs' manufacture as or for 'Naphtha Soap' or under any name 'or wrapper or in any get-up designed or calculated to induce the belief that 'the soap so sold is soap of the Plaintiffs' manufacture, and from passing off or 'enabling others to pass off soap not of the Plaintiffs' manufacture as or for 55

Fels v. Hedley & Co., Ltd.

"the goods of the Plaintiffs, whether by means of name, wrappers, or get-up or otherwise howsoever. (2) An injunction to restrain the Defendants, their directors, officers, servants, and agents from selling or offering for sale or advertising any soap not of the Plaintiffs' manufacture under any name of which 'Naptha' or 'Naphtha' forms part without clearly distinguishing such soap from the goods of the Plaintiffs. (3) Delivery up or destruction of all such wrappers in the Defendants' possession as are complained of in this action. (4) Damages or an account of profits and payment. (5) Costs."

The Defendants in their Defence contended that the word "Naptha" was in fact applied to the Plaintiffs' soap merely in order to describe its nature, naphtha being the important constituent, and they denied that in popular usage the Plaintiffs' soap had come to be known as "Naptha Soap" so as to distinguish it from any other soap made with naphtha. On the 11th of December 1902 they wrote to the Plaintiffs offering to discontinue their then wrappers and to destroy their stock of them, without prejudice to their right to continue to describe soap made with naphtha as "Naptha Soap." The Plaintiffs refused this offer, but notwithstanding the Defendants altered their wrappers by substituting blue panels for green.

When the action was tried by Mr. Justice *Byrne*, in March 1903, evidence was adduced on both sides and is summarised in the report of that trial.* The particular evidence of actual deception referred to in the argument before the Court of Appeal was given by a large number of witnesses, e.g., by *Maud Clifford* who always called the Plaintiffs' soap "Naptha Soap," and having asked for "Naptha Soap" at a shop with the intention of getting the Plaintiffs', was supplied with a packet of the Defendants', and she did not notice the difference until she had used the soap and then hunted up the wrapper; and by *Mary Ann Millhouse*, whose evidence was substantially the same, except that she destroyed the wrapper of the soap supplied to her. The two wrappers in question were thin sheets of papers (common in size), light buff in tint, and both pink in appearance, the Plaintiffs' from being covered with a groundwork of pink writing, and the Defendants' from a groundwork of pink lines; each wrapper included a number of panels, the largest of which bore the words "Fels-Naptha" and "Ladybird Naptha Soap" respectively; the ground of each of these larger panels was dark green, until the Defendants after action brought altered theirs to blue as mentioned above.

The Plaintiffs appealed from the decision of Mr. Justice *Byrne*, and the appeal was heard on the 30th of November 1903, subsequently to the appeals in *Fels v. Christopher Thomas Brothers, Ltd.*, and *Fels v. Stephenson Brothers, Ltd.*†

J. Culler, K.C., and *Waggett* (instructed by *Campbell and Baird*) appeared for the Appellants; *Warmington*, K.C., *Levet*, K.C., *Sebastian*, and *Howard E. Wright* (instructed by *Field, Roscoe & Co.*, agents for *Bateson, Warr and Winshurst*) appeared for the Respondents.

J. Cutler, K.C.—The Appellants refrained in this Court from arguing the case against *Stephenson Brothers, Ltd.*, because the evidence was the same in both that case and the case against *Christopher Thomas and Brothers, Ltd.*, in which the Court had previously decided against the Appellants. In the present case the evidence is different, but the evidence as to the word "Naptha" meaning the Plaintiffs' goods is of the same character as that in the other cases, so it would not be right to argue that point here; but that does not conclude the matter, because here we have evidence of actual deception of the public by means of the Defendants' wrapper. [The learned Counsel here shortly opened the salient facts of the case, and continued]—The public here have actually been misled by the Respondents' wrapper, which is the only one proved in the case at all like the Appellants'. This is "an eye-sight case," but more from

* 20 B.P.C. 437.

† *Ante*, pages 85 and 89.

Fels v. Hedley & Co., Ltd.

the point of view of the purchaser than of the Court. [Lord ALVERSTONE—Have you any witnesses who relied on the green and pink of the wrapper?] No, but a large number say that being supplied with the soap of the Respondents they thought they had the Appellants', which they had wanted, and never found out their mistake until they had got the soap out of the wrapper and began to use it. The spelling of "Naptha" without the second "h" by the Defendants is significant. [Lord ALVERSTONE—Do you suggest that the domestic purchaser would go by that?] No, but I rely on this point as evidence of copying. The Appellants had enjoyed two and a half years' identification of this name and wrapper with their goods, which had had enormous sales, and the Respondents have put an instrument of fraud into the hands of the trade, when they should have taken special precautions to distinguish their goods. This case is exactly within *Magnolia Metal Company v. Atlas Metal Company* (14 R.P.C., 389) and should be dealt with as *Collins, J.*, dealt with that case. If the case had been tried by a jury, I should have contended that the verdict was contrary to the evidence. [Lord ALVERSTONE.—What is your strongest evidence?] Counsel then read the evidence of *Maud Clifford* and *Mary Ann Millhouse* referred to above.

Counsel for the Respondents were not called on.

Lord ALVERSTONE, *L.C.J.*—This is really asking us to reverse Mr. Justice *Byrne* on a question of fact. Mr. *Cutler* has very properly read the strongest evidence that he could. It is clear to my mind that that evidence and the same given by thirty other witnesses shows that they were called in order to establish the case that the Plaintiffs had a right to the word "Naptha," on the ground that it had come to acquire a secondary meaning as denoting their soap, and really was not evidence on the point of make up. I should certainly come to the same conclusion that Mr. Justice *Byrne* did.

I can see no ground for interfering with his judgment on that which was a pure question of fact.

VAUGHAN WILLIAMS, *L.J.*—I agree.

ROMER, *L.J.*—I agree.

Fels v. Hodgson and Simpson.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BUCKLEY

January 11th, 1904.

FELS v. HODGSON AND SIMPSON.

- 5 *Trade name.*—"Naphtha."—*Action to restrain manufacturers from passing off their soap as the Plaintiffs'.*—*Previous action against retailers in respect of same soap dismissed.*—*Dismissal affirmed by the Court of Appeal.*—*Present action dismissed.*—*Arrangements as to appeal.*

- 10 The Plaintiffs in this action were Messrs. *Fels & Co.*, and the action was brought on the 11th of October 1902, claiming an injunction "to restrain the Defendants, their servants and agents, from selling, supplying, advertising or offering for sale any soap not of the Plaintiffs' manufacture as 'Naphtha Soap' or 'Naptha Soap,' or under any name or description whereof 'Naphtha' or 'Naptha' forms part, or in any manner using the word 'Naphtha' in connection with the sale or advertisement of any soap not of the Plaintiffs' manufacture without clearly distinguishing the goods, in connection wherewith such word is used, from the goods of the Plaintiffs, and from passing off, or enabling others to pass off, soap not of the Plaintiffs' manufacture as or for the goods of the Plaintiffs."
- 15 "the goods of the Plaintiffs."
- 20 On the same date *Fels & Co.* commenced an action against *Stephenson Brothers, Ltd.*, claiming a similar injunction. The soap complained of in both actions was the same—*Hodgson and Simpson* being the manufacturers and *Stephenson Brothers, Ltd.*, retailers thereof. The action against *Stephenson Brothers* was tried before Mr. Justice *Kekewich* in March 1903, and resulted
- 25 in the dismissal of the action, and this was affirmed by the Court of Appeal on the 24th of November 1903.*

On the 11th of January 1904 the present action came on for trial before Mr. Justice BUCKLEY.

- 30 *Waggett* (instructed by *Campbell and Baird*) appeared for the Plaintiffs; *Sebastian* (instructed by *Field, Roscoe & Co.*, as agents for *Bateson, Warr & Co.*, of Liverpool) appeared for the Defendants.

* *Ante*, page 89.

Fels v. Hodgson and Simpson.

Waggett, after stating the circumstances as to the two actions, said that it did not seem right to trouble the Court with this action, and he asked for leave to discontinue it.

Sebastian submitted that the action ought either to be brought on or dismissed. 5

Waggett stated that an appeal to the House of Lords in the action against *Stephenson Brothers* was under consideration.

Sebastian said that if the Plaintiffs consented to this action being dismissed he would agree that they should not be debarred from appealing after the proceedings in the House of Lords. 10

BUCKLEY, J.—You cannot contractually extend the time for applying to the Court of Appeal. It is a matter for them. Therefore it ought to be, that the Defendants will not oppose the Plaintiffs applying to the Court of Appeal for leave to appeal at any time within three weeks after the decision of the House of Lords. It is for the Court of Appeal and not for me to extend the time for 15 appealing.

The action was dismissed with costs on these terms.

Christy & Co. v. Tipper & Son.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before LORDS JUSTICES VAUGHAN WILLIAMS and STIRLING.

August 12th, 1903.

Before MR. JUSTICE KEKEWICH.

5 November 27th, 1903.

Before MR. JUSTICE JOYCE.

January 19th, 20th, 21st, and 22nd, and February 1st, 1904.

CHRISTY & CO. v. TIPPER & SON.

- Trade Mark.—Passing off.—Motion to rectify Register.—Invented word.—*
- 10 “Absorbine.”—Mark registered subject to a note on the Register.—Application before trial for commission to take evidence abroad refused.—Application to set down question of law refused.—Action dismissed.—Mark ordered to be removed from Register.—Patents, &c. Act, 1883, section 64; Patents, &c. Act, 1888, section 10.
- 15 In 1901 Y., carrying on business in the United States, registered the word “Absorbine” as a Trade Mark in Classes 2 and 3, stating in his application that no claim was made to the exclusive use of the word “Absorb,” and this disclaimer appeared on the Register. He used the word, which he himself had invented some years before, as the name of a liquid veterinary preparation, of
- 20 which there were large sales in the United States, and considerable advertisement from 1894 onwards in American papers circulating in this country; there had also been some sales in the United Kingdom from 1894. In 1901 C. & Co., carrying on business in the United Kingdom, became Y.’s agents. In 1901 T. & Son, who had for many years sold an absorbent ointment
- 25 for veterinary purposes as “Absorbent Ointment,” changed the name to “Absorbine,” but had not sold under that name until shortly after Y.’s application to register, although catalogues and labels having the new name in them had been prepared before that date. T. & Son had acted bonâ fide, and they

Fels v. Hodgson and Simpson.

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Christy & Co. v. Tipper & Son.

did not know of Y.'s use of the word "Absorbine" until December 1902, when they complained of it, and in 1903 Y. and C. & Co. commenced an action against T. & Son to restrain them from infringing the Trade Marks and from passing off. T. & Son moved to rectify the Register by removing the Trade Marks on the grounds that the word was not an invented word at the date of registration, 5 and was descriptive, and had been used before registration by themselves and others. It appeared that another firm had used the word to some extent before the registration, but they decided not to oppose the registration. Two interlocutory applications were made; one by the Plaintiffs for a commission to the United States to take evidence, especially as to the circulation in England 10 of American papers and magazines in which the Plaintiffs had advertised "Absorbine." This application was granted by Kekewich, J., but the Order for a commission was, on appeal, discharged by the Court of Appeal. The second interlocutory application was by the Defendants to have the question of law separately argued whether "Absorbine" was a registrable word. This 15 application was refused by Kekewich, J. The action and motion to rectify were heard together.

Held, that no case of passing off had been established, and that "Absorbine," whether it was a mis-spelling of "absorbing" or formed by adding the common termination "ine" to "absorb," was not an invented word. The 20 Trade Mark was ordered to be expunged in both classes, and the action was dismissed.

Eastman Photographic Materials Company's Application (15 R.P.C. 476; L.R. (1898) A.C. 571) discussed and followed.

On the 21st of November 1901 Wilbur Fenelon Young, a manufacturing 25 chemist carrying on business in the United States, applied to register the word "Absorbine" as a Trade Mark in Class 2 in respect of chemical substances used for agricultural, horticultural, veterinary and sanitary purposes, and the mark was registered under the number 242,163, the following disclaimer being entered on the Register, namely:—"No claim is made to the exclusive 30 "use of the word 'absorb.'" He also registered the word "Absorbine" in Class 3 in respect of chemical substances prepared for use in medicine and pharmacy under the number 242,164. The final notification of registration was on the 21st of June 1902, the registration having been delayed owing to the alleged user by Corbyn, Stacey & Co., hereinafter referred to; but, after the 35 time for opposition by them had been extended by consent to the 9th of June 1902, they decided not to oppose registration.

On the 30th of March 1903 Thomas Christy & Co., a firm of wholesale 40 druggists carrying on business in the City of London, and the sole agents of W. F. Young in the United Kingdom for the sale of "Absorbine," and W. F. Young commenced an action against B. C. Tipper & Son, who carried on business in Birmingham as manufacturers and vendors of medical preparations for veterinary purposes, claiming an injunction to restrain the Defendants, their servants and agents—(1) from selling or offering or exposing or advertising 45 for sale or procuring to be sold any veterinary preparation not of the Plaintiffs' manufacture under the name of "Absorbine," or under any other name which by reason of colourable imitation thereof or otherwise was calculated to represent or lead to the belief that such preparation was a preparation of the Plaintiffs; (2) from in any manner infringing the Plaintiffs' registered Trade Mark

Christy & Co. v. Tipper & Son.

No. 242,163; (3) and from in manner aforesaid or in any other manner passing off or enabling or assisting others to pass off any such veterinary preparation as aforesaid as or for a preparation of the Plaintiffs, and for other consequential relief.

- 5 Prior to the commencement of the action correspondence had passed between the parties. On the 6th of December 1902 the Defendants wrote to the Plaintiff *Young*, having seen an advertisement of his "Absorbine" in "Land and Water," complaining that the name was an infringement of a preparation which they made; and a correspondence ensued, in which the Plaintiffs referred to their
10 registrations, and on the 20th of February the Plaintiffs' solicitor wrote asking the Defendants for an undertaking in certain terms, but in the end the action above stated was commenced.

- The Plaintiffs by their Statement of Claim alleged—(2) that the "Absorbine" preparation manufactured by the Plaintiff *W. F. Young* had been publicly
15 sold in the United Kingdom for a number of years past under the name and Trade Mark "Absorbine" and had had a good sale; that the same had also been well advertised in the United Kingdom in various ways at considerable expense, and it had for many years past been well known in America and in many parts of the world; (3) that the word "Absorbine" had been registered
20 as set out in this report; (4) that by reason of the merits of the preparation and of the attractiveness of the name and of the expenditure of the Plaintiffs in advertising the same the said name and Trade Mark "Absorbine" had become and was well known as indicating exclusively that any veterinary preparation to which it was applied was a preparation made and sold by the Plaintiffs, and
25 anyone who asked for or ordered a veterinary preparation under the name "Absorbine" intended and expected to receive the Plaintiffs' said preparation and no other; (5) that the Plaintiffs had recently discovered that the Defendants were offering for sale and selling a veterinary preparation intended as a remedy for the same ailments as their said "Absorbine" preparation under the same
30 name "Absorbine," and they requested the Defendants to desist from so doing; that the Defendants, however, declined to do so; and (6) that the Defendants had caused damage to the Plaintiffs and had made profits.

- The Defendants by their Defence admitted the registration of the Trade Mark, but alleged that the registration in each class was improper, and, after
35 refusing to admit paragraphs 2 and 4 of the Statement of Claim, alleged—(4) that the Defendants and their predecessors in title had for upwards of 40 years past carried on a large and high class business as manufacturers and vendors of various medical preparations for veterinary purposes, which preparations had been and were extensively known and used in the United Kingdom
40 and had a high reputation; that one of the Defendants' said preparations, which had been sold by them and their predecessors in business for many years past, consisted of ointment used as a remedy for bony and glandular enlargements; (5) that the Defendants' said ointment was (prior to August 1901) advertised and sold by the Defendants under the name of "Absorbent," but in or about
45 August 1901 the Defendants, having exhausted their printed catalogues, caused a new catalogue to be prepared and copies therefrom to be printed; in such new catalogue the Defendants made alterations in the names of several of their preparations, including that of their said ointment, the name of which was altered from "Absorbent" to "Absorbine," and the Defendants at the time,
50 or shortly before, made a corresponding alteration in their labels; that the Defendants sent copies of their said new catalogues to numerous customers of their firm, and they had ever since their said catalogues and labels were printed sold the said ointment under the name of "Absorbine"; (6) that the Defendants never heard of the Plaintiff, *Wilbur Fenelon Young*, or of the Plaintiffs' preparation in the Statement of Claim mentioned, or of any medicinal preparation
55 (other than that of the Defendants') being advertised or sold or offered for sale under the name of "Absorbine" or "Absorbent" until December 1902, when

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the Defendants saw an advertisement of the Plaintiffs' said preparation, and the Defendants thereupon wrote to the Plaintiffs complaining of the Plaintiffs' user of the word "Absorbine"; (7) save as aforesaid and save that the Defendants had refused to abstain from using the word "Absorbine" the Defendants did not admit any of the allegations in paragraph 5 of the Statement of Claim; 5 (8) the Defendants denied the allegations contained in paragraph 6 of the Statement of Claim.

On the 22nd of April 1903 the Defendants gave notice of motion for an Order to rectify the Register by the removal of the Trade Marks Nos. 242,163 and 242,164, and that the Respondents, the Plaintiffs in the action, might be ordered 10 to pay the costs of that application.

In pursuance of an Order of *Kekewich, J.*, in Chambers, the Defendants gave the following Particulars of the grounds on which they intended to rely in support of their motion, namely:—(1) that the Respondents' alleged Trade Marks were not at the date of the registration thereof and were not then 15 registrable Trade Marks within the Patents, Designs, and Trade Marks Acts, 1883 to 1888; (2) that the word "Absorbine" was not an invented word, and was not distinctive of the Respondents' goods, but was merely descriptive of the character or quality of the articles to which it was applied, and the Respondents were not entitled to acquire an exclusive right to the use of the same by 20 registration; (3) that the alleged Trade Marks were, prior to the registration thereof by the Respondents, used by the Applicants and other persons in connection with articles similar to the goods to which the same were applied by the Respondents, and in fact the word "Absorbine" was at the date of and prior to the registration by the Respondents, and had ever since, been common 25 to the trade and to the public.

In pursuance of an Order for certain further Particulars the following were given by the Defendants, viz.:—(1) As to the names, addresses, and dates of user of the word "Absorbine" in connection with articles similar to the goods for which the said word had been used by persons other than the Applicants, 30 the Applicants were informed and believed that Messrs. *Corbyn, Stacey & Co., Ltd.*, whose registered office was 300, High Holborn, London, first used the word "Absorbine" for a preparation of similar character to the Respondents' preparation in May 1899, and that they had continued to use the same ever since, excepting that during the pendency of these proceedings such user had been 35 suspended; the Applicants were unable at present to give the names or addresses of any other firms or persons who may have used the said word "Absorbine" or the dates of any such user by any such persons. (2) As regards the date of the first user of the said word by the Applicants, in the autumn of 1901 the Applicants caused a reprint to be prepared of their catalogues 40 or booklets called "*Tipper's Three Tips*" containing lists of the Applicants' preparations, and also caused to be prepared new labels, the Applicants' stock of catalogues being almost exhausted, and in preparing the said new catalogues and labels the Applicants caused several of the names therein to be altered or modified, including that of the preparation referred to in this action, the name 45 of which they altered from "Absorbent" to "Absorbine." The printed copies of the said new catalogues were received by the Applicants on or about the 17th day of November 1901, and a large number of the same were forthwith distributed by the Applicants by their travellers and otherwise, the Birmingham and London Cattle Shows being then pending. Printed copies of the new labels 50 were received by the Applicants on or about the 25th day of November 1901, and a number of the same were forthwith affixed to the pots containing Applicants' said preparation. The first sale made by the Applicants of their said preparation under the name "Absorbine" was made on or about the 10th of December 1901. 55.

On the 3rd of July 1903 the Plaintiffs applied under the Summons for directions for liberty to issue a Commission for the examination of witnesses on their behalf

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in the United States of America, and for other consequential directions. This application was adjourned by the Master to the Judge, and was heard in Chambers on the 3rd of August by *Kekewich, J.*, but stood over for a fortnight to see if the Defendants would admit facts. The Defendants thereupon made an admission, which was conditional on its being accepted as sufficient to avoid a commission. The Plaintiffs did not so accept it, and on the 3rd of August *Kekewich, J.*, made an Order that the Plaintiffs should be at liberty to issue a Commission. On the 4th of August 1903 the Defendants gave notice to move for the discharge of that Order, and that the application for a Commission might be dismissed. This motion was on the 7th of August 1903 dismissed with costs, the Defendants refusing certain offers made by the Plaintiffs. Leave to appeal was refused by the Judge, but was subsequently given by the Court of Appeal, and the appeal on this point came before the Court of Appeal on the 12th of August 1903.

- 5 *E. P. Hewitt* (instructed by *Belfrage & Co.*, agents for *T. Wallace Robinson*, of Birmingham) appeared for the Appellants; *L. B. Sebastian* (instructed by *Townroe*) appeared for the Respondents.

Hewitt for the Appellants, after referring to the proceedings, continued :—The object of the application was for a Commission in order that the Plaintiffs might obtain evidence of advertisements of “Absorbine” by the Plaintiff *Young* in American journals circulating in this country with the object of showing the connection of the name with the Plaintiffs. [VAUGHAN WILLIAMS, *L.J.*—The identification of the goods in England must be by English evidence.] Yes, and if it is wished to prove extensive advertisement of the word in this country, it is incredible that it cannot be done except by this expensive course; moreover, the bearing on the case is somewhat remote.

Sebastian for the Respondents.—The Commission was only ordered because the Defendants refused to meet the Plaintiffs in the matter of admissions with regard to evidence which they considered important. Until the last few years the trade in “Absorbine” was done directly from America. We want to prove that persons in this country ordered goods from us in America in consequence of our advertisements. We can call individuals, but we cannot without the evidence for which we desire the Commission prove the extent of the publication of our advertisements. [VAUGHAN WILLIAMS, *L.J.*—You can prove how many persons in England you supplied.] But not to the extent to which the public were aware of our existence. [VAUGHAN WILLIAMS, *L.J.*—Although you sent over a large quantity of advertisements, if they did not produce a single order, the fact of the advertisements would be immaterial. To make an advertisement relevant you must show it had an effect. Although your sales may have been to individuals, yet the evidence of half a dozen of your customers, who saw and were familiar with the newspapers, and, seeing the advertisements, sent orders to you and bought from you, would be very cogent evidence.] I want to show that large quantities of the advertisements were sent here of our article. If, as I submit, the evidence is material, it is also wanted for the purpose of defending the registration, which is being attacked.

VAUGHAN WILLIAMS, *L.J.*—I do not think this Commission ought to go. Mr. *Sebastian* has stated very fairly that he wants the evidence to prove the use of this word over here, and that the word as used by his clients has become known in this country with reference to these goods. That is a material thing for him to prove; but, if it is true, it cannot be necessary to send a Commission to America to prove the knowledge of people in England of this word as used by the Plaintiffs. These Commissions are very expensive, and, in my opinion, in this case, a Commission is unnecessary.

- 55 STIRLING, *L.J.*—I entirely agree.

The appeal was allowed, and the Plaintiffs were ordered to pay the costs of the application and of the appeal.

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The Defendants subsequently applied that the question of law raised by the Defence, namely, that the word "Absorbine" had not any of the essential particulars of a Trade Mark within the definition of section 64 of the Patents, &c. Act, 1883, as amended by the Patents, &c. Act, 1888, should be set down for argument. This application was heard by *Kekewich, J.*, on the 27th of November 1903. 5

Hewitt, in support of the application, referred to the Pleadings and Particulars, and stated that the question of law, which was the main question in the action, and which he asked should be argued, was whether the word "Absorbine" was incapable of registration, and that the object of the application was to save expense. 10

Sebastian, opposing the application, said that the question was whether there should be two trials or one. Even if the Trade Mark was removed from the Register that would not determine the matter, and more expense would have to be incurred. The Plaintiffs relied on common law rights as well as on Trade Mark. Evidence would be required on the question whether the word was an invented word. 15

Hewitt replied.

KEKEWICH, J.—I am not satisfied that I can hear this as a pure point of law on admitted facts—that is to say, without hearing the evidence and probably at considerable length—in order to determine the origin of the word "Absorbine" and its meaning as applied to the particular preparation; and, even if I did dispose of it one way or the other, it seems to me that after that I should have to hear a great deal more. The result is that very little advantage, if any, would be obtained by having an independent hearing. Mr. *Hewitt* has not satisfied me that it falls within any rule guiding my discretion in these matters. It seems to me that this point must, like other points, be argued at the hearing of the Motion. The Plaintiffs are entitled to the costs of this application in any event. 25

The action came on for trial on the 19th of January 1904, the motion for rectification being set down for hearing with the action. 30

It appeared that the Plaintiffs' preparation was a liquid one sold in bottles, whereas the Defendants' preparation was an ointment sold in pots. After the commencement of the action the following notice was put on the pots:—"Tipper's 'Absorbine' is an ointment put up in pots, and has no connection with a liquid preparation sold by a Yankee house under a similar title." The Defendants' pots had from the first borne the name of the Defendants. In view of the decision of the learned Judge it is not necessary for the purpose of this report to state fully the facts as to the use of the word "Absorbine" by *Corbyn, Stacey & Co.* or those relating to passing off, but the main facts relied on appear from the speeches of Counsel reported *infra*. The Plaintiff *Young* had in 1892 registered a Trade Mark comprising the word "Absorbine" in the United States, and on that application stated that the arbitrarily chosen word "Absorbine" was the essential feature of the Trade Mark. 40

Hughes, K.C., and *L. B. Sebastian* (instructed by *L. E. Townroe*) appeared for the Plaintiffs; *Younger, K.C.*, and *E. P. Hewitt* (instructed by *Belfrage & Co.*, agents for *T. W. Robinson*, of Birmingham) appeared for the Defendants; *R. J. Parker* (instructed by the Solicitor to the Board of Trade) appeared for the Comptroller-General. 45

Hughes, K.C., for the Plaintiffs.—This is an action to restrain the use by the Defendants of the word "Absorbine," which is an invented word used for an embrocation for horses. The Plaintiffs also sell a form of it called "Absorbine J" for human beings. The word was invented by the Plaintiff *Young* in 1888, and was registered by him in the United States in July 1892; and "Absorbine" has been sold in this country from 1894 onwards, and has been largely advertised in American papers which circulate in this country. [The registrations in this 55

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country were then stated.] There was a correspondence with *Corbyn, Stacey & Co.* at the time of registration, in which they said that they had used the word, but they did not oppose the registration. The first sale by the Defendants was not until the 10th of December 1901. Their preparation is an ointment, and ours is a liquid, but the name might mislead persons who had been recommended to use "Absorbine," meaning our preparation. The Plaintiffs rely on Trade Mark and passing-off. [The Pleadings were referred to.]

- Younger, K.C., and Hewitt*, opening the motion to rectify, referred to the Particulars, and continued.—For two or three years prior to the Plaintiffs' registration, *Corbyn, Stacey & Co.* had sold an article of a similar character under the same name. The Defendants had for 20 years sold *Tipper's* "Absorbent," and in August 1901, gave instructions for altering the name to "Absorbine." The catalogues with the name so altered were finally printed in November 1901, and were delivered to travellers before the Plaintiffs' application to register. But, independently of any prior user, the word is not an invented word within the meaning of section 64 (1) (d) of the Patents, &c. Act, 1883, as amended by the Act of 1888. The registration could not have been justified before the "Solio" case (*Eastman Photographic Materials Company's Application*, 15 R.P.C. 476; L.R. (1898) A.C. 571). The substance is described by the name—it is stated to be specially prepared to absorb. The word properly describes the essential characteristic. Substantially the word is "absorbing" misspelt. All the judgments given in the House of Lords in the "Solio" case are against the registration of such a word as this. The Defendants' conduct has been quite *bonâ fide*; they now warn people that theirs is not to be confused with the Yankee preparation. The registration would entitle the Plaintiffs to restrain the use of the word "absorbent" for any preparation of this kind. This is the boldest attempt to justify a word as an invented word that has come before the Courts. [JOYCE, J.—Many such words have been registered.] The line must be drawn somewhere. The qualification on the Register is not justified by anything in the Acts; the sections relating to disclaimer have no reference to a disclaimer of part of a word. There is no statement in the application to register of the essential particular of the Trade Mark. [*Hughes, K.C.*—That is only necessary in the case of added matter, section 64, subsection (2).] [*Sebastian.*—The disclaimer was in compliance with the practice in the Office; where a common word is part of a distinctive word it is an Office rule that it must be disclaimed. The disclaimer is not under the sections as to disclaimer in the Acts.] [JOYCE, J.—If the word is properly registered I do not understand the disclaimer.] I submit that this registration of an ordinary word with the termination "ine" added to it is bad on the authority of the decided cases. [*Hughes, K.C.*, in answer to JOYCE, J., stated that he relied on passing-off if the action failed as to Trade Mark.]

The evidence in the action and on the motion was then taken together.

- R. J. Parker* for the Comptroller.—As to the note on the Register. Words such as "Satinino" were refused before the "Solio" case, but it was afterwards thought that under the judgments in that case they might be registered, and the Comptroller acting under directions has allowed registration with a note of this kind. The Board of Trade has in some cases made a similar condition. The note has nothing to do with any disclaimer under the Act; it is required by the Comptroller acting under advice. The case of every word must be judged on its own merits.

- Hughes, K.C.*, for the Plaintiffs.—First, as to Trade Mark, for, if the Plaintiffs succeed as to that, the other part of the action becomes unimportant. Before the "Solio" case it was assumed that clauses (d) and (e) were connected and that an invented word must have no reference to the character or quality of the goods. In that case the House of Lords decided that if a word is really an invented word, it is immaterial that it has such reference. A word is invented if it was not in the language before, subject to the qualification that two ordinary

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words put together do not make an invented word, and that a misspelling like "Pirle" will not do (see *Ripley's Application*, 15 R.P.C. 151). [Passages from the judgments in the "Solio" case were read.] Lord *Shand's* judgment differs somewhat from the other judgments, and is not correct on this point; an invented word may result from the real combining of two words, although not from merely adding together of two ordinary words. The termination "ine" has different meanings, such as to promote, or prevent, or to get an effect like as in "Satinine." In *Field, Ld. v. Wagel Syndicate, Ld.* (17 R.P.C. 266), *Buckley, J.*, held "Savonol" to be an invented word. [The judgment on this point was read.] Lord *Herschell* in the "Solio" case clearly thought that "Satinine," which was refused registration in *Re Myerstein's Trade Mark* (7 R.P.C. 114), was not objectionable on the ground of not being an invented word. [JOYCE, J.—The "Savonol" case simply decides that that was an invented word.] [Younger, K.C.—But *Buckley, J.*, says "Savonette" would not be; and I submit that "Savonine" would also not be an invented word.] "Ine" has no more meaning than "ol"; at all events there is no one common meaning. Invention in reference to word marks is quite a different matter from invention necessary to support Letters Patent. It is sufficient that the word was not used before, and there may be more than one inventor; a word is none the less genuinely invented, merely because someone has invented it before (*In Re Linotype Company's Trade Mark*, No. 2, 17 R.P.C. 380). But here the Plaintiff *Young* invented the word himself. As to the alleged users, there was no user by the Defendants before the application to register. At that date they could not have opposed registration. *Corbyn, Stacey & Co.* had used the word "Absorbine" with their own name for a liquid sold by the pound. February, 1900, is the earliest date fixed, and only two sales are actually proved; these were for single bottles on the 27th of September, 1901, and the 23rd of October, 1901. After long consideration they decided not to oppose the Plaintiffs' registration. Apart from common use, no one else can rely on their user (*Paine & Co. v. Daniell & Sons' Breweries*, 10 R.P.C. 217). [Younger, K.C.—That user is material on the question whether the word was an invented word.] As to passing-off—[JOYCE, J.—If you fail on Trade Mark, is not your case gone? The Defendants clearly had no intention to mislead; there has been no actual deception, and they now clearly distinguish.] The Plaintiffs' preparation was the only one known as "Absorbine," and the mere use of the word might lead to deception. [JOYCE, J.—No probability of deception is shown.] Persons recommended to use "Absorbine," and asking for it, might get the Defendants' goods. [JOYCE, J.—They sufficiently distinguish.] But they did not before action. [JOYCE, J.—No damage is proved.] There is evidence that "Absorbine" at the date of the commencement of the action meant the Plaintiffs' preparation and no other.

Sebastian followed.—In *Powell v. Birmingham Vinegar Brewery Company* (14 R.P.C. 720) an injunction was granted although "Yorkshire Relish" was removed from the Register. As to the course of the Trade Mark decisions, no words could be registered as new marks until the Act of 1883 was passed. After that Act some words were registered until the decision in *Van Duzer's Trade Mark* (4 R.P.C. 31), after which hardly any word-marks were upheld by the Courts until the "Mazawattee" case (*Densham's Trade Mark*, 12 R.P.C. 75 and 271). The Act of 1883 was intended to alter the law, but owing to the decisions did not effectually do so until *Re Trade Mark Bouril* (13 R.P.C. 382) and the "Solio" case (*Eastman Photographic Materials Company's Application*, 15 R.P.C. 476) put the law right. Now the Defendants are trying to go back from what was decided in the latter case. The rule laid down by Lord *Herschell* should be kept to. The note on the Register makes it clear that the registration does not prevent any one using any word which was used before, such as "Absorbent"; the registration can only interfere with a use of "Absorbine," or perhaps some slight alteration. The termination makes the

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word distinctive, and, apart from user, no one could know what "Absorbine" was. The Comptroller, in allowing such notes on the Register, apparently acted under directions. See sections 82 and 95 of the Patents, &c. Act, 1883.

- Younger, K.C.*, for the Defendants.—"Satinine" was held by *Kay, J.*, not to be an invented word, and the House of Lords, in the "Solio" case, did not express the opinion that that decision was wrong, but held that clauses (d) and (e) of section 64 (1) were independent. In *Salt's Application* (11 R.P.C. 517; L.R. (1894) 3 Ch. 166) "Eboline" was held not to be an invented word; and in *Farbenfabriken vorm. Bayer & Co.'s Trade Mark* (11 R.P.C. 84; L.R. (1894) 1 Ch. 645) "Somatose" was held not to be an invented word. The "Solio" case was not a new departure on the whole law as to word-marks, but it only decided that clauses (d) and (e) were independent and that "Solio" was an invented word. In the "Somatose" case, *Lindley, L.J.*, thought that "Somatose" was an invented word; but even taking his judgment, the restrictions which he lays down are sufficient to prevent "Absorbine" from being an invented word. Novelty at the date of registration is an important feature in invention. *Smith, L.J.*, said the word must be "coined for the first time," and Lord *Herschell* approved of that. In the cases a distinction is made between English words and foreign words, for the point of view of the ordinary person must be considered. If a word is an English word in its main form, with nothing added except a mere flourish, and the word suggests the same idea as the English word, then it is not an invented word. Apart from authority, the meaning of invented word is clear, some ingenuity is required. The "Solio" case, except as to clauses (d) and (e) being independent, did not overrule the previous decisions. [Passages from the judgments in the "Solio" case were read.] A particle such as "ine" added to an ordinary English word does not make an invented word; the qualifications in the "Solio" case govern the present one. According to the standard contended for on behalf of the Plaintiffs, no invention at all is required. Here three people independently hit on the word "Absortine." Lord *Shand* expressly approves the earlier decisions, and the other Lords do not differ from him. In the "Savonol" case, the whole decision turned on the word "Savon" being French. Lord *Shand* was dealing with English words when he said that the mere addition of a syllable did not make an invented word. But the "Savonol" case, in which "Savoline" was held to be an infringement, shows the danger of such registrations. On the strict meaning of the note on the Register, the termination "ine" is all that is registered; otherwise any variation of the word "Absorb" might be an infringement. This word is almost on the footing of "Nourishing Stout" (*Raggett v. Findlater*, L.R. 17 Ex. 29). If any one registered "Nourishine Stout" would not the former infringe? Either "Absorbine" is made by the addition of "ine" or by changing "ing" to "ine." Secondly, the word was not an invented word on the 21st of November 1901, when registered, because (1) it is part of the Plaintiffs' case that it had been attached to 20,000 bottles of the preparation annually in America since 1898; (2) it is part of their case that American newspapers with the word in them had come here; (3) it is part of their case that 20 bottles of the preparation had been sold here between 1894 and 1901; (4) *Corbyn, Stacey & Co.* had published eight circulars, with an average circulation of 600 copies, containing the word. *Paine v. Daniell & Sons' Brewery Company* (10 R.P.C. 217) related only to the individual right of a third party; here the user is relied on to show that the word "Absorbine" was not an invented word. The user in America is very material; the word must be new and freshly coined at the date of registration (*British Electrozone Company's Trade Mark*, 13 R.P.C. 447). At the date of registration any one was at liberty to use the word, and the Defendants were then having their catalogues printed. The "Tachytype" case (*Linotype Company's Trade Mark*, No. 2, 17 R.P.C. 380) is not against us; it is doubtful whether it is correct, but

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at all events in that case there had been no user by other people, and no business under the word in this country before registration. "Uneeda" in *National Biscuit Company's Application* (18 R.P.C. 170, and 19 R.P.C. 281), was held not to be an invented word by *Cozens-Hardy, J.*, who referred to Lord *Herschell's* judgment in the "Solio" case. In the "Pirle" case the burden on the public was pointed out, if a word having the same sound as an ordinary word was allowed to be registered. If "Absorbing" could not be registered, neither can "Absorbine." There must be some element of invention. [JOYCE, J.—An invented word may be the result of a lucky accident.] "Eboline" from "Eboli" has been held not to be invented. *Davis v. Stribolt* (6 R.P.C. 207), in which "Bökol" was held not to be a fancy word, was approved by *Romer, J.*, in *Densham's Trade Mark* (12 R.P.C. 75). As to the action, the only use of the word by the Plaintiffs is on bottles; the Defendants' preparation is an ointment in pots; there is no evidence of deception or that the Defendants' use is calculated to deceive. The right to restrain infringement of a Trade Mark is confined to goods for which it is registered and on which it is used (*Edwards v. Dennis*, L.R. 30 C. D. 454); at all events, if the mark is not used on the same goods there must be evidence of probability of deception. As to costs, much of these have been caused by the addition of the claim in respect of passing off.

Hughes, K.C., replying as to the cases cited.—The "Electrozone" case is contrary to principle if it decides that use by the Applicant himself before registration prevents a word from being an invented word within the meaning of the Act. *Edwards v. Dennis* turned on a question of assignment; besides, the Defendants' goods here are similar goods to those of the Plaintiffs. As to what evidence of probability of deception may be given, I refer to *North Cheshire and Manchester Brewery Company v. Manchester Brewery Company* (L.R. (1889) A.C. 83, and *Payton & Co., Ltd. v. Snelling & Co.* (17 R.P.C. 628); no evidence is required where the words are identical.

Judgment was reserved, and delivered on the 1st of February 1904.

JOYCE, J.—In November 1901 the Plaintiff, *W. F. Young*, applied for and subsequently obtained, the registration, as a Trade Mark, of the word "Absorbine" in Class 2, "In respect of chemical substances used for agricultural, horticultural, veterinary and sanitary purposes," and in Class 3, "In respect of chemical substances prepared for use in medicine and pharmacy." The user of the word seems to have been solely in connection with, and as the designation of, a liquid preparation professing to be "especially prepared to absorb and remove the wind-puff, capped hock, thorough-pin, shoeboil, enlarged glands, soft splint, big knee, thick cord, knotted tendons, big ankle, collar-puffs, boils and tumours." The Defendants are well-known manufacturers and vendors of veterinary preparations, and they had previously sold an ointment under the name of "*Tipper's* Absorbent Ointment" for application in cases similar to those for which the Plaintiffs' liquid remedy was advertised to be specially prepared or appropriate. At a date practically contemporaneous with the Plaintiffs' application for their Trade Mark "Absorbine," the Defendants who, in my opinion, are beyond all question perfectly honest and honourable traders, without any knowledge of what the Plaintiffs were doing, changed the title of their absorbent ointment to "Absorbine," and they have sold the same under the title of "Absorbine—*Tipper's*" ever since, though perhaps not in very large quantities. The Plaintiffs, having discovered what the Defendants were doing, on the 30th of March 1903 instituted an action not only for the usual relief in respect of the Trade Mark, but also for an injunction against passing off or enabling others to pass off their veterinary preparation, namely an ointment, as and for the Plaintiffs' liquid remedy. The Defendants replied with a Motion to expunge "Absorbine" from the Register. At the conclusion of the trial, if not before, it was virtually admitted on the part of the Plaintiffs that the only ground for the passing-off action was the use of the

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word "Absorbine," and I intimated my opinion, and, if necessary, do now decide that if "Absorbine" be allowed to remain on the Register of Trade Marks the action for passing off as distinguished from the action in respect of infringement of Trade Mark was unnecessary.

- 5 It is quite clear that the word "Absorbine" has obvious reference to the character or quality of the goods. It could only be registered, if at all, under Class (d) of subsection (1) of section 64 of the Act of 1883 as being an invented word. Whether or not it be an invented word within the meaning of this term in the Statute is the single question that remains for me to decide. The first two
- 10 syllables of the word under consideration are beyond all question the common English word "Absorb." I do not think I have been told how the whole word was invented. In the application for its registration in America it is spoken of by the Applicant as an arbitrary or arbitrarily chosen word. It may simply be a mis-spelling of the present participle of the verb "Absorb," or it may represent that participle pronounced in a careless, slovenly fashion, I may almost
- 15 say, as frequently pronounced by ordinary people. If it be this, it is certainly incapable of registration in respect of such a veterinary medicament as the Plaintiffs'. Or it may be the common English word "Absorb," with a common termination added thereto. Such a termination is found in very many words designating a chemical substance, as may be seen by reference to the index of
- 20 any Manual of chemistry, for instance, chlorine, glycerine, pepsine, saccharine, &c. It is also found frequently as a mere termination in the names of medicinal and other preparations which are sometimes referred to as proprietary articles, as, for instance, maltine, sulpholine, brilliantine, &c., &c. When so used I am not aware that the syllable "ine" has any meaning at all of itself, nor has it any here. It is
- 25 little if anything more than a sort of flourish to round off the word or expression to which it is attached in order to make an euphonious name. In the "Solio" case* it was decided, contrary to what had previously been held, that a word might be a good invented word although it might have some reference to the
- 30 character or quality of the goods, and that the word "Solio" was an invented word. The present Lord Chancellor, in the course of his observations at page 577 in Law Reports (1898) Appeal Cases, said: "My Lords, I desire to give my opinion with reference to the particular word and not to go behind it. I can quite understand suggesting other words—compound words or foreign words—
- 35 as to which it would be impossible to say that they were invented words, although perhaps never seen before, or that they did not indicate the character or quality of the goods, although, as words of the English tongue, they had never been seen before. Suppose a person were to attempt to register as a single English word 'Cheapandgood,' or even without taking so gross
- 40 an example, using a word so slightly differing from an ordinary and recognised word as to be neither an invented word nor, avoiding the prohibited choice of a word, indicating character or quality. The line must sometimes be difficult to draw: but to my mind the substance of the enactment is intelligible enough, and the Comptroller has to make up his mind whether in
- 45 substance there has been an infringement of the rule. Of course also words which are merely misspelt, but which are nevertheless, in sound, ordinary English words, and the use of which may tend to deceive, ought not to be permitted." Lord *Herschell*, a very high, if not the highest, authority on the law of Trade Marks, says at page 581: "It may no doubt sometimes be difficult
- 50 to determine whether a word is an invented word or not. I do not think the combination of two English words is an invented word, even although the combination may not have been in use before; nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea

Christy & Co. v. Tipper & Son.

"would be conveyed as by the word in its ordinary form." And Lord *Shand* says: "At the same time, I agree with your Lordships, and particularly with "what has been said by my noble and learned friend Lord *Macnaghten*, in "thinking, especially after the decision to be given in this case, that the Com- 5
"troller-General will be fully warranted in taking care that there shall not be
"admitted, under the guise or cover of words called 'invented' by the Appli-
"cant, words really in ordinary use, which might, in a disguised form, have
"reference to the character or quality of the goods. There must be
"invention and not the appearance of invention only. It is not possible to
"define the extent of invention required; but the words, I think, should be 10
"clearly and substantially different from any word in ordinary and common
"use. The employment of a word in such use, with a diminutive or a short
"and meaningless syllable added to it, or a mere combination of two known
"words, would not be an invented word; and a word would not be 'invented'
"which, with some trifling addition or very trifling variation, still leaves the 15
"word one which is well known or in ordinary use, and which would be quite
"understood as intended to convey the meaning of such a word." Now, it is
quite immaterial whether I agree with the opinions expressed by their
Lordships in that case or not, but indeed I do agree and I know of no authority
which requires me to hold that such a word as "Absorbine" is an invented 20
word. None of the syllables or parts of which the word is composed were
invented and I see no invention in the combining of them so as to form the
whole. The case of "Tachytpe," and I think also the case of "Savonol" were
materially different from the present, and in the circumstances I find myself
compelled to hold that "Absorbine" was not an invented word within the 25
meaning of that expression in the Act, and must be expunged from the Register.
The action will be dismissed with the ordinary consequences. You do not want a
stay, Mr. *Hughes*. You can appeal from the Order to expunge and perhaps
you can get it put in the Interlocutory List.

Younger, K.C.—If my friend should want a stay, I will not impose 30
difficulties.

JOYCE, J.—There is a difficulty about a stay, because of the public possibly
being interested. I do not think I can stay the Order.

General Electric Company (1900), Ltd. v. Safety Lift and Elevator Company.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE FARWELL.

December 4th, 1903.

GENERAL ELECTRIC COMPANY (1900), LD. v. SAFETY LIFT AND ELEVATOR
COMPANY.

5

Patent.—Action for infringement.—Alleged invalidity on the grounds of prior user and prior publication.—Application by Plaintiffs for leave to interrogate.—Form of interrogatories.

In an action for infringement of a Patent, the Defendants in their Particulars
10 *of Objections alleged prior user at a certain place by V. B. for some years prior to a certain date, and prior publication by J. B. at a certain place to M. of that place between certain dates. The Plaintiffs applied for leave to administer Interrogatories, which were shortly as follows:—As to prior user—what was the manner of the prior user; whether by means of a machine in actual use,*
15 *and what was the purpose of the use of the machine, and the periods for which it was used; whether it existed, and where it could be inspected, and what was the occupation and address of V. B. As to the prior publication—whether it was oral, by document, model, or how otherwise; whether such document or model existed, and where it could be inspected; whether any more exact date could be*
20 *given, and what was the occupation and address of M. At the hearing of the Summons it was proposed to ask whether the machine was in the Defendants' possession or power instead of where it could be inspected.*

Held, that, the Defendants stating that the prior user alleged was by machine, they ought to be ordered to answer the first Interrogatory by stating whether
25 *any such machine existed, and, if so, whether any such machine was in their possession, custody, or power, and stating the present address of V. B.; and, the Defendants stating that the publication referred to was by document, they ought to be ordered to answer the second Interrogatory by so stating and by sufficiently identifying the document and the present address of M.; but the Defendants*
30 *were not compelled to make further answer to either of the Interrogatories.*

Birch v. Mather (L.R. 22 C.D. 629) followed.

General Electric Company (1900), Ltd. v. Safety Lift and Elevator Company.

On the 17th of March 1903 the *General Electric Company (1900), Ltd.*, and *George Herbert Whittingham* commenced an action against the *Safety Lift and Elevator Company* for infringement of Letters Patent (No. 1417 of 1894) granted to the Plaintiff *Whittingham* for an invention of an "Automatic device for removing resistance in starting electric motors and replacing same," the Patent being then vested in the Plaintiff Company. 5

The Plaintiffs having delivered a Statement of Claim and Particulars of Breaches, the Defendants by their Defence (*inter alia*) alleged that the Patent was invalid by reason of the matters appearing in the Particulars of Objections therewith delivered. 10

The Particulars of Objections alleged (*inter alia*)—(2) That the alleged invention was not new. "(B) The said alleged invention had been publicly used at Winchester Square, Birmingham, by *Victor Bornard* for some years prior to the 23rd of January 1894. Such prior user is set up as anticipating all the claims in the Specification of the said Letters Patent sued on. (C) The said alleged invention had been published by *John Bush*, at Green Street Engineering Works, Blackfriars Road, London, S.E., to Mr. *Moffatt*, of that place, between the 9th of June 1892 and the 23rd of January 1894. Such prior publication is set up as anticipating all the claims in the Specification of the said Letters Patent sued on." 15 20

The Plaintiffs applied under the Summons for Directions for leave to administer the following Interrogatories, namely:—"(1) In what manner and during what period was the invention claimed by the Plaintiffs publicly used as alleged by clause (B), paragraph 2, of the Defendants' Particulars of Objections? Was it by means of a machine or machines in actual use or how otherwise? For what purpose and during what period or periods was such machine or were such machines used? Does any such machine exist or any model or description or drawings thereof? If so, where may the same respectively be inspected? What is the occupation and address of the said *Victor Bornard*? (2) In what manner was the said invention published by *John Bush* to Mr. *Moffatt* as alleged by clause (C), paragraph 2, of the Defendants' Particulars of Objections? Was it so published by means of oral communication, or by any document or documents, or by means of any machine or model, or how otherwise? Does any such document or machine or model, or do any plans or drawings thereof now exist? If so, where may the same respectively be inspected? Is the Defendant Company unable to give any more exact date for such publication than that mentioned in the Particulars of Objections? What is the occupation and present address of the said Mr. *Moffatt*?" 25 30 35 40

The Summons was adjourned by the Master into Court. 40

Bousfield, K.C., and *F. H. Maugham* (instructed by *F. Samuelson*) appeared for the Applicants; *A. J. Walter* and *J. H. Gray* (instructed by *Wilson, Bristows, and Carpmael*) appeared for the Respondents.

Maugham for the Applicants.—This is an action by the Plaintiff for infringement of Patent, and the Summons asks for leave to administer Interrogatories. The Patent is for a machine to be used chiefly in connection with lifts, for automatically regulating the flow of the electric current. The Defence denies infringement, and states that the Patent is invalid by reason of matters alleged in the Particulars of Objections. Clause 2 of the Particulars of Objections contains a statement of a number of Specifications alleged as anticipations. Paragraphs B and C are the two paragraphs in respect of which the application is made. Paragraph 3 alleges want of subject-matter. The Plaintiffs have asked for leave to administer two Interrogatories. [The first proposed Interrogatory was read.] As to the last thing of all—"What is the occupation and address"—there is an authority completely in point, namely, *Birch v. Mather* (L.R. 22 C.D. 629) before *Chitty*, J. The decision there was that 45 50 55

*General Electric Company (1900), Ltd. v. Safety Lift and
Elevator Company.*

in a Patent action, where the Plaintiff or Defendant made out a proper case, the Court had jurisdiction to order Interrogatories to be answered, notwithstanding the provision in the Patent Law Amendment Act, 1852, for the delivery of Particulars, and that the Plaintiff was also entitled under
5 the 41st section of that Act to the names and addresses of the persons by whom prior user was alleged to have been made, as well as the place where the prior user had taken place. In the present case the Particulars of Objections give the place and the name, but not the address and description. It also appears by the statement of facts in this case that, in addition to that, the
10 Plaintiff asked for, and was allowed to ask, whether the machines were in existence. It is a very important thing where prior user is alleged—that Plaintiffs should know whether the machines are in existence, and whether any models or drawings are in existence, in order that they may, if possible, get some notion of what the alleged prior user is. The Registrar in that case gave leave.
15 There was an elaborate judgment by Mr. Justice *Chitty* dealing with a number of cases, including the case of *Garrard v. Edge* (6 R.P.C. 372), which may be relied on for the Defendants, and he allowed the Interrogatories. The Interrogatories were opposed mainly on the ground that, as Particulars could be ordered and had to be given under the Act, there was no ground for Interrogatories. It was
20 mainly on the question of jurisdiction that the case was reported. The substance of it is that the Judge said that the Order of the Registrar was right. Then there is the case of the *Alliance Pure White Lead Syndicate, Ltd. v. MacIvor's Patents, Ltd.* (8 R.P.C. 322). In that case A. brought an action against M. for infringement of a Patent for improvements in making white
25 lead, and M., by his Particulars of Objections, relied on prior publication of the Plaintiff's invention by the manufacture and sale by white lead manufacturers generally in London and the vicinity from 1836 to the date of the Patent. The Plaintiff interrogated, asking the names and addresses of such manufacturers, and the places and dates of user. The Defendant having refused to answer
30 the Interrogatory, it was held that the Defendant was bound to answer the Interrogatory. There is one part of the Interrogatory here which can be amended in form if it is objected to as it stands, and that is the part which asks, "If so, "where may the same respectively be inspected"? Perhaps the proper form is to ask where it is now, and whether it is in the custody, power, or control of the
35 Defendants? If it is in their possession I submit that I am entitled to have the Interrogatory answered, and then I shall get inspection. I should be quite content with the Interrogatory in that form.

Gray for the Respondents on the first Interrogatory.—I admit that the Particulars which I am bound to give are the name and address, and the period
40 of time during which the prior user has been existing. I have said, "The "said alleged invention has been publicly used at Winchester Square, Birmingham, by *Victor Bornard* for some years prior to the 23rd of January "1894." I cannot give better Particulars with regard to the number of years. The address, I admit, is not directly stated, but the address is really *Victor*
45 *Bornard*, of Winchester Square, Birmingham, and it is given in that form. It ought to have been stated, "of that particular place." If my friend is satisfied with that I shall be perfectly prepared to give it in that form. So far as the other questions in the Interrogatory are concerned, I submit that they are absolutely unprecedented. One question is, "In what manner and during
50 "what period was the invention claimed by the Plaintiffs publicly used"? I do not understand the question. The function of Particulars of Objections in a patent action is to enable the Plaintiff to make inquiries to satisfy himself as to what really was done. We have given the name and address, subject, of course, to the alteration which I make now, and the time during which the
55 particular invention was alleged to be used. I submit there never was a case—none has been cited—in which further Particulars were necessary, or in which

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Elevator Company.*

such a question was ordered to be answered. The next part of the Interrogatory is, "Was it by means of a machine or machines in actual use, or "how otherwise"? I have said that the alleged invention has been publicly used. I do not know what other answer I can give to that. "For what "purpose, and during what period or periods was such machine, or were such 5 "machines used"? I cannot tell that at present. I have given Particulars which will enable the Plaintiffs to inquire for themselves. I submit that is all that is ever required in Particulars of Objections against a Patent. "Does any "such machine exist, or any model, or description, or drawings thereof"? I daresay my clients can inform the Plaintiffs whether the machine exists or 10 not. I cannot say. [FARWELL, J.—That seems to come within Mr. Justice Chitty's decision.] I think the decision only deals with the other part of the question—the name and address. [FARWELL, J.—As to whether the machines were in existence the Order was made, as far as I can make out.] The whole argument was on the question whether Interrogatories were permissible. I 15 admit that they are. The common practice is, however, to ask for further and better Particulars. There never has been a case where better Particulars have been given which would justify, or make it necessary for the Defendants to answer, the questions of the first Interrogatory. The Defendants understand that the machines have been made and sold continuously. They cannot say 20 whether they exist. The Plaintiffs can make inquiries as to this. [FARWELL, J.—Of course there is no difficulty in the Defendants answering it. If they do not know they can say so.] There is no reason why the Defendants should not say what they in fact know, but I submit it is putting the whole expense upon us at the present time. The Plaintiffs may discontinue the action. Why 25 should not the Plaintiffs make the inquiries for themselves? [FARWELL, J.—If it had not been for the Order of Chitty, J., I should have thought so too, but he seems to have allowed it.] The head note shows that this was not the real point with which Chitty, J., was dealing. From what appears by the report it was not disputed. [FARWELL, J.—Perhaps for the same reason that 30 it is hardly worth your while to dispute it.] I submit that this is not a decision against me on the point, and if inquiry has to be made by either party I suggest it ought to be made by the Plaintiffs. It is their interest to find out whether the machine was made. Then the other question is, "If so, "where may the same respectively be inspected"? [FARWELL, J.—It is 35 proposed to alter that and to ask whether it is in the Defendants' possession or power?] That is a new question. I say at once it is not in their possession and power.

FARWELL, J.—Perhaps Mr. Maugham is satisfied with that?

Maugham.—Is that satisfactory? I should prefer to have an answer as to 40 this.

FARWELL, J.—I must consider whether you are entitled to it. I have not given you leave to amend yet. As it stands you are not entitled to the second part.

Maugham.—Your Lordship will hear me on that? There is a case for some 45 Interrogatory.

FARWELL, J.—I think you are entitled, and I think it is admitted you are entitled, to the statement of the occupation and address of Victor Bornard. I understand the suggestion to be that it was intended to be given to you; that, if it is not given to you, it will be given to you as "Winchester Square, 50 "Birmingham"; and then as to the occupation?

Gray.—The Defendants do not know the occupation.

FARWELL, J.—I do not know that "occupation" is mentioned by Chitty, J. I will not go beyond the authority.

Gray.—The Plaintiffs cannot have made a single inquiry yet or they would 55 have satisfied themselves on every one of these points.

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FARWELL, J.—On the authority of that case the Defendants are bound to give the present address. If they do not know it, of course they cannot. As at present advised I think you have said enough. I think "For some years prior to the 23rd of January 1894" is sufficient for the first part of it. As to the question, "Was it by means of a machine or machines in actual use, or how otherwise"? I think there is no authority for that.

Maugham.—Your Lordship sees how misleading Particulars may be. It is now said that a number of machines were made and sold, and the Defendants do not know where they are.

Gray.—I do not rely on general user if I have specific user.

Maugham.—You say the machine had been publicly used. That is a vague phrase. I want to know whether the Defendants made the machine and sold it.

Gray.—It is a common expression in every Patent action, and it has always been held sufficient.

Maugham.—Then there is the question whether the machine exists or not?

FARWELL, J.—I do not think that point is decided.

Maugham.—Except that it was allowed. I think there is nothing in the judgment.

FARWELL, J.—Probably it was not objected to.

Maugham.—Nothing was said about it because the Defendants did not object. They gave it up before the Judge. It has been treated as an authority in some of the text books.

FARWELL, J.—I do not think it was argued; or that Chitty, J., decided it. The Defendants will answer that, but not in the form in which it is asked. I do not think they can say whether they can be inspected.

Gray.—Does your Lordship say I should answer the first part of the Interrogatory?

FARWELL, J.—No; the first three lines I do not see any reason for your answering—down to "whether any such machine exists." There is no authority that I can see from the cases. The rest of it I think you must answer.

Gray.—Then I answer whether any machine exists?

Maugham.—Including "or any model, or description, or drawings thereof."

FARWELL, J.—The authority does not go beyond machines, and I shall not go beyond that.

Maugham.—The second interrogatory is, "In what manner was the said invention published by John Bush to Moffatt, as alleged by clause (C), paragraph 2, of the Defendants' Particulars of Objections"? That is explained by the next question, "Was it so published by means of oral communication, or by any document or documents, or by means of any machine or model, or how otherwise"? I am entitled to ask what sort of publication it is that is relied upon by the vague statement in the Particulars—that it was published by John Bush at a certain date to Moffatt. Then I ask whether any document, machine, or model constituting such publication exists? The last question is, "What is the occupation and present address of the said Mr. Moffatt"?—which is the same thing as the occupation of Victor Bornard.

FARWELL, J.—Do the Defendants object to saying whether the publication is oral or in writing?

Gray.—No, they do not.

FARWELL, J.—I think the Defendants ought to state whether it is oral or by writing; and to identify the writing if it is by writing.

Gray.—It is by a document not in the possession of a party to the action. It is a publication by John Bush to Moffatt.

Maugham.—If it is a written document which is identified that will be quite sufficient. If my friend says the publication is publication by a document, and

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he is willing to produce it, or to identify it so that I can make an application for production, that is all I want.

Gray.—I am only prepared to say that it was a document which was shown by *Bush* to *Moffatt*.

FARWELL, J.—This is really getting better Particulars in an unusual form by Interrogatories. The Defendants ought in the first instance to state whether it is oral or written, and if in writing give the date. I can say nothing more than that. 5

Maugham.—I assent to that, provided the document is identified.

FARWELL, J.—Somehow or other the Defendants must identify the document. 10

Maugham.—Then I ask for the present address of Mr. *Moffatt*.

Gray.—The address given is that at the present time.

The Order as drawn up was as follows :—"The Defendants by their Counsel stating that the prior user alleged in the Defendants' Particulars of Objections, paragraph 2, clause (B), was by machine, this Court doth order that the Defendants do answer the first Interrogatory by stating whether any such machine does exist, and, if so, whether any such machine is in the possession, custody, or power of the Defendants, and stating the present address of *Victor Bornard*. And the Defendants by their Counsel stating that the publication referred to in the Defendants' said Particulars of Objections, paragraph 2, clause (C) was by a document, it is ordered that they do answer the second Interrogatory by so stating and by sufficiently identifying the document and stating the present address of Mr. *Moffatt*, and the Defendants are not compelled to make further answer to either of the Interrogatories; and it is ordered that the costs of this application and occasioned by the adjournment thereof into Court be costs in the action." 15 20 25

Jandus Arc Lamp and Electric Company, Ltd. v. Arc Lamp Company.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE KEKEWICH.

November 18th, 1903.

JANDUS ARC LAMP AND ELECTRIC COMPANY, LD. v. ARC LAMP COMPANY.

5 *Patent.—Action for infringement.—Practice.—Motion by Plaintiffs for liberty to apply to amend Specifications.—Terms.—Patents, &c. Act, 1883, sections 18, 19, 20.*

The Plaintiffs in an action for infringement of two Patents after the delivery of the Defence applied to the Court for liberty to apply at the Patent
 10 *Office for leave to amend their Specifications.*

Held, that the Order made in Ludington Cigarette Machine Company, Ltd. v. Baron Cigarette Machine Company, Ltd. (17 R.P.C. 745) was appropriate, which imposed on the Plaintiffs (among others) a term that no action should be brought or maintained for infringement of the Patent in respect of any
 15 *goods made prior to the date of the Order. An Order giving liberty to apply to the Patent Office for leave to amend was made accordingly.*

The Plaintiffs in an action for infringement of two Patents desired, after the delivery of the Defence and Particulars of Objections, to amend their Specifications, and moved for liberty to apply to the Patent Office for leave to amend
 20 *under section 19 of the Patents, &c. Act, 1883, which provides that "in an action for infringement of a Patent, the Court or a Judge may at any time order that the Patentee shall, subject to such terms as to costs and otherwise as the Court or a Judge may impose, be at liberty to apply at the Patent Office for leave to*
 25 *amend his Specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed."*

J. C. Graham and A. J. Walter (instructed by Faithful and Owen) appeared for the Applicants; W. R. Bousfield, K.C., and J. H. Gray (instructed by Rackham & Co.) appeared for the Respondents.

J. C. Graham for the Applicants.—It is only a question of terms, and the
 30 *Plaintiffs are willing to take the Order made by your Lordship, and confirmed by the House of Lords, in Ludington Cigarette Machine Company, Ltd. v. Baron Cigarette Machine Company, Ltd. (17 R.P.C. 745, at page 746). In that case there was only one Patent in issue, and there was a cross petition to revoke it, so that it is true that the Order there made covered that which has nothing*

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in common with this action. The Order gave liberty to apply at the Patent Office for leave to amend, but ordered that the Plaintiffs were not to bring or maintain any action for infringement in respect of the machines made before the date of the Order.

KEKEWICH, J.—Do the Defendants agree to that?

Bousfield, K.C., for the Respondents.—No. I submit the right Order in this case will be that the leave to apply at the Patent Office should be given, but subject to the condition that the amended Specification should not be put in evidence in the pending action. [KEKEWICH, J.—But, assuming that the action proceeds, what can they put in in their action? They cannot put in the original Specification because it would be gone. If they are not to put in the amended Specification, how are they to support their case at all?] They must contend that the Patent as it stands is valid. The Order I suggest was in effect made in *Laing v. Whitecross Wire and Iron Company, Ltd.* (7 R.P.C. 389), where the House of Lords considered that *Wills, J.*, had a perfect right to attach to the Order for leave to amend the condition that, if the amended Specification were given in evidence, no damages or injunction should be claimed for anything done before the disclaimer. Such an Order was also made in *Singer v. Stassen* (1 R.P.C. 121). [KEKEWICH, J.—That is a long time ago; we have learned something since that.] The decision was, in 1887, followed by *Day, J.*, in *Allen v. Doulton* (4 R.P.C. 377, at page 380), and in the meantime the same Order was made in an unreported case of *Bray v. Gardiner*. In each case the Judge must consider the particular circumstances, and, as in the cases I have cited, the higher Courts will not interfere with his discretion. [KEKEWICH, J.—Here the Applicants have admitted that, for the purposes of this action, their Patents as they stand cannot be upheld. If you are right in claiming this condition on the Order why should I not at once dismiss the action?] It comes to the same thing. That is what I was going to point out. It comes to this, whether the action is alive or is not alive.

After some further discussion,

KEKEWICH, J.—The Order made in *Ludington Cigarette Machine Company, Ltd. v. Baron Cigarette Machine Company, Ltd.*, is suitable, and I have not had my attention called to any subsequent case since 1900, a period of three years, which shows that the Order does not work well. But it must be clearly understood that I do not make the Order in this form because it is a settled form. The Court of Appeal distinctly said that it is not to be regarded as a hard and fast line; but the Order seems to work well and has stood the test of the House of Lords. I think I had better make an Order in that form, and that will do justice between the parties.

As regards costs, the learned Judge ordered that the costs of the Defendants in the action, including the costs of the present application, save so far as the same could be utilised for the purposes of the action after the amendment of the Specification, should be borne by the Plaintiffs in any event.

Grand Hotel Company of Caledonia Springs, Ltd. v. Wilson.

Before THE JUDICIAL COMMITTEE OF THE PRIVY COUNCIL.

Present: LORD DAVEY, LORD ROBERTSON and SIR ARTHUR WILSON.

July 21st and 29th, and November 4th, 1903.

GRAND HOTEL COMPANY OF CALEDONIA SPRINGS, LD. v. WILSON.

- 5 *Trade name of goods.—Consolidated actions to restrain passing off and infringement of Trade Mark.—Plaintiffs whether exclusively entitled to word.—Word whether indicating locality or the goods of the Plaintiffs exclusively.—Appeal of Plaintiffs dismissed.*

The Grand Hotel Company of Caledonia Springs, Ltd., being the owners of
10 natural springs in the township of Caledonia, Ontario, brought two actions (which were afterwards consolidated) to restrain infringement of Trade Mark and passing off, claiming an exclusive right to the word "Caledonia" in certain phrases, including "Caledonia Water," "Caledonia Springs Water," and "Mineral Water from Caledonia Springs," and also of
15 the words "Natural Saline Water" and "Natural Seltzer." The Plaintiffs' springs were called "Caledonia Springs," and the locality was also known by that name. The Plaintiffs had the right to take water from another spring situate about two miles from those before mentioned, and included this spring in the expression "Caledonia Springs." The word
20 "Caledonia" formed an element in certain of their Trade Marks sued on, and the Plaintiffs' waters had acquired in the market the name of "Caledonia Water." One of the Defendants bored on land belonging to another Defendant, and adjoining that of the Plaintiffs, and tapped two springs, which yielded water generally resembling that of the Plaintiffs' springs, and they
25 entered into arrangements with the other Defendants for placing the waters so yielded on the market and selling the same. The Defendants' water was sold under the description "Natural Saline Water, from the New Springs at Caledonia," and as "Beaver Brand," which phrases appeared on the labels. At the trial, it was held that there had been no infringement of the Trade Marks,
30 except a temporary infringement of one of them by a label of one of the Defendants, but that the Plaintiffs had established their case as to the trade names "Caledonia Water" and "Water from Caledonia Springs," and an injunction was granted restraining (inter alia) the use of those expressions and of "Water from the New Springs at Caledonia" by the Defendants. The Court of Appeal

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of Ontario allowed the Defendants' appeal dissolving the injunction, except as regards the one Defendant, against whom an injunction against the use of certain labels was granted. The Plaintiffs appealed.

Held, by the Judicial Committee of the Privy Council that the Plaintiffs had not an exclusive right to the use of the word "Caledonia" in connection with waters, although the Respondents could not use the word so as to pass off their goods as those of the Plaintiffs; that there had been no infringement of Trade Mark, except in the particular instance mentioned, nor imitation of get-up; that the Defendants were entitled to indicate the local source of the waters sold by them, and that they had discharged the burden cast on them of distinguishing their goods from those of the Plaintiffs. The appeal was dismissed.

On the 5th of February 1901, the *Grand Hotel Company of Caledonia Springs, Ltd.*, commenced two actions, one against *Rebecca Wilson* (executrix of *Charles Wilson*, deceased), *Samuel G. Wilson*, *Peter Lyall*, *William F. McDonell*, *Thomas A. Trenholme*, and *J. S. McDougall*, and the other against *J. Tunc & Son*, *Peter Lyall*, *W. F. McDonell*, *Thomas A. Trenholme*, and *J. S. McDougall*, claiming in each action a perpetual injunction restraining the Defendants, their servants and agents, from infringing the Plaintiffs' Trade Marks or any of them, and from infringing the Plaintiffs' exclusive right to the use of the word "Caledonia" in the phrases "Caledonia Water," "Caledonia Springs Water," "Caledonia Seltzer," "Magi Caledonia Seltzer," "Caledonia Springs, Ont., Natural Saline Water," and "Mineral Water from Caledonia Springs," and "From New Springs at Caledonia," and the words "Natural Saline Water" and "Natural Seltzer," and from using the labels complained of or any other labels infringing the Plaintiffs' Trade Marks, or any of them, or the Plaintiffs' said rights, and restraining the Defendants *Lyall*, *McDonell*, *Trenholme*, and *McDougall*, and each of them, their servants, workmen, and agents, from selling and from shipping from their said well water to be sold anywhere as "Caledonia Water," or under any name, Trade Mark, or designation using the said word "Caledonia" as descriptive of the same, or to indicate the source of the said water, and an account of damages.

The Defendants *Lyall*, *McDonell*, *Trenholme*, and *McDougall* were not parties originally to the actions, but were added on an amendment under an Order of the 26th of April 1901.

The following are the material parts, for the purpose of this report, of the amended Statement of Claim in the action against *Wilson* and others:—
 "(1) The Plaintiffs are a Company duly incorporated under the laws of Ontario with power to carry on the business of hotel keeping and sale of mineral waters in connection with Caledonia Springs, situate on lot 20 in the first concession of the township of Caledonia, in the county of Prescott. The Defendants *Wilson* carry on the business of bottlers and agents in the city of Toronto, under the name of *Charles Wilson*, but of their respective interests or their mutual relation in regard to the said business the Plaintiffs have been unable to ascertain the facts. The Defendants *Lyall*, *McDonell*, and *Trenholme* are British subjects resident in the province of Quebec, and the Defendant *J. S. McDougall* resides in the township of Caledonia, in the county of Prescott. (2) The Defendants *Wilson* have infringed the Plaintiffs' Trade Marks. (3) The Trade Marks are as follows:—(a) Trade Mark specific to be applied to the sale of a mineral water, and which consists of a representation of a fish or dolphin upon a background formed by a shield, and the words, 'Caledonia Springs, Ont.,' 'Natural Saline Water,' 'A Universal

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“ ‘Beverage,’ registered in the Department of Agriculture of Canada in accordance with the Trade Mark and Design Act by *King Arnoldi*, on the 24th day of April 1896, and by him assigned to the Plaintiffs on the 18th day of March A.D. 1899, recorded on the 20th of March A.D. 1899. (b) Trade Mark specific to be applied to the sale of mineral water, and which consists of a ribbon or band with pointed ends, with a circular protuberance or swelling beyond the straight edges of said ribbon or band; a representation of water spouting from the ground, the words ‘*The Grand Hotel Company of Caledonia Springs, Ltd.*, 1876,’ also the word ‘*Magi*,’ also the words ‘Every package of genuine Caledonia Water from the original Springs should bear this certificate,’ also fac-simile of signature of ‘*K. Arnoldi*, Sec’y-Treas.’; registered in the Department of Agriculture of Canada on the 5th day of April A.D. 1899, by the *Grand Hotel Company of Caledonia Springs, Ltd.* (c) Trade Mark specific to be applied to the sale of mineral waters, and which consists of a label re ‘*Magi Caledonia Seltzer*,’ registered in the Department of Agriculture of Canada on the 1st day of February A.D. 1901 by the *Grand Hotel Company of Caledonia Springs, Ltd.* (d) Trade Mark specific to be applied to the sale of a mineral water, and which consists of a representation of a cock or rooster enclosed within a horseshoe and the words ‘*Natural Seltzer*,’ ‘*The white sulphur water of Caledonia Springs*,’ &c. as set forth in the label annexed to the application for registration of the said Trade Mark registered in the Department of Agriculture for Canada in accordance with the Trade Marks and Design Act by *King Arnoldi* on the 24th day of April 1896, and by him assigned to the Plaintiffs on the 18th day of March 1899, by assignment recorded on the 20th day of March 1899. (e) Trade Mark specific to be applied to the sale of a mineral water, and which consists of a label bearing the representation of the seal and name of the registrant Company (the Plaintiffs) and the words ‘*Caledonia Water*,’ ‘*Caledonia Mineral Water*,’ ‘*From the Gas Spring*,’ as set forth in the label annexed to the application for registration of the said Trade Mark, registered in the Department of Agriculture for Canada in accordance with the Trade Mark and Design Act by the Plaintiffs on the 30th day of August 1898. (4) For several years prior to the registration of any of the said five Trade Marks the Plaintiff Company have been using the said five labels respectively the subject of the said registrations in their business of selling the water from Caledonia Springs, and they were and are the owners of the said labels respectively, and had and have the exclusive right to the use of the same respectively. (5) ‘*Caledonia Springs*’ is a name given to certain flowing springs of mineral water situate upon lot number twenty in the first concession of the township of ‘*Caledonia*, in the county of Prescott, in the province of Ontario, containing two hundred acres, more or less, and a certain other spring, known as ‘*The Intermittent Spring*,’ on adjoining lands, of which spring the Plaintiffs are lessees. The Plaintiffs are the owners in fee simple of the said lot number twenty, save and except a small portion thereof about fifty feet square, more or less, unconnected with the said springs. (6) The said springs have been the property of the Plaintiffs and their predecessors in title for one hundred years, or thereabouts, prior to the bringing of this action, and during all that time have been celebrated and known through Canada as springs of water with medicinal properties very beneficial in rheumatic and other cases and as a healthful beverage and very valuable upon that account, and the said water has been during all that time used by persons resident in the neighbourhood of the said springs, and has been sent away to people not resident near the said springs for use, and always has been and is an article of sale and merchandise, and the names of ‘*Caledonia Water*’ or ‘*Caledonia Springs Water*’ have for one hundred years or thereabouts been used to signify to the general public and the Plaintiffs and their predecessors water obtained from the Caledonia Springs only. 7. There is not now and

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" never was an incorporated village at the springs, but the name 'Caledonia
 " 'Springs' applies solely to the springs themselves as they come out of the
 " ground, and the proprietors of the same procured the opening of a post-office
 " there many years ago for the convenience of visitors to the said springs, and
 " have kept the said post-office under the name of Caledonia Springs Post-office 5
 " by themselves or their agents almost continuously since its first establishment
 " a great many years ago. 8. The present Grand Hotel was erected and the
 " Plaintiff Company were incorporated to carry on the same and to conduct the
 " business of selling the water derived from the said springs. In the course of
 " their said business the Plaintiffs and their predecessors in title have expended 10
 " large sums of money in advertising and printing, and in the employment of
 " agents or otherwise in establishing in Ontario and elsewhere in Canada the
 " business of selling the water from the said springs under the name of
 " 'Caledonia' employed in various relations such as 'Caledonia Water,'
 " 'Caledonia Springs Water,' 'Caledonia Seltzer,' 'Caledonia Natural Seltzer,' 15
 " 'Magi Caledonian Seltzer,' 'Caledonia Springs Ont. Natural Saline Water,'
 " and 'Mineral Water from Caledonia Springs,' and the Plaintiffs and their
 " predecessors in title of the said springs have acquired a right which is exclu-
 " sive to the use of the said word 'Caledonia' in the connection and use
 " aforesaid and for the purpose of indicating the waters derived from the said 20
 " springs. 8a. The Plaintiffs, for many years prior to the registration of any of
 " the said Trade Marks hereinbefore mentioned, used the words 'Natural Saline
 " 'Water' and 'Natural Seltzer' as Trade Marks exclusively for waters derived
 " from some of the said four Caledonia Springs, and have acquired a right
 " which is exclusive to the use of the said words in the connection and use 25
 " aforesaid. 8b. Prior to the invasion of the Plaintiffs' rights by the Defendants,
 " the Plaintiffs and their predecessors in title had always enjoyed the exclusive
 " use of all the words and phrases hereinbefore claimed by the Plaintiffs
 " without interruption, and the said words had acquired, long prior to the acts
 " of the Defendants herein complained of, a meaning signifying to the public 30
 " that waters so labelled came from the said Caledonia Springs. 8c. The
 " Plaintiffs claim their rights to the exclusive use of all the words and phrases
 " hereinbefore claimed by both common law and by virtue of the registration of
 " their said several Trade Marks or some of them. 8d. As a result of the
 " continuous expenditure of money, by the energy and work of the Plaintiffs 35
 " and their predecessors in title, proprietors of the said Caledonia Springs, an
 " extensive business has been for many years established and in operation for
 " the sale of the water from the said springs under the names hereinbefore
 " mentioned, and the said business is an increasing business by reason of the
 " expenditure, energy, and work of the Plaintiffs. 8e. The Defendants *Peter* 40
 " *Lyall*, *William F. McDonell*, and *Thomas A. Trenholme* being aware of all
 " the facts and circumstances set forth in paragraphs 1, 3, 4, 5, 6, 7, 8, 8a, 8b,
 " 8c, and 8d of this Statement of Claim acquired a piece of land being part of
 " the east half of lot 21 in the first concession of the said township of Caledonia
 " adjoining the said lot 20, and within one half-mile or so of the said Caledonia 45
 " Springs aforesaid upon said lot 20 in the name of the said Defendant
 " *McDonell*. 8f. There was not on the said last-mentioned lands at the time of
 " the purchase of the same by the said last-named Defendants any spring what-
 " soever, but immediately on acquiring the said lands the said last-named
 " Defendants sunk an artesian well or artesian wells thereon, which turned out 50
 " to produce water of a saline character different from the waters derived from
 " any of the Caledonia Springs, and thereafter the Defendant *McDonell* entered
 " into an agreement, bearing date the 1st day of August 1898, with the Defen-
 " dants *Lyall* and *Trenholme*, by which he transferred to each of the last-named
 " Defendants one undivided third part of the lands part of lot 21, which had 55
 " been acquired as aforesaid, in consideration of which transfer the Defendants
 " *Lyall* and *Trenholme* covenanted and agreed with the Defendant *McDonell*

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- “that they would, at their own expense, develop the said well on the property
 “to wit, bore and pipe the same so as to advantageously make use of the waters
 “thereof and instal and establish on said property at said well the necessary plant
 “for the bottling and shipping of the waters thereof as the demand therefor
 5 “may require; the sum to be so expended in said development of the said well
 “and the establishment and installation of the said plant by the said *Lyall* and
 “*Trenholme* not to exceed \$10,000. And it is in and by the said agreement
 “further provided that if it be found in the judgment of the said *Lyall* and
 “*Trenholme* that the flow of water from the said springs is insufficient, or that
 10 “the quality of the water thereof does not warrant the establishment and
 “installation of said plant and the operation of the said property, the said *Lyall*
 “and *Trenholme* are to have the option of discontinuing the development of
 “the said well and the establishment and installation of the said plant.
 “8g. The Defendants *Lyall*, *McDonell*, and *Trenholme* have entered
 15 “into a partnership in relation to the sale of the waters from their
 “said wells and have called their said partnership the *Beaver Brand Com-*
 “*pany*. The Defendant *J. S. McDougall* resides at or near the said wells of
 “the said Defendants and has some title or interest in the said lands and
 “in the said partnership between the said other Defendants, or is authorised by
 20 “the said other Defendants to do the acts on their behalf next hereinafter set forth.
 “8h. The said Defendant *J. S. McDougall* puts up the water from the said
 “wells of the Defendants *Lyall*, *McDonell*, and *Trenholme* in barrels and other
 “vessels and bottles, and sends them away from the said wells of the last-
 “named Defendants to all the Defendants and to other persons by the order
 25 “and direction of the last-named Defendants, and such water is shipped by the
 “Defendants *Lyall*, *McDonell*, *Trenholme* and *McDougall* for the purpose of
 “the same being sold and distributed over the Province of Ontario and the
 “Province of Quebec as ‘Caledonia Water,’ and the same has been for some-
 “time past and is now being so distributed under a title colorable and imitative
 30 “of what is used by the Plaintiffs in the sale of the water from Caledonia
 “Springs. 8i. The Defendants *Lyall*, *McDonell*, and *Trenholme* acquired the
 “said lands on lot 21 and sank the wells thereon for the purpose of
 “invading the business of the Plaintiffs in the sale of the waters from Caledonia
 “Springs and to avail themselves of the business which the Plaintiffs and their
 35 “predecessors had established as aforesaid in respect of the sale of the said waters,
 “and to secure to themselves the benefit of the expenditure, energy and work
 “of the Plaintiffs and their predecessors in establishing their said business for
 “the sale of the water from Caledonia Springs, and to rob the Plaintiffs of their
 “legitimate business and appropriate the same to the said Defendants. 8j. The
 40 “water from the said wells of the Defendants would not have any sale except
 “by the adoption of the word ‘Caledonia’ in connection therewith. The said
 “last-named Defendants procured the Defendants *Wilson* to sell the waters
 “from their said wells, and authorised them to employ a label or Trade Mark
 “for the sale of the same, using the word ‘Caledonia,’ and professing that the
 45 “said waters so sold are from the ‘New Springs at Caledonia’ and in bottles
 “imitative of the Plaintiffs’ bottles, and the sale of the same is effected by
 “calling the said waters ‘Caledonia Water,’ and in answer to the demand by
 “the customers of the said Defendants *Wilson* in other lines for the ‘Caledonia
 “‘Water’ sold by the Plaintiffs. The said *Lyall*, *McDonell*, *Trenholme* and
 50 “*McDougall* have also employed other agents in different parts of Ontario, and
 “are employing them to push the sale of their water with the name ‘Caledonia’
 “used in connection therewith in other parts of Ontario and in the province
 “of Quebec, and the said conduct of the said last-named Defendants has caused
 “and is causing serious loss and damage to the Plaintiffs, and injuring their
 55 “business in the sale of the water from Caledonia Springs. 8k. The public
 “are deceived by the devices, labels and misrepresentations of the Defendants
 “into the belief that the water sold by the Defendants is the water sold by the

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"Plaintiffs, that is to say, genuine water from Caledonia Springs. 8. The Defendants *Wilson* are the agents for part of the province of Ontario of the Defendants *Lyall, McDonell, Trenholme* and *McDougall* for the sale of the water from the said well, and are acting under labels and Trade Marks the devices of the said last-named Defendants and under their instructions, and are acting only upon and under an agreement by the said last-named Defendants to indemnify them, the said Defendants *Wilson*, against all loss, costs, damages and expenses, including the costs of this action, arising out of or occasioned by their sale of the said water under the name containing the word 'Caledonia,' and under the said labels and Trade Marks of the Defendants hereinbefore referred to. 9. The Defendants have infringed and are infringing, and, unless restrained by the order and injunction of this Honourable Court, threaten and intend to continue to infringe the Trade Marks of the Plaintiffs hereinbefore mentioned, and also the exclusive right of the Plaintiffs to use the said word 'Caledonia' in the phrases and relations hereinbefore mentioned, and the words 'Natural Saline Water' and 'Natural Seltzer' for the purpose of indicating mineral water derived from the said springs, by selling alleged mineral water under a label only colourably different from the registered Trade Mark labels of the Plaintiffs, and, in fact, compounded or made up of the said labels, and also by representing the said alleged mineral waters to the public as 'Caledonia Water,' or 'Caledonia Springs Water,' by the use of the said words and phrases when the fact was, and is, that the said waters are not mineral waters derived from the said Caledonia Springs, or obtained from the Plaintiffs." Paragraphs 10 and 11 contained allegations as to damages, and as to profits made by the Defendants.

The Statement of Claim in the second action was similar, except that it omitted the allegation against the Defendants *Wilson*, and contained allegations that the Defendants *Tune* were a partnership, doing business in the City of London, in the province of Ontario, as agents and bottlers, and were agents for part of the province of Ontario of the Defendants *Lyall, McDonell, Trenholme* and *McDougall* for the sale of the water from the said well, and were acting under labels and Trade Marks complained of.

On the 14th of May 1901 an Order was made, upon the application of the Plaintiffs, consolidating the two actions.

The Statement of Defence of the Defendants *Peter Lyall, William F. McDonell*, and *Thomas A. Trenholme* was, so far as material, as follows:—

"1. The Defendants now pleading are the owners of certain property, situate in the township of Caledonia in the county of Prescott, upon which there are certain mineral springs hereinafter mentioned. 2. In the township of Caledonia aforesaid there are a number of sulphur, saline, and other mineral springs well known throughout the Dominion of Canada and elsewhere, the waters of which are reputed to have, and have medicinal properties useful in rheumatic and other complaints. 3. These springs are in the immediate vicinity of an unincorporated village generally known as Caledonia and Caledonia Springs. 4. The Plaintiffs have recently become the owners of some of these springs, but other springs of a similar nature and of a superior quality and medicinal value are owned by other persons. 5. These Defendants have established a business at the said springs for the sale of the said mineral waters. Such mineral waters are generally sold in bulk to dealers who themselves bottle and sell to retailers. 6. In the ordinary course of the business of the said Defendants these Defendants sold mineral waters from their springs to the Defendant *Rebecca Wilson*, and to the Defendant *Tune*. These springs, owned and operated by these Defendants, were discovered and operated subsequent to the discovery and operation of the Plaintiffs' said springs. 7. In order to clearly distinguish the waters flowing from said springs from sulphur and other mineral waters obtained from other springs in Caledonia these Defendants have sold the same as "Natural Saline Water,"

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- " which is the proper and usual designation and description of such waters.
- " 8. In order clearly to distinguish the said water from the springs from which it comes from the Plaintiffs' and other older and longer discovered springs at Caledonia, these Defendants represented and sold this water as being 'From
- 5 " 'New Springs at Caledonia,' and, with the same object, these Defendants represented it to be of the 'Beaver Brand,' and placed conspicuously on the label, used and authorised to be used by them, the figure of a beaver, a Trade Mark adopted by these Defendants, and the words 'Beaver Brand.' These Defendants have authorised their co-Defendants, *Rebecca Wilson* and *Tune*,
- 10 " to use the said words in connection with the sale of mineral waters sold to him by these Defendants. 9. The Defendant *McDougall* is the agent of these Defendants, residing at Caledonia, employed by them in connection with the sale of their said mineral water and the operating of their said springs.
- 15 " 10. In the year 1896 *King Arnoldi* assumed to register the Trade Mark in paragraph 3 (a) in Plaintiffs' Statement of Claim mentioned, but the same does not contain the words 'Natural Saline Water' as is falsely alleged in said Statement of Claim, and the said words are not claimed or even mentioned in the application of the said *Arnoldi*." By paragraph 11 the Defendants alleged that the said last-mentioned Trade Mark was not a good and
- 20 " valid Trade Mark, and was not duly registered. The Defence continued as follows:—" 13. The Plaintiffs state that the elements of their firstly-mentioned alleged Trade Mark are" * [Four elements were set out including] (b) The words 'Caledonia Springs, Ont.' This is the name of the post-office and of the unincorporated village where are situated the springs
- 25 " from which the water sold by these Defendants comes, the village and locality also being commonly called 'Caledonia.' These Defendants have used the word 'Caledonia' only as stated in paragraph 7† hereof and claim the right to do so, and have not used the other words. (c) The words 'Natural Saline Water.' These words are not in the said alleged
- 30 " Trade Mark as falsely stated, nor are they even in the said *Arnoldi's* application therefor. These Defendants have used them as stated in paragraph 7 above and claim the right to do so. 14. The Plaintiffs state that the elements of their secondly-mentioned alleged Trade Mark are—" [The six elements were set out.] " 15. These Defendants deny that the Plaintiffs could by their regis-
- 35 " tration of the alleged Trade Mark referred to in paragraph 3 (c) obtain the right to the exclusive use of the words 'Natural Saline Water' and 'Caledonia,' and other words in common use and theretofore used by these Defendants and others, and these Defendants have not infringed the same but claim the right to use the words 'Natural Saline Water' and 'Caledonia' as herein set out.
- 40 " 16. The Plaintiffs state the elements of their fourthly-mentioned Trade Mark are (a) the representation of a cock or rooster enclosed within a horseshoe. These Defendants have never used any such representation and do not claim any right to do so. (b) The words 'Natural Seltzer.' These Defendants have never used these words and make no claim in respect thereof. (c) The
- 45 " words 'The White Sulphur Water' of Caledonia Springs. These Defendants have never used these words. These Defendants claim that they have never done anything that can by any possibility be regarded as in any way infringing this Trade Mark, but they do not admit the validity thereof.
- 50 " 17. The Plaintiffs allege as the elements of their fifthly-mentioned Trade Mark. [The four elements were set out including] (b) The words 'Caledonia Water.' These Defendants have used these words and claim the right to do so. (c) The words 'Caledonia Mineral Water.' These Defendants have used these words and claim the right to do so. 18. For many years prior to the bringing of

* Only the elements material to this report are here set out; the Defendants denied user of all the elements not set out, and, except in one case, expressly disclaimed the right to do so.

† *See, query 8.*

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"this action the owners of the said mineral springs in the said township of Caledonia, other than the Plaintiffs' springs, bottled and sold the waters of the springs as mineral waters from Caledonia, 19. These Defendants deny that they are in any way seeking to represent the mineral water sold by them as the Plaintiffs' mineral water or from their springs or in any way to mislead the public as to the said water, but, on the contrary, they have conspicuously called attention to the fact that the same comes from the 'New Springs at Caledonia,' and have adopted the words 'Beaver Brand' and the device or picture of a beaver to distinguish the said waters from the Plaintiffs' or those from other springs in the said township of Caledonia or at Caledonia. 20. Save as herein admitted these Defendants deny the allegations in the Plaintiffs' Statement of Claim."

The Defences of the other Defendants (*inter alia*) contained paragraphs corresponding to paragraphs 7, 8; and 19 of the Defence above set out and claimed the benefit of that Defence.

The action was tried in June 1901 at Ottawa, before the Hon. Chancellor Boyd, who found that the words "Caledonia Water" and "Water from Caledonia Springs," meant the mineral waters supplied by the Plaintiffs, which had been for many years on the market, and widely used medicinally and as a beverage; that the use by the Defendants of the words "Caledonia Water" and "Water from Caledonia Springs" was calculated to mislead, and had been used so as to mislead purchasers; and that, with the exception of the temporary invasion of a Trade Mark by *Tune's* use of one label, they had not actually infringed the Plaintiffs' registered Trade Marks; but as to the trade names above mentioned, the case of the Plaintiffs was established. The judgment contained the following observations on the facts:—"No doubt the township name may have originally, early in the last century, have suggested the application of it to the water; but in course of time the township name has been lost sight of in the particular name 'Caledonia Springs,' localised through the agency of the Plaintiffs. At this point where the three springs are situated, there grew up in the course of time the Caledonia Springs village (attached to the hotel), the Caledonia Springs post-office, and the Caledonia Springs station. A letter merely addressed to 'Caledonia' would go to that place in the township of Haldimand. This distinctive character, now and for a long time past generally attributed to the 'Caledonia Springs,' arose from the exertions and expenditure of the Plaintiffs in making known the qualities and worth of the water arising from their springs. The widespread market for this water known by this name was made entirely by the enterprise of the Plaintiffs. Knowing this, the Defendants have sought to profit by it, and not perhaps by means of perfectly accurate representations. The Defendants call their product 'Water from the New Springs at Caledonia,' and their labels carry prominently the words 'Springs' and 'Caledonia.' Now, it is not correct to speak of the water vended by them as from 'New Springs.' Their water was reached by means of boring and drilling, and it rises as from an artesian well. The Plaintiffs' water issues naturally from the earth, and is and has long been the spontaneous outflow of mineral springs. Neither are the so-called 'New Springs' of the Defendants at Caledonia; they may be in Caledonia, i.e., the township of that name, but the desire was to localise the new venture so that it might be confounded with the better and well known product."

An injunction was granted restraining the Defendants "from selling, shipping, or supplying any water in the province of Ontario, and from advertising or offering for sale, or causing or procuring to be advertised or offered for sale in the said province, any water as or under the name of 'Caledonia Water,' or as coming from the springs owned or leased by the Plaintiffs in the pleadings mentioned, or any of them, or enclosed in any bottles, barrels, or other packages whatsoever, having affixed or applied thereto any mark or

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“ label so contrived as, by colourable imitation or otherwise, to represent the
 “ water sold, shipped, or supplied by the Defendants, as being water coming
 “ from the springs in the township of Caledonia owned or leased by the
 “ Plaintiffs, or any of them, and particularly from using or applying in the said
 5 “ province, in reference to any water so sold, shipped, or supplied by them, the
 “ words ‘Caledonia Water,’ ‘Water from Caledonia Springs,’ or ‘Water from
 “ ‘the New Springs at Caledonia,’ and also, further, from so using and applying
 “ in the province of Ontario any name or title of which the word ‘Caledonia’
 “ forms part in a way likely or calculated to deceive the public into the belief
 10 “ that the water sold, shipped, or supplied by the Defendants in the said
 “ province of Ontario is mineral water from the springs owned or leased by the
 “ Plaintiffs in the township of Caledonia, or any of them,” with costs and an
 account of profits.

The Defendants appealed, and on the 4th of December 1902 the Court of
 15 Appeal for Ontario (*MacLennan* and *Oskier*, JJ.A., *Moss*, C.J., dissenting) allowed
 the appeal, except that with regard to the Defendants *Tune & Son* certain
 relief was granted, as appears below. *Moss*, C.J., was of opinion that the Plaintiffs
 were entitled to an injunction, but in a slightly modified form.

The judgment of *MacLennan*, J.A., with which *Oskier*, J.A., concurred, was
 20 as follows:—

“ *MACLENNAN, J.A.*—After a very careful perusal and consideration of the
 “ oral and other evidence in this case, I have arrived at a different conclusion
 “ from that of the Chancellor.

“ In the beginning of last century mineral springs were discovered quite near
 25 “ each other in lot number twenty in the first concession of the township of
 “ Caledonia, in the county of Prescott. The waters from these springs were all
 “ found to possess medicinal qualities, though differing considerably from each
 “ other in their component elements. These springs soon became known by
 “ the name ‘Caledonia Springs,’ and have ever since retained that name. They
 30 “ also became a place of resort by invalids, and the water therefrom has, for a
 “ long time, been a subject of merchandise by the proprietors by the name of
 “ ‘Caledonia Water.’ As early as the year 1839, as appears by the abstract of
 “ title put in by the Plaintiffs, the neighbourhood of the springs was divided
 “ into village lots, with streets and squares; there being as many as seventeen
 35 “ different streets mentioned in the abstract. Ever since that time the locality
 “ of the springs, as well as the springs themselves, has been called and known
 “ by the name of ‘Caledonia Springs.’

“ In the year 1866 a Company was incorporated, called the *Caledonia Springs*
 “ *Hotel Company*, for the purpose of building and maintaining a hotel, and their
 40 “ Charter declares that the Company’s place of operation is ‘the landed property
 “ ‘in the township of Prescott, called and known as the Caledonia Springs
 “ ‘property.’ That Company built a hotel and carried on the hotel business,
 “ and, in the year 1876, the Plaintiff Company was incorporated for the purpose
 “ of acquiring the land on which the springs and the Caledonia Springs Hotel
 45 “ are situate, and for carrying on a hotel business, and the business of selling
 “ mineral waters. The Plaintiff Company accordingly acquired the said pro-
 “ perty, including the hotel, and have carried on the hotel business, and the
 “ business of selling mineral waters, ever since.

“ Several years ago the Plaintiff Company induced a railway company to
 50 “ construct a line of railway to pass near the springs, affording communication
 “ by rail with Montreal and Ottawa, and the railway company has ever since
 “ maintained a station on its line at or near the springs, called Caledonia
 “ Springs. For many years, also a post-office has been maintained at the
 “ Plaintiffs’ hotel by the Government of Canada, called Caledonia Springs.

55 “ In the year 1898 the Defendants *Lyall* and *McDonell* and *Trenholme*, whom
 “ it will be convenient to call *Lyall & Co.*, became the owners as tenants in
 “ common of part of the east half of lot 21 in the township of Caledonia, which

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"lies adjacent to the Plaintiffs' land, and to their hotel and springs, and by boring thereon they discovered two springs of mineral water having medicinal qualities, and composed of many of the ingredients composing the water produced by the Plaintiffs' springs. These springs of the Defendants, although only discovered by boring, are flowing springs like those of the Plaintiffs; and the Defendants *Lyall & Co.* have engaged in the business of selling the water therefrom for profit."

After referring to the proceedings in the action and stating the injunction granted, the judgment continued as follows:—"The Defendants *Lyall & Co.* finding by analysis that their water contained valuable medicinal properties, opened a correspondence with the Defendants *Wilson*, at Toronto, and the Defendants *Tune & Co.*, at London, and employed them respectively as agents for the sale of the water from their wells or springs. The Defendants *Wilson*, and *Tune & Co.*, having received from their principals consignments of water in barrels from their springs, began the sale thereof in bottles, specimens of which, with the labels affixed thereto, have been produced in evidence.

"The Plaintiffs' waters have usually been put on the market in a similar way. They supply agents in Quebec and Ontario with water in barrels. The agents bottle and sell it to the dealers. The Plaintiffs' agents in Ontario are *McLaughlin & Co.*, of Toronto. The bottles used by *Wilson* and *Tune & Co.* are similar in size and shape to those used by *McLaughlin*."

"The Plaintiffs claimed in their Statement of Claim that the Defendants had infringed five different Trade Marks used by them to distinguish their goods. It is proved that for a short time before, and at the time the action was commenced, the Defendants *Tune & Co.* used a label upon their bottles which in shape and colour and several other respects resembled one of the Plaintiffs' Trade Marks, whereby a consumer, but I think not a dealer, might be deceived. This label had not been sanctioned by *Lyall & Co.*, and was at once abandoned when complaint was made, and another was adopted to which no objection could be made. The Defendants *Wilson* never used a label which could be regarded as an infringement of any of the Plaintiffs' Trade Marks. The learned Chancellor has, therefore, found that with the exception of what was done by *Tune & Co.* there was no infringement of the Plaintiffs' Trade Marks, and in that conclusion I agree. It was said, however, that the Defendants had been selling their water as 'Caledonia Water' without distinguishing it from the Plaintiffs' water. The Defendant *Tune* admits that he did sell some of the Defendants' water as 'Caledonia Water,' and that without any label, or anything to distinguish it from the Plaintiffs' water. This was just prior to the commencement of the action on the 5th of February 1901. On the previous day the Plaintiffs' solicitors wrote to *Tune & Co.*, threatening proceedings to restrain the use of a label with the words 'From the New Springs at Caledonia,' 'Selzer Beaver Brand,' 'Natural Saline Water,' as an infringement of Plaintiffs' Trade Mark, and claiming exclusive right to use the words 'Caledonia' and 'Caledonia Springs' in connection with their mineral waters. The service of the writ followed immediately, and on the 6th of February *Tune & Co.* answered the solicitors' letter, saying they were ignorant of the Plaintiffs' claim to the word 'Caledonia' and did not intend to imitate their Trade Mark, and they offered to cease using the label objected to, and to re-label all the 'New Caledonia Springs Water' with a label no one could mistake for the Plaintiffs' label. This fair and reasonable proposal was not regarded as satisfactory, and those Defendants were informed that they must submit to the relief asked for, and pay the costs, otherwise proceedings would not be stayed.

"The *Wilsons* do not appear to have at any time used a label which could be regarded as an imitation of the Plaintiffs' marks or any of them, or to have sold any water merely as 'Caledonia Water.' Their label is very different from any of the Plaintiffs' labels in colour and size and device, and has nothing

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- "thereon of which the Plaintiffs could complain unless it be the word 'Caledonia' as part of the phrase 'From the New Springs at Caledonia.' So far as *Tune & Co.* are concerned, I think their appeal fails as to that part of the judgment which enjoins them from selling their water as 'Caledonia
- 5 " 'Water.' On reading the correspondence between *Tune & Co.* and their principals *Lyall & Co.*, and the evidence at the trial, it is quite clear the latter are not responsible for the act of their agent in selling their water as 'Caledonia Water' without distinguishing it from the Plaintiffs' water. On
- 10 " the contrary, *Lyall & Co.* distinctly cautioned them not to use a label which would infringe upon any other water in the market. The first member of the mandatory part of the judgment must therefore be allowed to stand
- 15 " against *Tune & Co.* But I think it ought not to stand against any of the other Defendants. There is no evidence that they or any of them sold or desired or intended to sell their water as or under the name of 'Caledonia
- 20 " 'Water,' or that any of the Defendants, *Tune & Co.* included, intended or desired to lead their customers to suppose that they were getting water which came from the Plaintiffs' springs. If any intention of that kind had been shown it would have been proper to make the injunction wide enough so as effectually to prevent such a fraud. But where no wrong was intended an
- 25 " injunction should be confined to the precise act committed.
- " For the same reason I think the second, third, and fourth members of the mandatory part of the decree objectionable, and that they should be struck
- 30 " out. There is no evidence that any of the Defendants, except *Tune & Son* as already mentioned, advertised or sold their water as coming from the
- 35 " springs owned or leased by the Plaintiffs, or enclosed in any bottles, barrels, or packages having any mark or label contrived to represent their water as coming from the Plaintiffs' springs; or that they used or applied in Ontario
- 40 " to the Defendants' water the words 'Caledonia Water' or 'Water from Caledonia Springs.'
- 45 " They have used the last phrase mentioned in the fourth member of the injunction, namely, 'Water from the New Springs at Caledonia,' as descriptive of their water, and they justify their doing so, and the question is whether they are right.
- " The learned Chancellor thought it was not correct for the Defendants to
- 50 " speak of the water sold by them as from 'New Springs,' because it was reached by means of boring and drilling, and rises from an artesian well. while the Plaintiffs' water issues naturally from the earth, and is and has
- 55 " long been the spontaneous outflow of mineral springs. I am unable to take that view. As we have seen, the Defendants' wells are flowing wells. The
- 60 " water springs up spontaneously from the earth through the orifices drilled or bored by the Defendants. One of the definitions given in both the Standard and Century Dictionaries of a well is 'A spring or well spring, a
- 65 " 'spring of water, a fountain.' The Century says, 'A spring is a place where water comes naturally to the surface of the ground and flows away. A
- 70 " 'spring may be opened or struck in excavating, but cannot be made.' I confess I should have thought the word 'spring' the natural and appropriate
- 75 " word to use in order to designate the flowing wells of the Defendants. I am, therefore, of the opinion that the Defendants do no more than exercise their legal right in designating and describing their wells as springs.
- 80 " The learned Chancellor also finds fault with the use by the Defendants of the word 'Caledonia.' The Defendants describe their water as from 'The
- 85 " 'New Springs at Caledonia.' Their springs are within a quarter of a mile or less from the old springs, within a stone's throw of the village called Caledonia Springs, near a railway station and post-office of the same name. Now the
- 90 " Defendants have an undoubted right to describe their water correctly and truthfully. It is a saline mineral water. It is derived from the New Springs, and those springs are in the township of Caledonia, and they are at a place

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"called Caledonia Springs. If the Defendants' water is likely to be more sought after and more marketable, and if the business of selling it is likely to be more profitable by reason of the situation of the springs and their nearness to the famous old springs, the Defendants are entitled to the benefit of that. They might say, in so many words, that they were situate within so many yards of the old springs, just in order to gain favour in the market. The learned Chancellor also thinks there is inaccuracy in saying New Springs 'at' Caledonia instead of 'in' Caledonia. They might have said with perfect correctness New Springs at Caledonia Springs, for the phrase 'Caledonia Springs' unquestionably means not only the springs of water, but the place, the locality, the neighbourhood where they are situate. The Defendant *McDougall* lives and keeps a hotel there. The first question put to him by the Plaintiffs' Counsel on his examination for discovery was, 'You live at 'Caledonia Springs?'—A., 'Yes.' If a crime were committed at or near the Defendants' springs, the indictment would charge that it was committed at the township of Caledonia, and not in the township. Therefore, the Defendants' description of their water as water from 'The New Springs at Caledonia' is, in my opinion, a perfectly true and accurate description, and not only so, but one which clearly and sufficiently distinguishes it from the Plaintiffs' water. There might have been some danger of confusion if they had said 'The New Springs at Caledonia Springs,' although that would have been a true description; but they wisely, perhaps, avoided that.

"It was very strenuously contended that the Defendants have no right to use the word 'Caledonia' at all in designating their water. A similar contention 27, Lord *Selborne* says:—'For that argument no authority was cited; and it was made in *Singer Manufacturing Co. v. Loog* (L.R. 8 App. Cas. 15). At page 'cannot, in my opinion, be maintained on any principle. If the Defendant 'has (and it is not denied that he has) a right to make and sell in competition 'with the Plaintiffs, articles similar in form and construction to those made 'and sold by the Plaintiffs, he must also have a right to say that he does so, 'and to employ for that purpose the terminology common in his trade, 'provided always that he does this in a fair, distinct and unequivocal way.' And at pages 37, 38 Lord *Blackburn* uses similar language; and Lord *Watson* at pages 38, 39. Therefore, the Defendants' springs being at Caledonia, they have a right to say so, taking care to distinguish them from those of the Plaintiffs at the same place.

"It was also contended that the make up of the Defendants' goods was calculated to deceive the public, because the bottles used were similar. But it was not shown that the Plaintiffs' bottles were in any way peculiar in form, or size, or colour, or different from bottles in common use for the sale of other waters. It was said that it was common to put such goods on ice, and that the labels then came off and the customer might be deceived, but it is not shown that the Defendants did things of that kind. [As to this contention, see observations of Lords *Macnaghten* and *Davey* in *Payton v. Snelling* (L.R. (1901) A.C. 308).]

"I am, therefore, of opinion that the whole of the fourth member of the injunction is unwarranted.

"It remains to consider the fifth element, and it follows from what I have said, that, in my opinion, no part of it can be maintained as against any of the Defendants. None of the Defendants, except *Tune & Son*, have been shown to have done anything that is here enjoined, and that part of the judgment which I think ought to stand against *Tune & Son* is sufficient as against them.

"The result is that as to all the Defendants, except *Tune & Son*, the appeal should be allowed with costs, and the action should be dismissed with costs. As to *Tune & Son*, the appeal should be allowed, except as to the first clause of the injunction; and the reference as to damages, if the Plaintiffs think it worth while. As against them the action was rightly enough brought. I

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"think, however, if the Plaintiffs had asked no more than that, *Tune & Son* would have contested the matter no further. I think the Plaintiffs should have against *Tune & Son* such costs as they would have incurred in entering up judgment against them by default, for so much of the injunction as they still retain, and I think they should pay them the rest of the costs of the action and appeal, with set off."

The injunction against *Tune & Son*, as granted by the Court of Appeal, was in the terms following, namely:—"From selling, shipping, or supplying any mineral water in the province of Ontario, and from advertising or offering for sale, or procuring to be advertised or offered for sale in the said province any water enclosed in any bottles, barrels, or other packages whatsoever, having affixed or applied thereto the label marked as exhibits 1 and 3 referred to in the examination for discovery of *James Tune*, read at the trial hereof, or either of them, or any other mark or label so contrived as, by colourable imitation or otherwise, to represent the water sold, shipped, or supplied by the Defendants as being water coming from the springs in the township of Caledonia, owned or leased by the Plaintiffs, or any of them."

The Plaintiffs appealed.

The Appellants' Reasons, stated in their Case on appeal, were as follows:—

(1) The conclusions of fact arrived at by the learned Chancellor at the trial and the learned Chief Justice of Ontario in the Court of Appeal are indisputable upon the evidence adduced, and are sufficient to sustain the judgment pronounced at the trial, and should not have been departed from by the Court below. The evidence in this case is strikingly similar to the proof in *Reddaway v. Banham*. In that case the Lord Chancellor's view that the Defendants are telling the truth only in calling their product 'Camel-hair Belting' was changed by an agent's letter put in evidence explaining the necessity for adopting the trade name of 'Camel-hair Belting' to get the Defendants' product into the market established by the *Reddaways*. Here there is an exact parallel in the letter from Respondent *Tune* to Respondent *Lyall*, in which he says: 'If we have to omit all reference to Caledonia it would as you know be very detrimental to the sale of the water.' The defence of these actions attests that fact as the Respondents' reason for using the word 'Caledonia' (*Reddaway v. Banham*, L.R. (1896) App. Cas. 199 *et seq.*).

(2) The Respondents have failed to establish any ground for the use of the word 'Caledonia' as applicable to their waters. Not only is it not shown that the township of Caledonia outside the Appellants' property is generally a source of 'Caledonia Water,' but, on the contrary, it is proved that the 'Caledonia Springs' on the Appellants' property are the only source thereof.

(3) The name 'Caledonia Springs' being that of the Appellants' four springs only, and the waters therefrom being only 'Caledonia Water,' it would not be allowable for the owners of the Rochon Spring or the Cadieux Spring (the only other mineral springs in Caledonia township) or for the Respondents if they became such owners to call those two springs or either of them 'Caledonia Springs' or the water therefrom 'Caledonia Water,' or to describe them as of the township of Caledonia or otherwise in connection with the word 'Caledonia' so as to render it likely that those waters would be by reason thereof called 'Caledonia Waters.' No more, it is submitted, can the Respondents do so with their wells aforesaid or the waters therefrom.

(4) The Appellants have the exclusive control of the only place of origin of 'Caledonia Waters' and the access thereto. It is not necessary to consider what would be the effect if these sources were available to all the world or found in many places within the township of Caledonia outside the Appellants' property.

(5) The word 'Caledonia' has lost its signification as the name of the township, and has in relation to mineral waters acquired a secondary signification as solely designating the waters of the Caledonia Springs. The place

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" of origin being the property of the Appellants, the Respondents cannot originate
 " their goods there, in which respect this case differs from the 'Stone Ale' case
 " (*Montgomery v. Thompson*, L.R. (1891) A.C. 217), for which reason the rule of
 " that case applies here to entitle the Appellants to their injunction without qualifi-
 " cation. Appellants rely also on *McAndrew v. Bassett* (1863) (4 De G. J. & S. 5
 " 380); *Seizo v. Provezende* (L.R. 1 Ch. 192); *Wotherspoon v. Currie* (L.R. 5
 " H. of L. 508, 521); *Braham v. Beachin* (L.R. 7 C. D. 856); the "Akron Cement"
 " case (*Norman v. Alford*, U.S. Ct., 40 Barb. 588). (6) For these reasons the
 " Appellants are in the same position to all intents and purposes as if they and
 " their predecessors had produced the 'Caledonia Water' by actual manu- 10
 " facture; as if the same was in fact their manufacture and product under that
 " name, the principle of the line of cases of which *Reddaway v. Banham*
 " (L.R. (1896) App. Cas. page 212) is the leader, governs this case; *Radde*
 " v. *Norman* (L.R. (1872) 14 Eq. 348); *Apollinaris Company v. Norrish*
 " 33 L.T. N.S. 242). Per Lord Justice *James*, " *Thorley's Food for Cattle*" had 15
 " 'never become an article of commerce as distinguished from the particular
 " 'manufactory from which it proceeded' (*Thorley's case—Massam v. Thorley's*
 " *Food Company*, L.R. 14 C. D. 748). (7) The use of the word 'Caledonia' by
 " the Respondents in the sense of the name of the township as applicable to
 " their waters is an untrue use thereof, and is intended to and does create a 20
 " false impression. (8) Ordinary and unwary persons desiring to use water
 " from Caledonia Springs are thereby deceived into using the Respondents'
 " waters. It is and was the intention of the Respondents that this should be
 " so. (9) The Respondents so deal with their water that they enable others to
 " make false representations and to deceive the ultimate customers, which has 25
 " been done in this case (*Wotherspoon v. Currie*, per Lord *Hatherley*, L.R. 5,
 " H.L. 517). (10) It is no answer for the Respondents to say (what the
 " evidence shows would be untrue), viz., that they made no false represen-
 " tations themselves, and had no intention to deceive or enable others to do so.
 " It is proved by their own evidence that they put their waters into the hands 30
 " of others to be sold as 'Caledonia Water' or by means of the word 'Caledonia'
 " as applied to mineral waters; at all times their devices were calculated to
 " cause the word 'Caledonia' to be attached to their waters in the sale thereof;
 " it matters not what the label says on the bottle in which it reaches the
 " purchaser asking for 'Caledonia Water,' or that the label has been previously 35
 " washed off or no label at all is on the bottle, the purchaser is deceived, and
 " the deception must be attributed to the Respondents. They must be taken
 " to have intended the reasonable and natural consequences of their acts. Per
 " *James*, L.J.: 'No man is entitled to represent his goods as being the goods of
 " 'another man; and no man is permitted to use any mark, sign, or symbol, 40
 " 'device, or other means whereby, without making a direct false misrepresen-
 " tation himself to a purchaser who purchases from him, to enable such
 " 'purchaser to tell a lie or to make a false representation to somebody else
 " 'who is the ultimate customer' (*Singer Manufacturing Company v. Loog*,
 " L.R. 18 C. D. at page 12; quoted by Lord *Macnaghten*, *Reddaway v. Banham*, 45
 " L.R. (1896) App. Cas. 218). (11) The Respondents' acts in the premises
 " were and are calculated and liable to mislead, and it is sufficient if this
 " is so as to ordinary and unwary customers. It is not necessary in any
 " event to show that experts and others aware of the real facts may be deceived,
 " or that anyone was in fact deceived (*Singer Manufacturing Company v. 50*
 " *Loog*, L.R. 8 App. Cas. 18; *Worcester Royal Porcelain Company v. Locke*,
 " 18 T. L.R. 712). (12) Actual instances of deception have been proved in the
 " evidence. (13) The case made put the onus upon the Respondents of showing
 " that there was no deception (*Radde v. Norman*, L.R. 14 Eq. 348); this they
 " did not even attempt to prove. (14) It is not necessary for the Appellants 55
 " to make out a case of fraud against the Respondents or to show that they
 " intended to deceive (*Singer Manufacturing Company v. Wilson*, L.R. 3

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"App. Cas. 376; *Johnston v. Orr Ewing*, L.R. 7 App. Cas. 219; *Singer Manufacturing Company v. Loog*, L.R. 8 App. Cas. 15; *Reddaway v. Bentham*, L.R. (1892) 2 Q.B. 639; *Saxlehner v. Apollinaris Company*, L.R. (1897) 1 Ch. 893; 2nd edition *Kerly on Trade Marks*, 375, cases cited 451
 5 "et seq.). (15) A case of fraud is, however, shown upon the evidence. It must be inferred that the operations of the Respondents were entered upon and carried on with the fraudulent design of passing off their water as the water of the Appellants from the Caledonia Springs."

The Reasons set out in the Respondents' Case were as follows:—“(1) That the
 10 “Appellants have no exclusive right of user in the word ‘Caledonia’ either alone or in combination with other words as a designation of mineral waters. (2) That the Respondents are entitled to use the word ‘Caledonia’ in designating or describing mineral waters derived from their new springs at Caledonia, provided that they clearly distinguish such waters from the waters supplied
 15 “and sold by the Appellants from the old springs at Caledonia. (3) That the Respondents in fact clearly distinguish by labels and descriptions their mineral waters from those of the Appellants. (4) That the judgment of the majority of the Court of Appeal for Ontario, and the reasons given for it, are right, and should be affirmed. (5) That the Hon. Chancellor *Boyd* and the
 20 “dissenting judgment of the Hon. Chief Justice *Moss* are wrong.”

The Appeal came on before the Judicial Committee of the Privy Council on July 21st, 1903.

Arnoldi, K.C. (of the Canadian Bar) (instructed by *Gadsden and Treherne*) appeared for the Appellants; *Scrutton*, K.C., and *R. C. Smith*, K.C. (of the
 25 Canadian Bar), (instructed by *Poole and Robinson*) appeared for the Respondents. The arguments on both sides substantially followed the Reasons above referred to.

The following cases were cited by *Arnoldi*, K.C., for the Appellants:—
 30 *Montgomery v. Thompson* (8 R.P.C. 361; L.R. (1891) App. Cas. 217); *McAndrew v. Bassett* (4 D.J. & S. 380); *Reddaway v. Banham* (13 R.P.C. 218; L.R. (1896) A.C. 199); *Seizo v. Provezende* (L.R. 1 Ch. 192); *Radde v. Norman* (L.R. 14 Eq. 348); *Massam v. Thorley's Cattle Food Company* (L.R. 14 C.D. 748); *Wotherspoon v. Currie* (L.R. 5 H.L. 508); *Powell v. Birmingham Vinegar Brewery Company* (13 R.P.C. 235; 14 R.P.C. 720; L.R. (1896) 2 Ch. 54;
 35 L.R. (1897) App. Cas. 710); *Braham v. Beachim* (L.R. 7 Ch. 848); and *Worcester Royal Porcelain Company, Ltd. v. Locke & Co., Ltd.* (19 R.P.C. 479).

The cases cited by *Scrutton*, K.C., and *Smith*, K.C., for the Respondents, were the following:—*Cellular Clothing Company v. Maxton and Murray* (16 R.P.C. 397; L.R. (1899) App. Cas. 326); *Whitstable Oyster Fishery Company v. Hayling Fisheries, Ltd.* (18 R.P.C. 434); *Braham v. Beachim* (L.R. 7 C.D. 848); *Canal Company v. Clarke* (13 Wallace 311 (United States)); *Montgomery v. Donald* (11 Scotch Sess. Cas., Fourth Series, 506); *Montgomery v. Thompson*, *ubi supra*; *Singer Manufacturing Company v. Loog* (L.R. 8
 40 App. Cas. 15).

45 The judgment of the Judicial Committee was delivered by:

Lord DAVEY.—The Appellants are the proprietors of certain lands in the township of Caledonia, Prescott County, Ontario. There are on this land three natural springs of mineral waters containing chemical properties which render them serviceable as table waters and for medicinal purposes. The springs are
 50 in close proximity to each other, but differ widely in character. One of these springs is known as the “Gas Spring,” from the quantity of carburetted hydrogen gas which it evolves; another is called the “Saline Spring,” while the third is known as the “White Sulphur Spring.” Owing to the presence of these springs the site has for many years past acquired a great reputation as a place of summer resort. The Appellants own a large hotel called the
 55 “Caledonia Springs Hotel,” and in the course of time other buildings have been erected, which the learned Chancellor of Ontario in his judgment describes

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as the "Caledonia Springs village attached to the hotel," and there are a Caledonia Springs post-office and a Caledonia Springs railway station. The springs are called the "Caledonia Springs," and the locality itself has also acquired the name of Caledonia Springs, very much like Tunbridge Wells, although in this case there is nothing which could properly be described as a town, and no incorporated village. 5

There is a fourth spring, situate about two miles from the other springs, called the "Intermittent" or "Duncan" spring, belonging, not to the Appellants, but to a gentleman named *King Arnoldi*. The Appellants, on the 27th of December 1889, acquired from Mr. *Arnoldi* the right to take water from the "Duncan Spring," and to use his registered Trade Marks for a period of two years, and also for ever to use, in connection with the water of the "Duncan Spring," the words "Magi Caledonia Springs," registered by them. The Appellants thus include this spring also in the expression "Caledonia Springs." 10

The Appellants use the water from their springs for the purpose of supplying the visitors at their hotel, and also supply it in barrels to their agents and others in Ontario and Quebec, who bottle it for the purpose of sale to the public. And they have registered as Trade Marks certain labels for use on the bottles. The Appellants' waters, and (it may be assumed) Mr. *Arnoldi's* waters also, have acquired in the market the name of "Caledonia Water." 15

The Respondent *McDougall* was also until recently the proprietor of an hotel at Caledonia Springs, known as the "Queen's Hotel." The Respondent *McDonell* was the owner of land immediately adjoining the land of the Appellants. *McDougall*, having some difficulty with the Appellants as to the supply of their water for the visitors at his hotel, in the year 1898 commenced boring on the land of *McDonell*, who was his brother-in-law, and at the depth of 85 feet a spring of saline water was tapped, and a further boring, made a short distance from the first, struck a subterranean spring of sulphur water at a depth of 165 feet. Both springs have a continuous natural flow, which rises up the pipes laid in the borings. These borings are situate about a quarter of a mile from the Appellants' three springs, and the analysis of the water obtained from them shows a general resemblance to the waters from the Appellants' springs. On the 1st of August 1898 *McDonell* entered into a partnership agreement with the Respondents *Lyall* and *Trenholme* for placing on the market the waters from the borings thus made on his land. Arrangements were then made with the Respondents *Wilson* for sale of the waters, as agents for the partners, at Toronto, and with the Respondents *J. Tune & Son* for their sale at London (Ontario). 20

On the 5th of February 1901, the Appellants commenced two actions against the Respondents *Wilson* and against the Respondents *J. Tune & Son*. The other Respondents were afterwards added as Defendants in each action. The two actions were consolidated, and were heard by the Chancellor of Ontario on the 11th of June 1901, and judgment was delivered on the 18th of the same month. 25

The Plaintiffs in the action claimed an exclusive right to the use of the word "Caledonia" in the phrases (amongst others) "Caledonia Water," "Caledonia Seltzer," "Mineral Water from Caledonia Springs," and "From New Springs at Caledonia," and the words "Natural Saline Water," and "Natural Seltzer," and prayed an injunction to restrain the Defendants from infringing the Plaintiffs' Trade Marks, and also from selling the water as "Caledonia Water," or under any name, Trade Mark, or designation using the word "Caledonia" as descriptive of the same, or to indicate the source of the water. 30

The learned Chancellor held that the Respondents, *J. Tune & Son*, had infringed the Appellants' Trade Marks, and the Court of Appeal agreed in that finding, and continued the injunction granted against those Respondents. There is no appeal as to this matter, and it seems to their Lordships clearly right. It is fair, however, to the principal Respondents to say that the 35

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obnoxious labels were adopted without any direction from them, and when they were made aware of the use of the labels they expressed their disapproval, and said they could not undertake to defend it. As regards the labels used by the Respondents *Wilson*, the Chancellor held that the Defendants had not infringed the Appellants' Trade Marks, but as to the trade names "Caledonia Water" and "Water from Caledonia Springs," the case of the Plaintiffs was established, and he granted an injunction accordingly.

The Respondents appealed, and their appeal was heard ultimately before *Moss, C.J.*, and *MacLennan and Osler, JJ.* The Chief Justice agreed with the Chancellor, but thought that the terms of the injunction should be varied in one respect. The two other learned judges dissented (except as to the injunction against *J. Tune & Son*), and the reasons for their judgment were given by Mr. Justice *MacLennan*. The appeal was accordingly allowed, and by an Order of the 4th of December 1902 the actions, save in respect of the injunction against the Respondents *J. Tune & Son*, were dismissed with costs. Hence this appeal.

The learned Counsel for the Appellants did not lay much stress upon the alleged infringement of the Trade Marks except as regards the use of the word "Caledonia," and in their Lordships' opinion quite rightly. On this point, which is one of fact, their Lordships agree with the concurrent findings of the two Courts below. Nor do their Lordships think there is anything in the make-up of the Respondents' goods to which the Appellants can reasonably object. A more difficult question is as to the use of the word "Caledonia" as a trade name, or as part of the description of the Respondents' waters. It must be conceded that the Respondents cannot use the word in such a manner as to pass off their goods for those of the Appellants. But if they have not done so, they ought not to be restrained by injunction from the use of the word.

The first fact to be noted is that the goods in question are not a manufactured article, or, in other words, the name which it is sought to protect is not the name for the Appellants' make of goods but, to put it most favourably for the Appellants, designates water from particular springs belonging to them. The waters derive their virtues from the strata from which they spring, or through which they pass, before they reach the surface, that is to say, from the inherent properties of the soil itself in that particular locality. Another material fact is that the words "Caledonia Springs" and "Caledonia Water" are said to designate the "Duncan" Spring and its waters equally with the Appellants' three springs, although the former is distant two miles from the latter and has no apparent connection with them, except that of being situate in the same township. It is quite true that the same trade name may designate the goods of more than one person, but it is less easy to infer that a geographical description has acquired a secondary meaning when you find that it is used to designate the goods of two or more persons connected only by identity of geographical origin. And whatever force there is in this observation does not appear to their Lordships to be materially weakened by the fact of there being other springs in the township which, like the "Duncan" Spring, are called by different names. Lastly it must be observed that in the present case the name of the locality necessarily enters into and forms part of any real description of the Respondents' waters, and that the words "Caledonia Springs" have acquired a secondary or perhaps tertiary meaning as the name and the only name of the locality. Their Lordships agree with Mr. Justice *MacLennan* that if the Respondents' water is likely to be more sought after and more marketable, and if the business of the selling it is likely to be more profitable by reason of the situation of the springs and their nearness to the famous old springs, the Respondents are entitled to the benefit of that circumstance. Indeed it is impossible to see how the Respondents could adequately describe a natural product of the soil which derives its excellence from the inherent properties of the soil in that particular locality without some reference to the place, and using for that purpose in some form the only name by which it is known.

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Their Lordships are therefore of opinion that the Appellants have not a right to the exclusive use which they claim of the word "Caledonia" in connection with their waters. The "Stone Ale" case (*Montgomery v. Thompson*, L.R. (1891) App. Cas. 217), does not appear to them to have any bearing on the present case. That was a case of a manufactured article, and was decided on the special circumstances of the case, as clearly appears from the judgments of Lord *Watson* and Lord *Macnaghten*. The "Glenfield Starch" case (*Wotherspoon v. Currie*, L.R. 5 H.L. 508) differs materially from the present case in the facts on which it was decided, for the term "Glenfield" was not a necessary part of the description of the manufactured article there in question, and there was evidence that the Defendant's works were set up at Glenfield for the purpose of passing off their goods as those of the Plaintiff. But have the Respondents used the word "Caledonia" in such a manner as to pass off their water as coming from the springs of the Appellants? Or have they taken adequate care to distinguish their goods from those of the Appellants? In considering this question their Lordships do not forget the answer given by the Respondent *Lyall* in his evidence when he accepted the suggestion of the Plaintiffs' Counsel that his object, in taking hold of this water from these wells, was to sell it as "Caledonia Water." They do not, however, attach so much importance to this piece of evidence as the learned Chancellor. From the way in which the suggestion was made and accepted they think that *Lyall* may not have meant more than that he desired to sell it as "Water from Caledonia" in competition with the Plaintiffs. The Respondents are not proved to have ever themselves sold their water under the description of "Caledonia Water" or "Water from Caledonia Springs," but what is said is that the use by them of the word "Caledonia" in any form enables the water to be sold by the retailer as "Caledonia Water," and is therefore calculated to deceive the ultimate purchaser. Their Lordships agree with what has been frequently said in these cases, that even a description of goods which is literally true may be so framed as to mislead, and they bear in mind the cases of which *Johnston v. Orr Ewing* (L.R. 7 App. Cas. 219) is an example, where a trade name or mark which would not mislead the dealer has been held an infringement because it was calculated to mislead the retail purchaser.

The Respondents (other than *J. Tume & Son*) sell their goods under the description of "Natural Saline Water from the New" (or) "from New Springs at Caledonia," and as "Beaver Brand," and they have a picture of a beaver on their labels as a Trade Mark. It appears to their Lordships that the expressions "the new springs" or "new springs" at once distinguishes their water from the water coming from what the Appellants call on one of their labels "the original springs," and no person reading the label could possibly believe he was buying water from the original springs. It is not like the case of manufactured goods where the trade name attaches to the make of a particular manufacturer, and the purchaser might then suppose he was buying a new make of the same manufacturer. In the present case the name is not personal but local, and attaches only to the particular springs. The learned Chancellor criticises the use of the word "springs" as descriptive of the source from which the Respondents derive their water, but this seems hypercritical. The source is none the less a spring because it finds its way to the surface by an artificial cavity instead of a natural fissure in the soil. The learned Chancellor also criticises the use of the words "at Caledonia." He says there is no place called Caledonia simply. It is true that "Caledonia Springs" would have been more accurate, but also, probably, in the view of the Plaintiffs, more objectionable. But whether the words are to be taken as referring to the township or the particular place, their Lordships agree with Mr. Justice *MacLennan* that the words "at Caledonia" are not inaccurate, and it was pointed out that the expression is used in the sheet called "Life at the Springs," which is described as published every Saturday "at Caledonia." It is possible that the common

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- use of the word "Caledonia" in any form may lead to some dishonesty on the part of the retail seller. But their Lordships think that, in the peculiar circumstances of this case, the Respondents cannot be made responsible for such a consequence. The Plaintiffs sold their water as "Caledonia Water" at a time
- 5 when they had no competitors in the sale of natural mineral waters from the place called Caledonia Springs, but in giving it that name they ran the risk of other persons discovering other springs in the same locality, and being entitled to sell other water as water coming from springs in that locality. Their Lordships hold that the Respondents are entitled to indicate the local source of the
- 10 waters sold by them, and so holding, they think that the burden cast upon the Respondents of distinguishing their goods from those of the Appellants has been discharged. "New Springs" seems at least as distinctive as "Crystal Springs," which the Respondents originally thought of, or "Beaver Spring" which was suggested by the Counsel for the Appellants.
- 15 They will, therefore, humbly advise His Majesty that the appeal should be dismissed, and the Appellants will pay the costs of it.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BUCKLEY.

December 18th, 1903.

20 DOVER (H. W.) AND DOVER, LD. *v.* NEW TOWNEND CYCLE COMPANY, LD.

Patent.—Trade Mark.—Action for infringement.—Perpetual injunction consented to.—Undertaking substituted.

- An action having been brought by *Horace Walter Dover and Dover, Ltd.*, for infringement of Letters Patent No. 10,087 of 1899, and also for infringement
- 25 of the Plaintiffs' registered Trade Mark No. 221,740, the Plaintiffs gave notice of motion for an interlocutory injunction. On the hearing of the motion, *Astbury, K.C.*, and *A. J. Walter* (instructed by *Gresham, Davies, and Dallas*) appeared for the Plaintiffs; *Sargant* (instructed by *Morgan, Price, and Mewburn*, agents for *Hargreaves and Heaton*, of Birmingham) appeared
- 30 for the Defendants.

- Astbury, K.C.*, having stated that the Defendants had consented to a perpetual injunction and to treat the hearing of the motion as the trial of the action, added that, although the writ was issued against a Limited Company, that Company was not in fact incorporated until after the issue of the writ. The
- 35 real Defendant was an individual carrying on business under the name of the *New Townend Cycle Company*, and Counsel asked, with the consent of the other side, to amend the writ by making as the Defendant the individual trading as the above named Company.

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BUCKLEY, J., suggested simply striking out the word "Limited," and said it was not necessary to put the Defendant's personal name in, as his firm name would do.

Astbury, K.C.—Amend the writ by omitting the word "Limited," and then we will treat this as the trial of the action and take a perpetual injunction with costs by consent. 5

BUCKLEY, J.—Would you not prefer that the Defendant should give a perpetual undertaking with costs? Perhaps I had better take this opportunity of saying why. I have recently heard that sometimes in Patent cases injunctions are taken by consent upon terms which are arranged as between the Plaintiff and Defendant (I am not suggesting that that is so here), and then these injunctions are advertised as if they had been granted by the Court in an opposed matter. That ought not to be done. "The Defendant appearing and undertaking" of course precludes that. 10

Astbury, K.C.—As a matter of fact this is a hostile case, but we will take the undertaking. 15

The judgment as drawn up was, omitting the formal commencement, as follows:—
"The Defendants by their Counsel agreeing to treat this hearing as the trial of
"this action and consenting, and the Defendants by their Counsel undertaking
"during the continuance of the Plaintiffs' Letters Patent No. 10,087 of the year 20
"1899 and of the Plaintiffs' registered Trade Mark No. 221,740 respectively to
"refrain from infringing the said Letters Patent and the said Trade Mark
"respectively, this Court doth order and adjudge that the Defendants, the
"*New Townend Cycle Company*, do pay to the Plaintiffs, *Horace Walter Dover*
"and *Dover, Ltd.*, their costs of this action, to be taxed by the Taxing Master." 25

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BYRNE.

October 31st, November 2nd and 3rd, and December 21st, 1903.

WERNER MOTORS, LD. v. A. W. GAMAGE, LD.

5 *Design.—Action for infringement.—Validity of registration.—Patent granted on application prior to registration of Design.—Novelty.—Defendants threatening to sell after knowledge of registration.—Marking of articles.—Judgment for Plaintiffs.—Patents, &c. Act, 1883, sections 51, 58, and 59.*

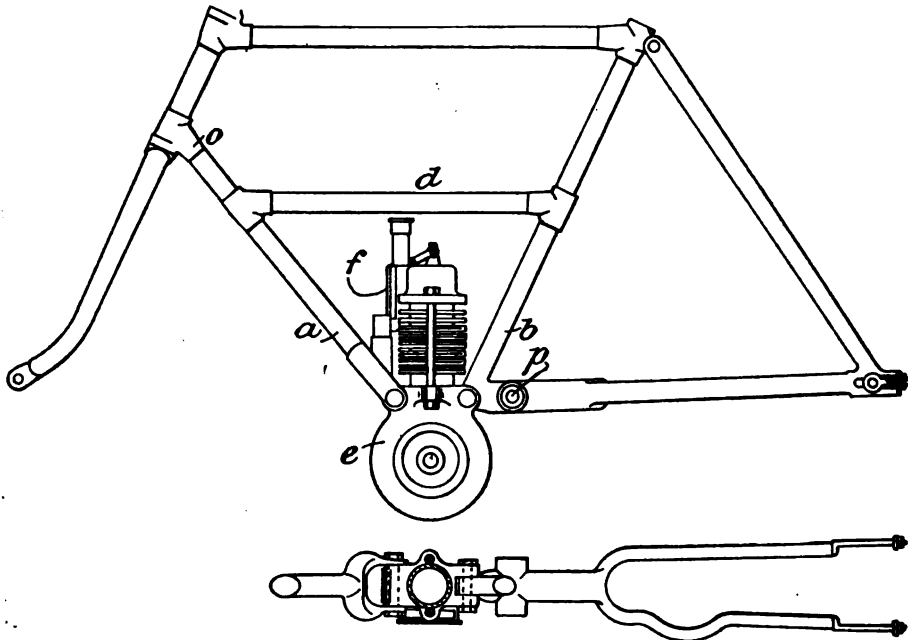
10 *On the 18th of November 1901 M. W. and E. W. registered a Design applicable "for the pattern as shown of a motor-cycle frame," and the registered proprietors of the Design subsequently commenced an action for infringement. The Defendants denied infringement, and alleged that the registration was invalid for want of novelty; they also alleged that the sales made by them before action had been made without knowledge of the registration of the Design,*
 15 *and at the trial they contended that, although they had made a few sales after the commencement of the action, they had never threatened to do any wrongful act, since on the evidence the copyright had ceased under section 51 of the Patents, &c. Act, 1883, by reason of insufficient marking of articles by the Plaintiffs; they further alleged that a Patent had been applied for, on the*
 20 *8th of November 1901 for a frame for motor-cycles the same as that shown in the Design, and that, the Patent having been granted on an application made before the application to register the Design, the registration of the Design was invalidated by reason of a prior grant of exclusive rights in the article.*

Held, that the Design was novel, and that the design of the machine sold by
 25 *the Defendants was, with the exception of immaterial details, identical with the registered Design; that the fact of the registration was unknown to the Defendants before action, and their acts until then were protected as far as penalties or damages were concerned, but that having regard to the subsequent sales and the position taken up by the Defendants on the motion and subsequently, the*
 30 *Plaintiffs were entitled to an injunction against infringement; that there was no evidence of articles insufficiently marked having been sold; and that the registration of the Design was not invalidated by the Patent, because, first, the Design was registered before the actual grant of the Patent; secondly, that the*

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right of copyright in a Design is not a grant but is statutory ; and, thirdly, that rights under a Patent and in a Design are separate and distinct and may co-exist. An injunction was granted with costs, and by arrangement the Plaintiffs accepted a sum for damages. A stay of the injunction was refused.

On the 18th of November 1901 *M. Werner* and *E. Werner* registered a Design 5 (No. 383,283) in Class 1 applicable "for the pattern as shown of a motor-cycle 'frame.'" A representation of the Design as registered is shown below, except that the lettering of the parts has been added for the purpose of this report.



On the 18th of April 1902 the Design was assigned to *Werner Motors, Ltd.* On the 1st of August 1902 *Werner Motors, Ltd.*, commenced an action against *A. and W. Gamage, Ltd.*, for infringement of the Design, claiming an injunction, damages or an account of profits, delivery up, and costs. 10

The Plaintiffs by their Statement of Claim alleged—(1) the registration of the Design, and that it was a new and original Design not previously published in the United Kingdom ; (2) that the Defendants had, without the written 15 licence or consent of the Plaintiffs, applied and caused to be applied such Design or a fraudulent or obvious imitation thereof for the purpose of sale to motor bicycles, being goods within Class 1 ; (3) that the Defendants had sold and offered for sale, and were still selling and offering for sale, motor bicycles constructed according to such Design or a fraudulent or obvious imitation 20 thereof, well knowing that such Design had been used or applied by them without the consent of the Plaintiffs ; (4) that the Plaintiffs complained in particular that, on the 29th day of July 1902, the Defendants sold to *Rowland James Moon*, at their premises in Holborn, in the City of London, a motor cycle to which the said Design No. 383,283 had been wrongfully applied as 25 aforesaid ; by (5) the Plaintiffs claimed the right to recover compensation in respect of all infringements ; and (6) they alleged injury to their business.

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- By their Defence, as amended, the Defendants (1) denied infringement ; (2) alleged that the said Design was not a new nor original Design at the date of the registration thereof, but had been published in the United Kingdom at that date—(a) by the publication of the following documents :—(i) The Specification of Letters Patent (No. 15,605 of 1897) granted to *Mettewic*, Fig. 1 of the drawings being relied on ; (ii) the Specification of Letters Patent (No. 13,970 of 1899) granted to *Chapelle and Chapelle*, Figs. 1 and 9 of the drawing being relied on ; (iii) the issue of a newspaper entitled the “ Motor Car Journal,” dated the 28th of July 1900, the illustration on page 359 being relied on ; (iv) the issue of the “ Motor Car Journal,” dated the 16th of March 1901, the illustration on page 28 being relied on ; (v) the issue of a newspaper entitled the “ Auto Car,” dated the 26th of January 1901, the illustration on page 79 being relied on ; (b) by the use in public and sale (*inter alia*)* (ii) by *W. A. Barnes* of Church Street, Gainsborough, in the year 1900 of motor bicycles substantially the same as those illustrated in the “ Auto Car” of the 26th of January 1901, page 79 ; (iii) by *A. G. Hastings*, of 53, Abingdon Villas, Kensington, London, in the year 1901 of a motor bicycle known as the “ Red Star” ; (v) by *A. J. Westlake*, of 82, Portsdown Road, Maida Vale, London, in the year 1900 and 1901 of a motor bicycle known as the “ Bluhm” ; (3) that the Defendants did not apply or cause to be applied, and did not intend to do so, the said Design or any fraudulent or obvious imitation thereof to any bicycles ; (4) that the Defendants had not published or exposed for sale, and did not intend to do so, any bicycles to which such Design or any fraudulent or obvious imitation thereof had been applied, knowing that the same had been applied without the consent of the registered proprietors ; (5) that the said Design was registered in this country on the 18th day of November 1901 in the names of *Michel Werner* and *Eugene Werner* ; that on the 8th of November 1901 one *A. F. Spooner*, as agent for the said *M. and E. Werner*, applied for Letters Patent in this country in respect of an invention of “ Improvements in frames for motor bicycles and other vehicles,” which frames were in all respects identical with the said Design, and Letters Patent in respect of the said invention were subsequently granted and dated the 8th of November 1901 ; the Defendants would contend that, in these circumstances, the registration of the said Design was invalid and was contrary to the policy of the Act and was a fraud on the Crown.

- The following further Particulars of paragraph 2 (b) of the Defence were delivered pursuant to an Order of the 16th of February 1903 :—(2) By the use in public in Gainsborough by *W. A. Barnes*, of Church Street, Gainsborough, in and after the month of December 1900, of a motor bicycle substantially the same as that illustrated in the “ Auto Car” of the 26th of January 1901, page 79 ; (3) by the use in public in London by *A. G. Hastings*, of 53, Abingdon Villas, Kensington, London, in the month of August 1901 and subsequently thereto, of a motor bicycle purchased from *M. Knapen*, of Louvain, Belgium, known as the “ Red Star” ; (5) by the use in public in London in and about the month of August 1898 by *A. J. Westlake* of 82, Portsdown Road, Maida Vale, London, of a motor bicycle known as the “ Bluhm” ; by the sale by the said *A. J. Westlake* to *A. L. Stent* of Fairfield, Havant, in the month of September 1900 of a motor bicycle known as the “ Bluhm.”

- Figs. 1 and 2 of the Specification of *Spooner's* Patent (No. 22,563 of 1901, granted on a communication from abroad by *M. Werner* and *E. Werner*) were, with the addition of some detailed matter, substantially identical with the registered Design.

The claims were as follows :—“ 1. A frame for motor cycles characterized by “ the arrangement instead of and in the place of the ordinary pedals, at the

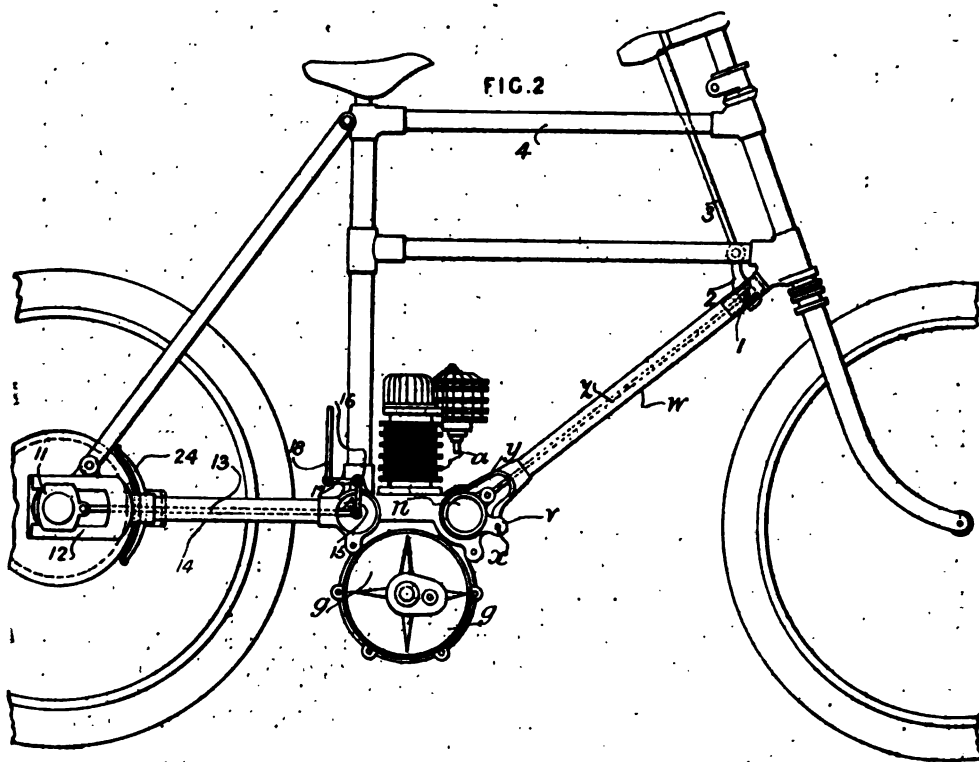
* Nos. (1) and (4) were struck out by an Order of the 26th of October 1903, and by the same Order the evidence on *b* (2) and (3) was to be confined to use.

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"angle formed by two adjacent tubes of the frame, of an opening allowing of
 "the placing of an engine suitably fixed to the said tubes but being preferably
 "secured by means of a fork *i* formed on one of the tubes *a* and connected to
 "an ear *h* extending the width of the casing *s*, the other tube *b* being connected
 "between the parts of the other ear *g* of the casing opposite to the first ear *h*; 5
 "the part *b* of the frame being formed with the head of the back stay *c* carrying,
 "itself, the pedal-crank axle *p*; all with the object of assuring greater stability
 "while running and to facilitate the fixing of the engine. (2) A frame for
 "motor cycles constructed substantially as described with reference to the
 "accompanying drawings." 10

The Complete Specification was left on the 8th of August 1902, and accepted on the 23rd October 1902.

Fig. 2 of *Chapelle's* Specification, which was the anticipation chiefly relied on at the trial, is, so far as material, shown below.



The following is an extract from the description of the *Baines* motor bicycle, 15 in the "Motor Car Journal":—"The bottom tube is divided, and, with the seat tube or diagonal which is also bifurcated, forms the frame for the motor. "No pedals are fitted—that is, revolving pedals—the bottom bracket or pedal crank bearing being done away with."

At the trial the Defendants raised the point that the Plaintiffs had not always 20 complied with section 51 of the Patents, &c. Act, 1883, as to the marking of articles, and alleged that, on the evidence, the copyright in the Design had ceased. The facts, as they alleged them on this point, were that a Design was in November 1902 registered by the Plaintiffs which was practically the same as the Design sued on, and that articles made according to the second Design, and 25

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therefore according to the first Design substantially, had been sold without being marked with the number of the first Design. It will be seen from the judgment, however, that it was found that no sale of such articles had been proved.

- 5 The Plaintiffs moved for an interlocutory injunction, but the motion was ordered to stand to the trial, the Defendants having undertaken to keep an account. The Defendants put in evidence on the motion to prove delay on the part of the Plaintiffs, and they did not state that they did not intend to sell in future.
- 10 *A. J. Walter and D. M. Kerly* (instructed by *J. B. and F. Purchase*) appeared for the Plaintiffs; *T. Terrell, K.O.*, and *J. C. Graham* (instructed by *Ward, Perks, and McKay*) appeared for the Defendants.
- 15 *Walter* opened the Plaintiffs' case.—This is an action for infringement of a registered Design for motor cycles. The registration is under section 47 of the Patents, Designs, and Trade Marks Act, 1883. The registration was in November 1901, and on the 29th of July 1902 there was a sale by the Defendants of a motor cycle to which the design had been applied. In the Design the motor itself completes the frame, and the position of the strengthening bar is new. It has been very largely used. The question of design is one to be decided by
- 20 the eye assisted by expert evidence. The Defendants buy machines abroad, and bring them into this country and sell them here; they are actually selling the *Werner* motor cycle under that name, getting the machines indirectly. Substantially the registered Design is taken. The Plaintiffs ask for an injunction and for damages under section 59 of the Patents, &c. Act, 1883, and not for
- 25 penalties under section 58. [*Terrell, K.C.*—One of the substantial defences is that the Defendants' acts do not come with 58 (a), nor within (b), as they knew nothing of the registration; also, under section 59, there must be knowledge on the part of a Defendant that the proprietor has not given his consent to the application of the Design.] The evidence will show knowledge on the part of
- 30 the Defendants. The Plaintiffs have advertised that the Design was registered. [Correspondence was here referred to on the question of knowledge, including a letter of the 9th of April 1903 from the Plaintiffs to *F. Chaplin*, a purchaser from the Defendants, complaining of infringement of the Plaintiffs' rights, stating that the Plaintiffs had certain rights in the new *Werner* Design, and also
- 35 the letter referred to in the judgment.] [*Terrell, K.C.*—As to the first letter, the Defendants thought it referred to Patent rights, and, as to the other letter to *Mr. Brett*, the *Werner* 1903 model is not made according to the registered Design.] The Defendants are still threatening to sell and offering for sale.
- 40 The following witnesses were called for the Plaintiffs, namely:—*R. J. Moon*, who identified the machine referred to in paragraph 4 of the Statement of Claim; *Professor Boyes*; and *E. H. Arnott*, secretary of the Plaintiff Company. The certificate of registration was put in, and an affidavit by *Guttridge* was read as an admission that the Defendants claimed the right to continue.
- 45 In the course of his examination-in-chief of *Professor Boyes*, *Walter* proposed to ask the witness as an expert what were the special features of the Design. *Terrell, K.C.*, objected, and referred to *Hecla Foundry Company v. Walker, Hunter & Co.* (6 R.P.C. 554; L.R. 14 App. Cas. 550), and in particular *Lord Herschell's* judgment, and continued:—The object or purpose is not to be regarded; the question of infringement of a design is one of shape and is one
- 50 for the eye of the Court. [*Walter*.—Expert evidence was called in that case.] Expert evidence is only admissible where explanation is required from a scientific point of view. If a witness expresses an opinion whether there is resemblance to a design, then he is performing the function of the Court. [*BYRNE, J.*, referred to *Addley Bourne v. Swan and Edgar, Ltd.* (L.R. (1903)
- 55 1 Ch. 211, at page 224; 20 R.P.C. 105, at page 118).] That was an action for passing off. [*BYRNE, J.*—May I not have assistance, for instance as to whether the article is made in accordance with the Design?] But the Design is registered for the

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pattern, and the function is immaterial. [BYRNE, J.—Cannot the expert point out in the actual machines each of the parts shown in the drawing? I will take the evidence *de bene esse*.] The witness then asked how far he was to eliminate function. [BYRNE, J.—You may point out the parts in the actual machine.] The witness then described the design, stating what the parts which were identified in the drawing before him by letters were, and subsequently pointed out in the exhibit R.J.M. 2 (the alleged infringement) the parts shown in the Design. He stated that he was accustomed to compare designs and to the interpretation of them in articles of manufacture. He was then asked—In your view has the registered Design been applied to that motor bicycle (R.J.M. 2)? Terrell, K.C., objected that it was the same as if an expert was asked if a Patent had been infringed. BYRNE, J., proposed that the question should be whether the witness found all the parts represented in the Design on the alleged infringement? Terrell, K.C., suggested that the question should be whether the witness found the shape of the parts the same, and, the question being so put, the witness said that he found all the parts substantially the same in shape in the bicycle and relatively to one another in position identical, and that he saw no Design referred to in the Particulars of Objections like the registered Design in configuration and geometrical arrangement of parts one to another. In cross-examination the witness specially mentioned the following points as novelties in the Plaintiffs' Design—first, putting (*d*) (the horizontal strengthening tube) lower than had been done, cross-bars going to the lug of the head were old; secondly, the bifurcation of *a* (the front down tube) and its separation from *b* (the back down tube), the diamond frame not being complete at the bottom apart from the motor.

Kerly summed up the Plaintiffs' case. The point being taken that knowledge on the part of the Defendants must be proved, there may be a difficulty as regards damages, but there is a threat to continue the acts complained of, so that the Plaintiffs are entitled to an injunction. It is inconceivable, however, on the facts that the Defendants did not know of the registration; the Defendants are a limited Company, and knowledge of their agents is that of the Company, though the agents must, of course, be agents for this purpose; the manager of their cycle department would be such an agent. The Plaintiffs have at all events made out a *prima facie* case. The Design and the Patent are not a double grant. The protection for a Design is limited to the particular arrangement and shape, but that of a Patent is not so limited. The Patent might be infringed without infringement of the Design. It is contended that one must look at the Design irrespective of function, but this is not so, *i.e.*, some lines represent tubes, the concentric circles represent a crank case, and so on. One has to look at the collection of objects as indicated in their relative arrangements and dimensions. The Design is good as applied.

Terrell, K.C., opened the Defendants' case. There is no offence under section 59 without knowledge that an offence is being committed. The policy and scheme of the Part of the Act as to Designs are different from those with regard to Patents. Section 30 specially provides for the grant of an injunction in the case of infringement of a Patent, but it contains nothing to make knowledge necessary. For the granting of an injunction, there must be a threat to commit a wrong. Section 51 requires the marking of articles to which a registered Design has been applied. By section 52 a Design is only open to inspection as therein provided; there is no publication during its existence; but for the marking of articles no one would know of it. Section 58 imposes penalties (*a*) in the case of manufacture; (*b*) of sale with knowledge. Under section 59 knowledge is part of the offence. The Court will not grant an injunction in a case in which it will give no damages and impose no penalty. The cause of action must be complete at the date of the writ, and if the Plaintiffs fail because of want of knowledge on the part of the Defendants, there ought not to be an injunction on account of anything happening subsequently. There was no.

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notice to the Defendants before the commencement of the action. [*Jan v. Grossman*, 12 R.P.C. 537, was referred to.] Moreover, the subsequent acts may be lawful if articles have been sold unmarked, the Defendants have a statutory right to make the article. [The Pleadings were referred to.] Only one breach
5 is alleged, and I shall prove that that was without knowledge. The fact is that the Defendants knew of the Patent, and were prepared to contest it; but they are sued on a Design which they did not know of. Knowledge of a claim of the Plaintiffs is not sufficient, without knowledge of the Design. Part only of the bicycle is registered, and the marking does not show which part. Subject-
10 matter is, however, an important point of the case; section 47 allows registration of a new or original Design, not previously published in the United Kingdom, and section 61 defines the "proprietor." Subject-matter is a question for the eye (*Hecla Foundry Company v. Walker, Hunter & Co.*, 6 R.P.C. 554), and not every Design that is new is registerable (*Le May v. Welch*,
15 L.R. 28 Ch. D. 24); there must be substantial novelty, and the novelty must be in the Design, not in the function. A Design must be applicable for pattern, shape, or configuration, or ornament (section 60). Here the registration is for the "pattern as shown of a motor-cycle frame." Trade ought not to be hampered by the registration of Designs for merely frivolous alterations. *Chapelle*
20 had been published; and bicycle frames of all kinds of shapes were old; the diamond frame with a strengthening tube was old, but it is said for the Plaintiffs that the tube is in a new position. The placing of the motor where it is in the registered Design was old. So far as design is concerned, and apart from function, the alterations are mere detail. Function is not material (*Walker v. Falkirk Iron Company*, 4 R.P.C. 390). There is no authority on the point
25 raised as to prior grant, but the Crown cannot grant the sole right of manufacturing an article to two different persons: it can under the Statute of Monopolies only grant it to the first and true inventor. In this case, the Crown had already granted the sole right to make the article before the Design was
30 applied for. The claim in the Specification of *Spooner's* Patent involves all the essential elements of the Design. A purchaser who buys the patented article from the Patentee is entitled to do what he likes with it (*Incandescent Gas Light Company, Ltd. v. Cantelo*, 12 R.P.C. 262); but, according to the Plaintiffs' contention, the owner of the Design can prevent a purchaser from
35 using the article.

Evidence was given on behalf of the Defendants by *A. J. Boulton*, Patent agent, *A. W. Gamage*, and other witnesses, including *Guttridge*, who was manager of the motor department of the Defendants' business. *Gamage* stated that about 25 to 30 machines had been bought in Paris from *Werner*
40 through the Defendants' agent before the date of the writ; that he knew there was a Patent, but did not know of the registered Design; one of these machines then remained unsold; subsequently about four machines were sold.

Graham summed up the Defendants' case.—As to the sales before the service of the writ, there was no knowledge on the part of the Defendants, and there is
45 a complete defence under sections 58 and 59. It is said that the Defendants threatened to go on selling, but no injunction can now be granted as the copyright has ceased, because the Plaintiffs registered another Design, practically identical with that sued on, and sold machines made according to that later Design without the number of the first Design on them; so they have really
50 sold machines made under the first Design without the machines being properly marked under section 51. Under the circumstances any assertion by the Defendants of a right to continue selling was not an assertion of an intention to do an unlawful act. It is submitted that an injunction should not be granted. At the date of the writ the Defendants were not threatening
55 and intending to go on selling; they had only one unsold machine; about four were sold subsequently, but this was after knowledge of facts rendering the registration bad. The Plaintiffs must contend that an injunction ought

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to be granted now, because they were entitled to one at the date of the writ, but the Plaintiffs never had any right to an injunction. [BYRNE, J.—The Plaintiffs say that the subsequent acts of the Defendants show that they intended to go on selling.] One must not assume a wrongful intention without any evidence of a wrongful act. [BYRNE, J.—Is there not evidence of an intention to go on doing an act which became wrongful on knowledge by the Defendants?] There is no evidence of any threat. As to prior grant, section 50 gives the registered proprietor of a design copyright for five years, and section 60 defines "copyright" as the exclusive right to apply the Design; but by the Patent which is dated ten days earlier than the Design, the Crown granted the exclusive right to another person. As to subject-matter, a Design is not by section 60 applicable for construction. Bearing the judgment of Lord Herschell in *Hecia Foundry Company v. Walker, Hunter & Co.* in mind, one must compare the Design with the drawings in *Chapelle's Specification*. As to infringement, there are some differences between the machine complained of and the Design.

Walter in reply.—As to the marking, the Court is asked to decide a point that is not pleaded. The validity of the second Design is not before the Court, and there might arise a question whether the registration of it was good. There is no evidence that any article, to which the Design sued on has been applied, has been sold without being properly marked; section 51 says the marking is to be before "delivery on sale." Knowledge of the Design on the part of the Defendants is proved; they knew that exclusive rights were claimed, and in the Plaintiffs' advertisements, or many of them, it appears that the Design was registered. The Defendants knew that no consent was given, as required by section 59. At all events, on the interlocutory motion the Defendants did not deny knowledge, and they gave an undertaking to keep an account. Moreover, the validity of the registration has been attacked. Assuming that there was no knowledge of the Design by the Defendants before the date of the writ, there is evidence of an intention to go on infringing. As to infringement, one has to compare the alleged infringement with the Design. Common knowledge is not material on the question of infringement; the only test is whether the Design has been applied. As to subject-matter, the question is whether the shape is to be found in any alleged anticipation; one must not make a mosaic of the anticipations. The Design need only be new in its application (*Harrison v. Taylor*, 29 L.J. Ex. 3; *Saunders v. Wiel*, 10 R.P.C. 29). In *Le May v. Welsh* it was found that there was no subject-matter for design in collars, but that cannot be said to be so as to motor cycles. The new features are a frame, to which a motor is secured as shown, the strengthening tube *d*, the position of the pedal crank axle, and the way in which the frame is joined to the motor in the front and back. As to prior grant, there is no grant of a Design, the right is a statutory copyright. The Defendants must say that there cannot be a Patent and Design for the same article, but there is no authority for that. Patent rights are a different matter, Design is purely a question of form, whereas the question in relation to Patents is not one of form. At all events, the Design was registered before the actual grant of the Patent.

Judgment was reserved and delivered on the 21st of December 1903.

BYRNE, J.—The Plaintiffs are the registered proprietors of a Design for motor bicycles, being goods comprised in Class 1. They sue for an injunction to restrain the Defendants from selling motor cycles to which such Design or any obvious imitation thereof has been applied, and for damages. The Defendants deny infringement and raise other defences, grounded on want of novelty, denial of knowledge of application of the Design without the consent of the registered proprietor, and fraud on the Crown, a previous application for a Patent for improvements in frames for bicycles, which frames are identical with the Design, having been made 10 days before the registration of the Design—the Letters Patent subsequently granted dating back to the date of

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- application. I am satisfied that the Design registered was new and original. It represents the frame of a motor bicycle, having the strengthening tube placed a good deal lower than usual, joining two tubes, called on the lettered reproduction of the registered Design used at the trial (a) and (b), by means of junction
- 5 pieces, the front joint being a good way down the tube (a). There is also a continuation of the tubes (a) and (b) downwards so as to leave an open space between, filled and joined only by the motor by means of two bolts; the front tube (a) being bifurcated and passing outside the motor case; the back one, with stays, not bifurcated; the bearings of the pedal crank axle being shown
- 10 situate at the commencement of the lower back stay, at a place before it bifurcates. A comparison of this drawing with the drawing of *Chapelle's* frame relied on shows that the latter differs essentially. It represents the strengthening tube in the usual position, and it represents a crank axle in front of, not behind, the engine.
- 15 In the representation of a motor cycle in the picture of *Baines'* machine in the "Autocar"—a very badly blurred impression not, I think, much relied on—there there is no cross stay rod shown as in the Plaintiffs' Design. It was in fact admitted that the Design of this machine is quite different from the registered Design, but it was said that it showed a similar fastening of motor to
- 20 rods. I cannot say that I am persuaded that even this is the case. On the other hand, I am clearly of opinion that the Design of the machine sold by the Defendants as shown in their drawing, is, with the exception of small and immaterial details, identical with the registered Design. In fact the two drawings are different drawings of the same machine.
- 25 Next, as to the point raised that the Defendants had no knowledge that the Design was registered, I come to the conclusion, though not without a natural doubt inspired by a knowledge of the keenness with which advertisements are examined by those whose duty it is to see and look at the literature connected with the trade, that I must accept the evidence given on behalf of
- 30 the Defendants, with the result that the fact of registration was unknown to those persons connected with the Defendant Company, whose duty it was to watch and know about what was doing in the trade in motor cycles, prior to the issue of the writ in the action. It is not the fault of the Plaintiffs that the Defendants did not know; but, treating the case upon the footing that notice of
- 35 registration has not been brought home to the Defendant Company, what is the result? Only that the Plaintiffs are not entitled to damages in respect of sales effected before writ. The relevant sections of the Act are sections 58 and 59. The Defendants have not themselves applied the Design, and their acts, so far as penalty or damages are concerned, appear to be protected up to the date of the
- 40 service of the writ. This, however, will not protect them against an injunction unless they can bring themselves within the exception from the general rule mentioned in *Proctor v. Bayley* (L.R. 42, Chancery Division 390).^{*} That was a case having reference to infringement of a Patent, and Lord Justice *Cotton* at page 398 says: "Where a Patent is infringed, the Patentee has a *prima facie*
- 45 "case for an injunction, for it is to be presumed that an infringer intends to go "on infringing, and that the Patentee has a right to an injunction to prevent "his doing so." Again, if there has not been any infringement, but an intention "to infringe has been shown, an injunction will be granted." He then goes on to deal with the facts of the particular case, and comes to the conclusion that the
- 50 plaintiff was not justified in believing that the defendants intended to continue the infringement, and consequently an injunction was refused. The facts of that case were very special. There was a single and isolated act of user nearly five years before action, and the use of the machines had then been abandoned, because the defendants had found them unserviceable. The defendants in
- 55 their pleadings admitted the validity of the Patent and expressly pleaded that

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they never threatened or intended, and did not threaten or intend to use any apparatus infringing the plaintiff's Patent.

The facts in the present case differ entirely. The Defendants put in an affidavit on the interlocutory application for an injunction, strongly opposing an injunction on the ground of delay in bringing the action, and offering to keep an account. So far from saying that they did not mean to repeat the acts, they, in effect, claimed the right to repeat them if they kept an account, so that justice might be done at the trial should they prove to be wrong in selling more. They have defended, attacking the validity of the Design, and they have since the action offered to sell, though stipulating that they could give no indemnity (*see* their letter to Mr. Brett of the 10th March, 1903,* the writ having been issued in August 1902). Also four machines have also been sold since the writ.

I have no doubt at all but that the Defendants were threatening and intending at and after the date of the service of the writ to sell machines to which the registered Design had been applied. If on service of the writ they had written and said that they had been in ignorance of the registration, and that they did not mean to sell any more machines, or if on the motion they had offered an undertaking not to sell more, the matter would have stood on an entirely different footing.

The Plaintiffs had every right to suppose when they issued the writ that the Defendants must know of the registered Design, and want of knowledge was not raised on the motion as a defence. In August 1902, as I have said, the writ was issued, and in November 1902, the Plaintiffs registered a new Design, which, in fact, was similar to the originally registered Design except as to a matter of two inches in some detail as it was put by one of the witnesses. I am not sure that I yet appreciate the argument put forward—a man sues in respect of infringement of a Design, and he subsequently to action registers another, and if I understand the point, it is suggested that subsequent sales by him of things according to the new Design, without having both registration numbers upon them, has occasioned a forfeiture of his right to relief. I cannot follow the reasoning. I could understand the second registration being invalid because it was in truth a second registration of the original Design, but this is not the argument. Section 51 has reference to delivery on sale, and I have no sort of evidence that before delivery on sale any article was not caused to be duly marked.

The remaining point in the case is whether or not there has been a fraud upon the Crown because, having registered a Design under Statute, the Crown has been induced to grant a Patent for a machine, the grant dating back to a period before the registration of Design. There appear to me several answers to this: in the first place, the grant from the Crown was not made until after the statutory title was created, although, when made, it dated back to an earlier date prior to publication; in the second place, it is not a question between grant and subsequent grant from the Crown; and, in the third place, there is nothing inconsistent between a grant for a Patent and a coincident right and existence of a statutory right to a Design. The object of and privilege conferred by Letters Patent are wholly different from the object of and privileges conferred by Statute to a Design by registration. They may be co-existent, and the rights conferred do not clash. The Patent rights may be infringed, notwithstanding

* This letter omitting formal parts was as follows:—"Dear Sir,—Your esteemed letter dated the 7th instant duly to hand, and in reply thereto note that you are thinking of going in for a motor bicycle, and that you much prefer to have a 'Werner.' With reference to your request for a quotation for a 2 h. and a 2½ h.p. fitted with two good reliable brakes, and to be the same as *Werner's* are selling as 1903 models, our prices are as follows:—(Prices here followed.) "We would respectfully inform you, however, that should you favour us with an order, pending our own action, we cannot indemnify you should Messrs. *Werner's* take action against you."

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the Design, and the Design may be infringed though Patent rights may not be touched. A Design may be copied exactly without a Patent for the subject being infringed, and a Patent may be easily infringed without touching rights to a Design. The two rights are separate and distinct in title as well as in substance, and though no doubt any attempt to bolster up an invalid Patent or to get the advantage of an equivalent to Patent rights by the utilization of the right to register a Design would be jealously watched, the rights may and do fairly co-exist.

10 I think that the Plaintiffs are entitled to an injunction and costs. Do they ask for any damages?

Kerly.—Yes; but they will accept 5*l.* damages.

Graham.—I agree; that is to say subject to appeal.

A stay of injunction was applied for and refused.

IN THE COURT OF SESSION IN SCOTLAND

15 (INNER HOUSE. SECOND DIVISION).

Before THE LORD JUSTICE CLERK and LORDS YOUNG, TRAYNER,
and MONCRIEFF.

September 24th, 1903, and January 26th, 1904.

20 NEW CONVEYOR COMPANY, LD. v. EDINBURGH AND LEITH
GAS COMMISSIONERS.

Action for infringement of Patent.—*Specification admittedly bad.*—*Application by Pursuers for liberty to apply at the Patent Office for leave to amend the Specification by way of disclaimer and to sist procedure in the meantime.*—*Application refused.*—*Action dismissed.*—*Patents, &c. Act, 1883, section 19.*—

25 *Costs of Public Authority.*

The N. C. Co., who were the owners of a Patent for improvements in charging inclined gas retorts, raised an action against the Edinburgh Gas Commissioners for infringement of the same. After the pleadings had been closed and a proof allowed, the N. C. Co. admitted that the Specification was
30 bad, and that, if its defects were cured, the Summons would have to be correspondingly amended. Under the 19th section of the Patents, &c. Act, 1883, they moved for an Order authorising them to apply at the Patent Office for leave to amend their Specification by way of disclaimer, and to sist procedure in the action until such application had been disposed of by the Patent Office. The
35 motion was refused, and the action thrown out. The Pursuers reclaimed.

New Conveyor Company, Ltd. v. Edinburgh and Leith Gas Commissioners.

Held, that the Lord Ordinary had taken the proper course, and that his discretion ought not under the circumstances to be interfered with. Expenses as between agent and client refused.

In an Action for infringement of Letters Patent (No. 20,709 of 1892) for "Improvements in charging inclined gas retorts," in which the Defenders 5 pleaded the invalidity of the Patent for want of novelty and by reason of prior publication. After the Record had been closed and proof allowed, the Pursuers moved under section 19 of the Patents, &c. Act, 1883, for liberty to apply at the Patent Office for leave to amend the Specification of the Patent. The Lord Ordinary refused the Motion and dismissed the Action. The Lord Ordinary 10 pronounced the following interlocutor:—"The Lord Ordinary, having heard "Counsel for the parties on the Motion of the Pursuers for an Order in terms "of the 19th section of the Patents, Designs, and Trade Marks Act, 1883, "authorising them to apply at the Patent Office for leave to amend their "Specification by way of disclaimer and to sist procedure in this Action in the 15 "meantime, refuses the said Motion, dismisses the Action, and decerns; finds "the Pursuers liable in expenses; allows an account thereof to be given in, "and remits the same when lodged to the Auditor to tax and report."

For the facts of the case and the proceedings in the Outer House see *supra*, page 1. 20

On the 24th of September 1903 the Pursuers boxed a Reclaiming Note to the First Division, by whom it was transferred to the Second Division. The case was heard on the 26th January 1904.

Ure, K.C. (instructed by *Laing and Harley, W.S.*) for the Pursuers asked the Court to allow the Pursuers to apply at the Patent Office for leave to amend 25 their Specification by way of disclaimer as provided by the Patents, &c. Act, 1883, section 19. This would not prejudice the Defenders, for by section 20 of the same Act where such an amendment is allowed no damages are to be given in any Action in respect of the use of the invention before the disclaimer, correction, or explanation unless the Patentee establishes to the 30 satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge. Thus, if this Action was allowed to go on, the Pursuers must still establish that their original claim was made in good faith and was reasonable. [Lord YOUNG.—You could do that equally well in a new Action:] [Lord MONCRIEFF.—Is not an amendment of the Specification 35 a matter taking time?] What I wish to disclaim is quite an unimportant part of the Specification, but the disclaimer is necessary to me. [Lord TRAYNER.—This amendment might possibly make your Summons incompetent.]

Duncan Millar (instructed by *J. McG. Jack, S.S.C.*) for the Defenders was not called on. 40

The LORD JUSTICE CLERK.—In this case I think the Lord Ordinary has taken the proper course. Besides I do not think that it would be wise to interfere with his discretion in such circumstances unless upon very strong grounds.

Lords YOUNG, TRAYNER, and MONCRIEFF concurred.

Duncan Millar for the Defenders asked for expenses as between agent and 45 client—the Defenders, the *Edinburgh and Leith Corporations Gas Commissioners* being a public authority, and entitled to costs on that footing.

Lord TRAYNER.—Only when they have been challenged in the exercise of their public functions. The infringement of Patents in the manufacture of gas is not a case of that sort. It does not arise out of the exercise of public duties. 50

The Court gave expenses as between party and party.

Boord & Son v. Huddart.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE SWINFEN-EADY.

November 10th, 11th, 12th, 13th, 14th, and 15th, and December 21st, 1903.

BOORD & SON v. HUDDART.

5 *Trade Mark.—Action for infringement and to restrain passing off.—Reputation acquired under words descriptive of a Trade Mark.—Injunction granted with costs, but no inquiry as to damages, as the Defendant's sales were so small.*

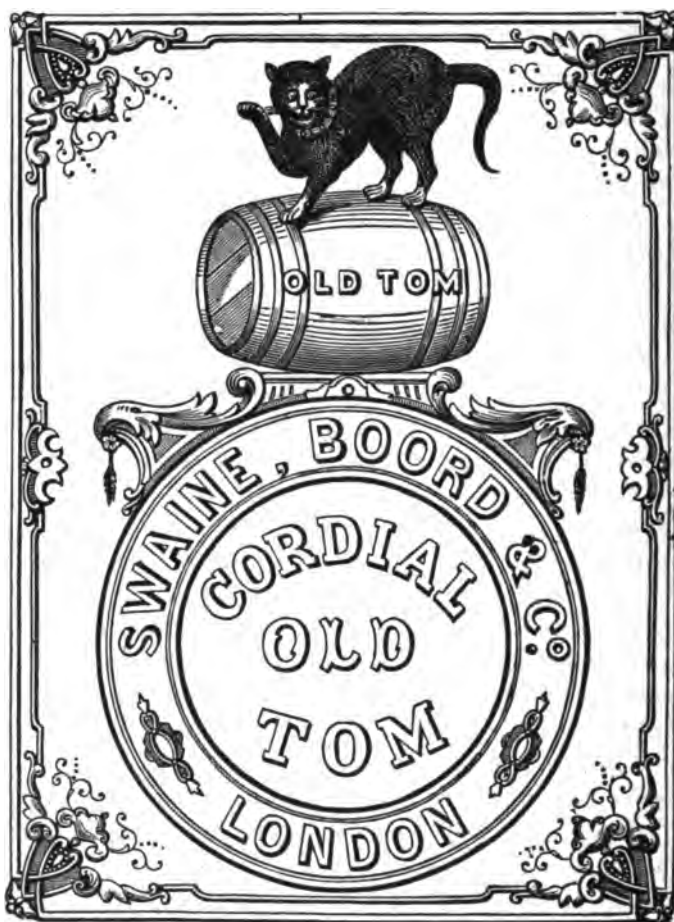
B. & S. (the Plaintiffs), distillers and wine and spirit merchants, registered in 1879 a Trade Mark (No. 20,505 in Class 43) for fermented liquors and
10 *spirits, including liqueurs, as having been used for 25 years prior to 1879. The mark comprised a cat with one paw uplifted standing on a barrel placed on its bilge. Sweetened gin, one of the articles sold by them, had long been known as "Old Tom," and with the mark they associated those words. In addition to selling gin they in 1893 began to sell a liqueur called "Sloe Gin"*
15 *under their mark with suitable letterpress. The Defendant H., in November 1899, commenced to sell sloe gin under a label containing thereon a cat looking out of a barrel with the words "Cat Brand" on a scroll underneath it. No manufacturer's name appeared on the label, but there were the words, "Specially prepared*
20 *and bottled for A. C. Huddart." H. obtained the article bottled and labelled from M. D. & Co. M. D. & Co., in response to a letter of complaint addressed to H., accepted the responsibility, gave H. an indemnity, claimed that the label complained of was their ordinary label used by them in their trade since 1876, and that it had been adapted for sloe gin by the addition of suitable letterpress. In 1887 M. D. & Co. had applied to register a Trade Mark consisting of a cat*
25 *and barrel. The application was refused on the ground that the mark was calculated to deceive. They, however, continued to use the mark, and placed upon their label the word "Registered." It was suggested by them, in answer to Plaintiffs' inquiries, that this meant copyright registered. No registration, however, anterior in date to the 4th of February 1899 was produced at the trial.*
30 *M. D. & Co., who were not Defendants, sought to prove that a cat and barrel label was common to the spirit trade, and that the Plaintiffs, with knowledge of its use, had not been vigilant. They contended also that at the date of registration the Plaintiffs did not manufacture "Sloe Gin," and that they could not claim the exclusive use of the mark for all articles in the class. The Plaintiffs contended*
35 *that M. D. & Co.'s user had been acquired in fraud of them by the use of the word*

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"Registered"; that there was no satisfactory evidence of the user of similar marks; and claimed that they (the Plaintiffs) had acquired an exclusive reputation for goods of the same description as gin under the designation "Cat Brand" or "Cat and Barrel Brand."

Held, that the label complained of was an infringement of the Plaintiffs' registered Trade Mark, and also was calculated to mislead and to induce the belief that goods so labelled were the manufacture of the Plaintiffs. An injunction was granted with costs, but no inquiry as to damages, the Defendant's sales being so small.

In 1879 Sir Thomas William Boord registered under No. 20,505 in Class 43, for fermented liquors and spirits—namely, wine, whisky, and liqueurs—the subjoined Trade Mark. This Trade Mark was registered as an old mark, user for 25 years being claimed.



On the 13th of August 1902 *Boord & Son* commenced an action against *A. C. Huddart*.

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By the Statement of Claim the Plaintiffs stated that—(1) They were the registered proprietors of a Trade Mark (No. 20,505) registered in Class 43 for fermented liquors and spirits, including liqueurs, in 1879, as having been used for 25 years before that date. (2) They and their predecessors in business had carried on the business of wine and spirit merchants, distillers, manufacturers, and sellers of fermented liquors, spirits, and liqueurs for upwards of 150 years, and they relied upon a user from 1850 by the Plaintiffs and their predecessors. All these persons, including the Plaintiffs, had for a great number of years manufactured, sold, and advertised for sale gin and liqueurs as well as other fermented liquors and spirits, and had acquired a great reputation for the same respectively under and in connection with their Trade Mark and under and in connection with a certain label, of each whereof an important essential and prominent feature was the representation therein of a cat and of a barrel. (4) The fermented liquors, spirits, and liqueurs, including "Sloe Gin" and other goods of the Plaintiffs' manufacture and sale, had become known to the purchasers and intending purchasers as the "Cat and Barrel Brand" and the "Cat Brand" of fermented liquors, spirits, and liqueurs, including "Sloe Gin" and any such goods or merchandise advertised or sold under or in connection with the Trade Mark or label or as or of the "Cat and Barrel Brand" or the "Cat Brand" had become known to and were identified by traders and the public as goods of the Plaintiffs' manufacture or merchandise, and the words "Cat and Barrel Brand" were commonly used to indicate the Plaintiffs' goods, and the words "Cat Brand" were also commonly used and known to indicate the Plaintiffs' goods. (5) The Plaintiffs had lately discovered that the Defendant was selling and advertising for sale "Sloe Gin" (a liqueur) not of the Plaintiffs' manufacture or merchandise under or in connection with an alleged Trade Mark or label bearing a representation of a cat and a barrel with the words "Cat Brand" in prominent letters under or otherwise in connection with such representation. (6) By the said acts the Defendant had wrongfully obtained and would obtain for himself and had traded and would trade upon the reputation of the Plaintiffs, and had passed off and would pass off the "Sloe Gin" sold by the Defendant, not being of the Plaintiffs' manufacture or sale, as and for goods of the Plaintiffs' manufacture or sale. (7) The user of the said representation of a cat and a barrel and of the words "Cat Brand" in connection therewith was misleading and calculated to deceive purchasers into the belief that they were being offered and were purchasing "Sloe Gin" of the Plaintiffs' manufacture or sale. (8) The Defendant had intended, or, alternatively, must be taken to have intended, the said passing off and deceit in the two preceding paragraphs mentioned. (9) The said acts of the Defendant respectively were an infringement of the Plaintiffs' registered Trade Mark. (10) The Plaintiffs had been greatly damaged in their trade and reputation by the wrongful acts of the Defendant. They claimed—(1) An injunction to restrain the Defendant, his agents and servants, from infringing the Plaintiffs' registered Trade Mark. (2) An injunction to restrain the Defendant, his agents and servants, from selling, offering for sale, passing off, or attempting to pass off, or enabling others to pass off "Sloe Gin" not of the Plaintiffs' merchandise or manufacture as and for the goods and merchandise of the Plaintiffs in any way whatsoever, and in particular by using the words "Cat Brand" in connection with the representation of a cat and barrel or otherwise, or using the representation of a cat and barrel, or any words or a word, or signs or a sign, figures or a figure, devices or a device, which were calculated to enable the Defendant's "Sloe Gin" or other liqueurs or goods of the Defendant to be passed off as or for the goods of the Plaintiffs. (3) Delivery up of labels, &c. (4) An account of profits or damages; and (5) Costs.

By his Defence the Defendant stated that (1) he did not admit any of the statements contained in paragraphs 1 and 2 of the Statement of Claim, save and except that the Plaintiffs were then selling gin under a label which comprised,

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with other matter, a representation of a cat on a barrel. (2) He denied that any goods of the Plaintiffs had become or were known to anyone as "Cat and Barrel Brand," or "Cat Brand," and he denied that any such goods sold under any such brand had become or were in any way identified with the Plaintiffs. And he denied that the words "Cat and Barrel Brand," or "Cat Brand," were commonly or at all used or known to indicate the Plaintiffs' goods. (3) Gin (which was the spirit to which the action related) had from time immemorial been commonly described and spoken of as "Old Tom," and by reason thereof the representation of a cat (sometimes with and sometimes



without a representation of a barrel) had for many years past been, and the same was, in common and general use in the spirit trade, and in particular in the gin trade, and many of such Trade Marks had been actually registered. The designations of "Cat and Barrel Brand" and "Cat Brand," which the Plaintiffs claimed, were not and could not be exclusively indicative of their goods. If the Plaintiffs were entitled to the representation of a cat on a barrel which they were using (which the Defendant did not admit), they were not entitled to any other representation thereof than such as they were actually using, nor to any name derived therefrom. (4) The Defendant was selling and advertising

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for sale "Sloe Gin," not of the Plaintiffs' manufacture or merchandise, under a label bearing a representation of a cat's head with the upper part of a barrel and the words "Cat Brand," and claimed to be entitled so to do in common with the trade generally. (5) He denied that by anything he had done or was doing he had wrongfully obtained or would obtain for himself, or had traded or would trade upon the reputation of the Plaintiffs, or had passed off or would pass off any "Sloe Gin" sold by him as or for any goods of the Plaintiffs. (6) The user of the device and words aforesaid was not misleading, nor calculated to deceive anyone into the belief that he was being offered or was purchasing "Sloe Gin" of the Plaintiffs. (7) The Defendant did not intend, and ought not to be taken to have intended, any passing-off or deceit whatsoever. (8) Nothing that the Defendant had done was an infringement of the Plaintiffs' Trade Mark. No two labels on which any representation of a cat, or part of a cat appeared, could well be more different than the labels of the Plaintiffs and the Defendant respectively were from one another, and the Plaintiffs were not entitled to all cat devices, nor to any name derived therefrom. (9) The Plaintiffs had sustained no legal damage by reason of anything that the Defendant had done, and the action should be dismissed with costs.

A representation of the Defendant's label appears on page 152.

20 The action came on for trial on the 10th of November 1903.

Moulton, K.C., Eve, K.C., and Israel Davis (instructed by *Halse, Trustring & Co.*) appeared for the Plaintiffs; *Warnington, K.C., Scrutton, K.C., and Sebastian* (instructed by *Farlow and Jackson*) appeared for the Defendant.

Eve, K.C., opened the Plaintiffs' case.—The Plaintiffs are the owners of a Trade Mark the essential features of which are a cat on a barrel. "Sloe Gin" is the subject-matter of the action, and it is one of the commodities sold under the Trade Mark. The Plaintiffs' goods have become known under the designations "Cat Brand," "Cat and Barrel Brand," and "Cat on Barrel Brand." Such designations now denote their goods alone. The Defendant, *Huddart*, has been selling "Sloe Gin" not of the Plaintiffs' manufacture under a Trade Mark or label bearing a representation of a cat and barrel, together with the words "Cat Brand." Messrs. *Melrose, Drover & Co.* are really the Defendants. [Correspondence was read, wherein *Melrose, Drover & Co.* stated that they had used the label complained of for many years and had, in 1887, applied to register it.] They supplied the goods complained of to *Huddart*, and they claim the right to use the label. Their mark is not registered under the Trade Marks Act, but the word "registered" is printed on the labels. It is only the copyright that is registered. No one is, to the Plaintiffs' knowledge, using a "Cat and Barrel Brand" or mark. They have brought actions against persons using a "Cat and Barrel" mark, but the actions have never been fought out. In answer to written orders by the Plaintiffs for "Cat Brand," or "Cat on Barrel," or "Cat and Barrel" goods, the goods of Messrs. *Melrose, Drover & Co.* have been supplied.

Evidence was adduced by the Plaintiffs and the Defendant in support of the premises.

Scrutton, K.C., summed up the Defendant's case.—The Plaintiffs' mark registered in 1879 as an old mark, has been applied only to particular classes of goods in Class 43. "Sloe Gin" is the subject-matter of the action, and neither before nor after the registration has the registered mark been used by them for "Sloe Gin." The mark as used contained the descriptive words, "Cordial Old Tom." "Sloe Gin" could not have been sold under that designation. Three firms have for between 30 and 35 years been using labels containing a representation of a cat and barrel in connection with the sale of gin. The Plaintiffs have known this for considerably over a year, but have taken no steps to challenge the user except by bringing this action against one London retailer of a subsidiary product, viz., "Sloe Gin." An old mark registered as such is valid only in respect to the goods for which it has been used. The use of the mark cannot

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be extended to other goods in the class unless it is registered for the new goods. Nor can an essential portion of the old mark be applied to goods of the same class except by a new registration, for it must be the mark that is registered and not some part of it (*Edwards v. Dennis*, L.R. 30 C.D. 454; *Hargreaves v. Freeman*, 8 R.P.C. 237; L.R. 1891 3 Ch. 39; *Hart v. Colley*, 7 R.P.C. 93; L.R. 44 C. D. 193). The Plaintiffs have produced no registered Trade Mark for "Sloe Gin." [SWINFEN - EADY, J.—You say that anyone may take an essential portion of a registered mark and apply it, not to the same but analogous goods?] Yes—apart from the question of passing off. As far as Trade Mark is concerned, the cat and barrel can be applied to any article in Class 43 for which the old mark has not been used by the Plaintiffs. [SWINFEN-EADY, J.—You could take all the mark with the exception of the descriptive words and use it for dry gin?] Yes; in *Hargreaves v. Freeman* the whole mark was taken, and was used for cigars instead of cut tobacco. There cannot be a prospective claim for all the goods in a class. The use of the picture of a cat is common to the trade, and six firms used a picture of a cat and barrel before 1879. To constitute infringement there must be a close imitation and reproduction of the Plaintiffs' particular arrangement (*Orr-Ewing v. Registrar of Trade Marks*, L.R. 4 App. Cas. 479, 486, per Lord Cairns). If all the six firms had gone before the Registrar in 1879 he would have said, "These are substantially the same, and none can register the mark as an old mark," or "You all have the cat and barrel, but each may register a distinctive arrangement." As to passing off, representations of cats and portions of cats are common to the trade. The Plaintiffs' claim that their goods are known under the designations of "Cat Brand," and "Cat and Barrel" and "Cat on Barrel" brands. But such a phrase as "Cat Brand" is merely descriptive of a mark anyone may use. The most overwhelming evidence is required to satisfy the Court that a trader has a monopoly of the use of words descriptive of brands or marks. The Chinaman or African may forget everything except the cat, and in that case could there be passing off? This is an attempt to obtain a monopoly of a truly descriptive term (*Cellular Clothing Company v. Maxton and Murray*, 16 R.P.C. 397; L.R. 1899, App. Cas. 326), and in that case *Reddaway v. Banham*, 13 R.P.C. 218; L.R. 1896 App. Cas. 199, was distinguished. The use of a phrase which also describes the mark is the same in principle as the use of a phrase which describes also the nature of the goods or their geographical origin. A trader has the right to make an article of a particular description and sell it under that description. Also to make and sell an article coming from and described by reference to a particular district (*Whitstable Oyster Fishery Company v. Hayling Fisheries, Ltd., and George Tabor*, 18 R.P.C. 434). The words "Cat Brand," &c., equally describe accurately the get-up of a mark commonly used in the trade. It cannot be truly said that the mark or its description represents the goods of any particular firm. Nor could the use of the mark by persons other than the Plaintiffs mislead the public into the belief that under it they were purchasing the Plaintiffs' goods. Amongst the 130 documents put in by the Plaintiffs only one referred to sloe gin by the phrase "Cat and Barrel," and that was in 1900; and a large number of the documents mentioned simply "Cat Brand." Messrs. *Melrose, Drover & Co.*, are entitled to use a cat and barrel not colourably imitating the Plaintiffs' label. A similar mark is on the register in the names of two other people. The words "Cat Brand," the use of which is objected to, cannot be identified with the Plaintiffs' "Sloe Gin" except in relation with "Cat and Barrel," and there cannot be such an identification in view of the number of people using the "Cat and Barrel." The evidence shows that persons in the trade are not deceived, and there is no evidence sufficient to show that other persons would be deceived. No suggestion has been made of deception by the retailer, as suggested in *Payton & Co. v. Snelling* (17 R.P.C. 48; L.R. 1901, App. Cas. 309). If the Plaintiffs may not have a monopoly of the figures of

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a cat and barrel they may not monopolise the words "Cat Brand," or "Cat and Barrel" (*Wills's Trade Mark*, 10 R.P.C. 269; L.R. 1893, 2 Ch. 262). The Defendant's label has been in use for ten years. It originated in 1893, when *Melrose, Drover & Co.* adapted for the purpose a label that had been in use for
 5 15 or 16 years. Unless the Plaintiffs have a reputation for every sort of representation of a cat and barrel there is no case of passing-off. The evidence does not establish this. Nor does it establish that they have a reputation for every kind of liquor in the class sold under "Cat," or "Cat and Barrel Brand." In view of the marks on the Register the strongest evidence is required to establish
 10 such a reputation.

Sebastian followed.—The evidence shows that by reason of the extraordinary differences between the labels in question no one who knew the Plaintiffs' label could mistake the Defendant's for it. It is not possible for anyone to be deceived. The Plaintiffs have not shown that any member of the public has
 15 known the Plaintiffs' goods as either of the "Cat" or "Cat and Barrel" brand, and no one in the trade or out of the trade has been shown to have known *Boord's* "Sloe Gin" under either designation. He cited, in addition to the cases already referred to, *In re Trade Mark of La Société Anonyme des Verreries de L'Etoile* (11 R.P.C. 142; L.R. 1894, 2 Ch. 26); *In re Trade Mark of John Dewhurst & Sons, Ltd.* (13 R.P.C. 288; L.R. 1896, 2 Ch. 137); *In re Worthington & Co.'s Trade Mark* (L.R. 14 C.D. 8).

Eve, K.C., in reply.—The issue is one of fact, namely—Have the goods of the Plaintiffs become known or distinguished by the appellations "Cat Brand" or "Cat and Barrel Brand?" The Defendant relies upon the parentage of the label,
 25 but on that the evidence is not satisfactory. The evidence disproves that the label as used by *Melrose, Drover & Co.* had been in use for "Sloe Gin" ten years prior to 1899, at which date the Defendant first stocked "Sloe Gin." That a similar label other than the Plaintiffs' had been in use for 30 years is doubtful, and the evidence as to labels other than the Plaintiffs' is not satisfactory. There has
 30 not been such a wide user of them as to attract the notice of persons moving about in the localities whence the labels emanated. There is no evidence that any other person's gin was spoken of as "Cat Brand" or "Cat and Barrel Brand." Such an appellation was not applied to any of the marks referred to in the evidence. It is no answer that there are the goods of somebody else to which
 35 the phrase might have been applied. The answer to the Defendant's user is that it has been in fraud of the Plaintiffs. They have had the word "Registered" on a mark not registered as a Trade Mark (*Paine & Co. v. Daniell & Sons' Breweries*; *In re Paine & Co.'s Trade Mark*, 10 R.P.C. 217; L.R. 1893, 2 Ch. 567). By the use of this label they have filched away the Plaintiffs'
 40 trade. In the absence of the label of Messrs. *Melrose, Drover & Co.'s* the Defendant's case would be, "In 1899 I put on the market a product of gin, "selected a label consisting of a representation of a cat and barrel, and affixed "to that label the description "Cat Brand." But since 1893 "Sloe Gin" has been identified with the Plaintiffs' label. The identification of the source
 45 of the article is that which is important to the trader. The reputation grows up in respect not of particular goods, but in respect of goods from a particular source. When the goods of a trader have become identified with a particular appellation it is not necessary for him to establish for each item of his goods that it has in fact become separately known by the appellation.
 50 "Sloe Gin" is a by-product of gin to which the reputation had already attached. Messrs. *Boord* are entitled to claim for "Sloe Gin" the reputation which has attached to their gin and gin products. They are goods of the same description (*In re Australian Wine Importers, Ltd.*, 6 R.P.C. 311; L.R. 41 C.D. 278). As to the use of a Trade Mark for goods for which the mark has not been registered see
 55 *Jay v. Ladler* (6 R.P.C. 136; L.R. 40 C.D. 649). Any person asking for "Cat Brand" or "Cat and Barrel Brand" goods would be taken to refer to the device on the Plaintiffs' label for gin, and such person would expect to be supplied with

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their goods (*Johnston v. Orr Ewing*, L.R. 7 A.C. 219). Upon Trade Mark it is said that the Trade Mark, as registered, contains the words "Old Tom" and "Cordial Old Tom," and that if the Defendant uses the Trade Mark omitting those words they are not infringing the Trade Mark, and that the Plaintiffs have no Trade Mark except with those words. In respect of goods other than gin the Plaintiffs have altered the wording on the mark as registered, and seek to protect, by virtue of the registration, a mark which includes the greater portion of the Trade Mark, although not an exact reproduction. It is not necessary, in order successfully to maintain an action for an injunction, that that which you are using should be an exact reproduction of the whole device (*Melachrino & Co. v. Melachrino Egyptian Cigarette Company and Melachrino*, 4 R.P.C. 221). The registration shows that it was registered for a wider class of articles than "Old Tom." The Plaintiffs are entitled to restrain the Defendant from using the mark in respect of any goods for which the old mark was registered, and the mark extends to "Sloe Gin."

Judgment was reserved, and was delivered on the 21st of December 1903.

SWINFEN-EADY, J.—The Plaintiffs are a very old-established firm of distillers and wine and spirit merchants, and they claim an injunction to restrain the Defendant from infringing their registered Trade Mark, and from passing off goods, not of their manufacture, as and for their goods.

The business was a very old one—something like a century old—in 1840, when a Mr. Boord was admitted a partner, and in 1847 the name of the firm was *Swaine, Boord & Co.* In the year 1848 an Act was passed enabling spirits to be exported on drawback (11th and 12th Victoria cap. 122), and this fact and the development of the Australian Colonies led the Plaintiffs to believe that an export trade of spirits and liqueurs to the Colonies would be profitable; and therefore they commenced their export trade which they have continued ever since. In connection with this trade, they determined to adopt a Trade Mark for their goods, and they chose as the mark a cat with one paw uplifted standing on a barrel placed on its bilge, which they have ever since used. This mark was adopted in or about the year 1849. The Plaintiffs' firm were ridiculed at the time for adopting the cat on a barrel, and for associating the words "Old Tom," by which sweetened gin had long been known, with a cat. Mr. Beckwith left the firm in 1866, down to which date no other firm were using the cat and barrel to his knowledge. Mr. Beckwith was with the firm when they adopted the cat for "Old Tom." The precise origin of the term "Old Tom" as applied to sweetened gin is lost in obscurity. *Charles Dickens* in "Sketches by Boz" refers to casks bearing such inscriptions as "Old Tom," and, long previous to that publication, the expression was well known. In one of the early gin labels on the cover of the exhibit E.S.B. 2, the figure of "Old Tom" appears as a human being; but, whatever the origin of the expression, the Plaintiffs have established that they were the first persons to connect the words "Old Tom" with a cat. Mr. Syndercombe, who was with the Plaintiffs' firm when the device was adopted, says that the reason for its adoption was that there was a tradition in the distillery that a cat had fallen into one of the vats—No. 4—and the gin from that vat was always highly esteemed. Mr. Syndercombe, who went to the Plaintiffs' firm in 1849, was previously with *Tanner, Sinclair & Co.*, distillers of Lambeth, and was familiar with their "Old Tom," but neither there nor in any other distillery was "Old Tom" associated with a cat, until, as he says, Mr. Joseph Boord originated it in or about the year 1849. This Mr. Boord died in the year 1875. This witness was also able to identify the label referred to in an entry in the bought ledger of the 28th of September, 1849, as the first printing of the "Cat and Barrel" label. Since this date the "Cat and Barrel" label has been used continuously by the Plaintiffs' firm. A bundle of five Price Lists was produced by Mr. Beckwith (marked E.L.B. 4) which were in use in the years 1863, 1864, 1865 and 1866 respectively. In the first Price List, the "Bottled Cordials" are seven in number. The first is, "No. 1 Old Tom,

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"bottled, labelled, capsuled, &c., as for exportation." The next is "Juniper Cordial, ditto," which means "Juniper Cordial, bottled, labelled, capsuled, &c., as for exportation." Then follow "Orange Bitters, ditto," "Ginger Brandy, ditto," "Imperial Brandy, ditto," "Royal Highland Whisky, ditto," and "Islay Malt Whisky, ditto." Thus these beverages, including brandy and whisky, were described as early as the year 1863 as "Cordials," and were offered by the Plaintiffs for sale in bottles, and with labels, capsules, &c., as for exportation; that is, with the "Cat and Barrel" label. In 1866, "Dry Gin"—that is, unsweetened gin—and "Pure Irish Malt Whisky" are added to the list of bottled cordials, "bottled, labelled, capsuled, &c., as for exportation."

Other persons appear to have copied the Plaintiffs, and to have applied the figure of a cat's head, or of some part of a cat, or the whole figure of a cat, to gin. When this practice first commenced does not appear. In the collection of labels made by Mr. *E. S. Boord* many years ago, and marked E.S.B. 2, there is no label in the least like the Plaintiffs' "Cat and Barrel" label, nor any label with any portion of a cat. But gradually a cat was adopted by various traders, and by the time the Plaintiffs applied, namely, in 1879, to register their "Cat and Barrel" mark, under the Act of 1875, a cat alone—that is, without any barrel—had become common to the trade. The Plaintiffs registered their mark in 1879 in Class 43 for fermented liquors and spirits, namely, wine, whisky, and liqueurs, as an old mark used by the Applicants and their predecessors in business for 25 years.

There are two other "Cat and Barrel" marks on the Register in the same class. One is Messrs. *Bernard & Co.*'s of Leith, No. 5716, registered on the 15th of May, 1876, consisting of a shield supported by dragons, and having a cat and barrel on the shield, the whole surmounted by a demi-bear muzzled, user of the mark claimed being for one year and four months previously. This label appears to have been used scarcely at all in England. Mr. *D. H. Campbell*, cashier with Messrs. *Bernard & Co.*, said that practically all the gin they send to England is sent in bulk, and that they do not supply labels with this gin; that although the label is still in use, they only use it for "Old Tom" gin, for which they also have another label without any cat and barrel. Mr. *John Peters* of Leith was the only witness who spoke to having seen Messrs. *Bernard's* registered label in use. The other registered mark is that of Mr. *D. N. Abbott* (formerly *Barker & Son*), No. 8656, registered in 1876, consisting of a barrel and three cats, one on the barrel and the other two on the ground. This was registered as a new mark, and no user of it in this country took place so far as shown by any evidence in this case.

The Plaintiffs' goods are well known in the market, and frequently referred to and ordered as "Cat and Barrel Brand," or "Cat Brand"; and the Plaintiffs themselves are frequently referred to as the "Cat and Barrel People." The Plaintiffs called evidence of other distillers, of merchants in the wholesale trade, of export merchants, and of travellers, who proved the reputation of the Plaintiffs' goods under the name of "Cat and Barrel" or "Cat Brand"; and, indeed, the evidence on this part of the case is almost entirely one way. And, considering the length of time for which the Plaintiffs have used their "Cat and Barrel" Trade Mark, it would be surprising if it were otherwise.

The Defendant has recently—that is to say, in November 1899—commenced to sell "Sloe Gin" under a label containing thereon a part of a cat, and a part of a barrel, with the words "Cat Brand" underneath it. He obtains this article bottled and labelled from *Melrose, Drover, Ltd.*, of Leith. Upon the Plaintiffs complaining to Mr. *Huddart*, the Defendant, he sent on their complaint to *Melrose, Drover, Ltd.*, who replied to it and accepted the whole responsibility in the matter and said that they should defend Mr. *Huddart*. This firm, it is admitted, is defending the action, having agreed to give the Defendant an indemnity, and it is claimed that the label on the "Sloe Gin" in

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question is *Melrose, Drover, Ltd.*'s ordinary label, used by them in their trade, and adapted for "Sloe Gin" by the addition of suitable letterpress.

It appears that *Melrose, Drover & Co.*, and their predecessors were customers of the Plaintiffs down to the 8th of November 1878, and dealt in the Plaintiffs' gin, and were familiar with the Plaintiffs' label. *Mr. C. B. Drover*, who gave 5 evidence, joined the firm in 1875, and the name was then changed from *Melrose, Dickson & Co.* to *Melrose, Drover & Co.* He said that, shortly after he joined, the firm changed the nature of their trade, and started to manufacture, and determined to adopt a new label for themselves. He said that their object was to have a label which should not bear the shadow of a likeness to any 10 other. I cannot reconcile this with what they did, because having the Plaintiffs' label before them, and intending to discontinue purchasing from the Plaintiffs, and to sell goods of their own manufacture, they determined to adopt a cat and barrel as their own label. *Mr. Drover* said that they obtained, for the purpose of their new label, a photograph from a Brighton photographer of a cat put in a hamper, and adapted that; but the hamper disappears, and a barrel is substituted for it in the label. No satisfactory explanation is given of this change and the obvious reason was to approximate as closely as possible to the Plaintiffs'. Messrs. *Melrose, Drover & Co.* subsequently, in October 1887, 15 applied to register their label, but registration was refused by the Comptroller, one of the grounds of his refusal being that it was too close to the Plaintiffs' registered Trade Mark and calculated to deceive. It appears from the file of proceedings that in the notice of objection sent from the Comptroller's office, *Melrose, Drover & Co.* were referred to the Plaintiffs' Trade Mark already on the Register. Messrs. *Melrose, Drover & Co.* did not appeal from the Comptroller's decision, but nevertheless proceeded to use their proposed mark as their Trade Mark, and as their ordinary and standard label. They also placed and used the word "Registered" upon this label. When the Plaintiffs asked for an explanation of the use of the word "Registered," *Melrose, Drover & Co.* 20 stated that the word meant that the copyright had been registered. Even this was untrue, as no registration of copyright anterior in date to the 4th of February 1899, has been produced. *Mr. Drover* said that he had other labels than the Plaintiffs' before him when designing their new label, and instanced *Thom & Cameron's* labels. The secretary of that Company, *Mr. J. M. Nichol*, was called as a witness and produced a book (exhibit J.M.N. 1) containing their labels, and 25 many of these appear to be close approximations to the Plaintiffs'. Indeed the label appearing on the 22nd page of the book (which has a printed leaflet immediately beneath it) is an obvious copy of the Plaintiffs' label, with the addition of two barrels beneath that, on which the cat is represented with uplifted paw. *Melrose, Drover, Ltd.*, have not, in my opinion, honestly 30 tried to take a label as different from the Plaintiffs' as possible, as they alleged, but have taken one as closely resembling the Plaintiffs' label as they dared to go, and have persisted in using it, with the word "registered" upon it, after the registration of it had been refused for the reason already mentioned. When *Melrose, Drover, Ltd.*, on the 12th July 1902, sent to the Plaintiffs a specimen of 35 their label with the word "Registered" upon it (namely, the exhibit C.B.D. 4), the label so enclosed contained a cross against the word "Registered," and the addition in ink of the words "Copyright Registered." *Mr. Drover* was pressed in cross-examination about this, and as to whether the reason for putting this note was not that, without it, it would imply that the Trade Mark was registered 40 under the Trade Marks Act, and, after stating that it was quite possible that it might be so understood, sought to shield himself from answering further by alleging that he was abroad when the label was so sent to the Plaintiffs. This answer turned out to be absolutely untrue, and the very letter enclosing that label with the words "Copyright Registered" is signed by *Mr. Drover* himself. 45 Such conduct cannot be justified. The observations of Lord Justice *Lindley* in *Paine v. Daniell* (L.R. 1893 2 Ch., at page 579),* are much in point in such a case. 50 55

* 10 R.P.O. 217.

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Section 105 of the Trade Marks Act, 1883, makes such conduct illegal and enacts that for every offence the offender shall be liable on summary conviction to a fine not exceeding five pounds. Moreover, the use by *Melrose, Drover, Ltd.*, of the "Cat and Barrel" label, with the word "Registered" upon it, is a disparagement of the Plaintiffs' mark as registered; and the use by the Defendant *Huddart* of the "Cat and Barrel" label in question, with the words "Cat Brand" in prominent type, is not only an infringement of the Plaintiffs' Trade Mark, but is also calculated to mislead the public, and induce the belief that the goods in question are the manufacture of the Plaintiffs. There is not any name of a manufacturer on the Defendant's label complained of, but the words appear, "Specially prepared and bottled for *A. C. Huddart*," and persons may well believe that the firm who specially prepare and bottle the liqueur in question are the Plaintiffs, whose "Cat and Barrel" mark is so well known, especially as the word "Cat Brand" appear so prominently on the label. When Mr. *Drover* was pressed about the use of the words "Cat Brand," he said that, as a cat mark was common to the trade, the words "Cat Brand" would not identify any sloe gin, or any particular brand or mark of sloe gin, and that there was nothing on the label in question to indicate the manufacturer beyond the "Cat and Barrel" mark. In my judgment *Melrose, Drover, Ltd.*, have not been acting innocently in the matter; the user of the words "Cat Brand" on the label, in connection with the "Cat and Barrel" mark, is only another attempt on their part to approximate to the Plaintiffs' Trade Mark and trade description. I am of opinion that the label in question is an infringement of the Plaintiffs' registered Trade Mark, and is certainly calculated to mislead, and to lead to the belief that goods so labelled are of the Plaintiffs' manufacture.

It was alleged that *Melrose, Drover, Ltd.* had used their "Cat and Barrel" mark (although without the words "Cat Brand") since about the year 1876, and had advertised it in *Ham's Year Book* from 1885, and that the Plaintiffs must have known of this user. Upon the evidence, I arrive at the conclusion that the Plaintiffs have certainly not known of it, but brought these proceedings immediately upon its coming to their knowledge; and I am by no means satisfied that *Melrose, Drover, Ltd.* have used the label for the length of time alleged. *Melrose, Drover, Ltd.* have placed themselves practically in the position of Defendants, and have actively defended this action, but they are not formal Defendants, and have not come under any obligation to make discovery of documents. Mr. *Drover* attended and gave evidence, but did not bring with him any of the books of business of his firm, or any written documents by which his recollection of the date when his firm began to use the "Cat and Barrel" label could be tested. In any case, the label has been used mostly in Scotland and Ireland or abroad, and not in this country to any material extent, and has not come to the notice of the Plaintiffs or their travellers.

With regard to other "Cat and Barrel" labels alleged to have been used, but not registered, the evidence is unsatisfactory. The witnesses differ in their recollection as to which label *Thom and Cameron* used in 1876; there is no writing produced to fix any date; and if *Thom and Cameron* used the "Cat and Barrel" mark in 1876, why did they alter it and use a label with a cat, bottle and glass on the barrel? Evidence of user by *Thom and Cameron* fails. Again, with regard to *Mackenzie*, afterwards *Peter Macdonald*, there is no confirmation of the statement that the label was used in 1865; no documentary evidence to confirm the recollection of *Peter Macdonald*; and *Drover* did not apparently know of *Peter Macdonald's* when preparing his own label. The evidence altogether fails to establish that the "Cat and Barrel" label is common to the trade, and the various proceedings instituted by the Plaintiffs show that they were vigilant to restrain the use of it when user came to their knowledge.

It was urged that the Plaintiffs did not manufacture "Sloe Gin" at the date of the registration of their Trade Mark in 1879, and that a trader cannot, by merely

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registering a Trade Mark for an entire class, and yet using it only for certain articles in the class, claim the exclusive right to use it for every article in the class and restrain other traders from so using it, and reliance was placed upon *Edwards v. Dennis* and *Hargreaves v. Freeman*. True it is, that where the Plaintiff dealt only in iron sheets, and the Defendant exclusively in steel wire, the Court held that it was impossible that the public could be led into any mistake. And Mr. Justice Chitty followed this case in *Hargreaves v. Freeman*. But in *Edwards v. Dennis* all the Lords Justices pointed out the substantially different character of the goods made by the Plaintiff and Defendant respectively. When the Summons came before Vice-Chancellor Bacon he said: "If I were to listen to the argument addressed to me on behalf of Mr. Edwards, a man who deals in gold and stamps gold watch cases would be restricted from using this Trade Mark, because a man who makes sheet iron has already registered the Trade Mark." In the Court of Appeal, Lord Justice Lindley, at page 476, said: "When, therefore, Mr. Edwards got himself registered as proprietor of this Trade Mark, it is perfectly preposterous to say that he thereby acquired any right to bring an action against a person, say a goldsmith, who may manufacture goods of a kind entirely distinct from that which he himself manufactures." And he further pointed out that the Act meant that the mark was to be registered "in connection with the particular trade in respect of which the person registering desires to use it." It follows from the decision on the Summons, that after Edwards' mark had been confined to iron sheets, this registration would not have prevented Dennis from registering a similar mark for steel wire, although in the same class. Dennis in fact established his right to the mark which he had registered. The Plaintiffs have used their registered Trade Mark for sweetened gin, and, without the words "Cordial Old Tom," for dry gin, and for ginger brandy and other liqueurs. In the present case, instead of the goods sold by Plaintiffs and Defendant respectively being substantially of a different character they are of the same character. The Plaintiffs began to sell the liqueur called "Sloe Gin" in 1893, but had previously used their registered mark for sweetened gin, and, without the words "Cordial Old Tom," for dry gin, and for ginger brandy and other liqueurs, or alcoholic preparations flavoured and sweetened. Although the Defendant only began to sell "Sloe Gin" in November 1899, *Melrose, Drover, Ltd.*, began to do so in 1893, the same year as the Plaintiffs; they also deal in spirits and liqueurs, and, having regard to the Plaintiffs' registration, it is clear from the case of the *Australian Wine Importers, Ltd.*, that *Melrose, Drover, Ltd.*, could not have registered their "Cat and Barrel" mark for "Sloe Gin," even if the Plaintiffs had not, down to the date of their application, dealt in "Sloe Gin" at all.

Some questions were put to Sir Thomas William Boord, with a view of showing that registration was obtained upon a Statutory declaration which was inaccurate. Even if there were any error in the Statutory declaration, it is clear that in the present proceedings, I can only have regard to the Trade Marks Register where the mark is duly registered in Class 43 for fermented liquors and spirits.

The result is that the Plaintiffs have established their case, and there must be an injunction as prayed, and the Defendant must pay the costs of the action. I do not grant any inquiry as to damages, as the Defendant *Huddart* is the only Defendant on the record, and he has only dealt in a very small quantity of "Sloe Gin" labelled in the manner complained of.

Dunlop Pneumatic Tyre Company, Ltd. v. North British Rubber Company, Ltd.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BYRNE.

November 14th, 18th, 19th, and 26th, and December 3rd and 4th, 1903.

IN THE COURT OF APPEAL.

5 *Before LORDS JUSTICES VAUGHAN WILLIAMS, STIRLING, and COZENS-HARDY.*

March 1st, 1904.

DUNLOP PNEUMATIC TYRE COMPANY, LD. v. NORTH BRITISH
RUBBER COMPANY, LD.

- Patent. — Action for infringement. — Licence. — Construction. — “Use and*
10 *exercise.” — Licence whether full or limited. — Whether acts complained of were*
covered by the licence. — Goods made abroad by third persons on behalf of
Defendants. — Counterclaim for breach by Plaintiffs of agreement contained
in licence limiting the number of licences. — Plaintiffs settling with infringers,
whether a breach of agreement. — Action dismissed. — Counterclaim dismissed. —
15 *Appeal by Plaintiffs in the action dismissed.*

- A licence having been granted under Bartlett's Patent relating to pneumatic*
tyres, the owners of the Patent commenced an action for infringement
against the licensees, alleging that certain acts of the licensees were not
covered by the licence. Full licence to use and exercise the invention was
20 *granted, but certain clauses of the licence, including those relating to royalties*
and accounts, referred only to tyres manufactured and sold by the licensees;
there was also a clause prohibiting assignment or sub-licence, and a clause that
the licensees should not manufacture or sell tyres constructed according to
Welch's invention, but, subject as aforesaid, should be entitled to manufacture
25 *all forms of pneumatic tyres theretofore manufactured by them under the name*
or title of “Clincher.” The Plaintiffs contended that the Defendants had
infringed the Patent by the importation and sale of Clincher-Michelin tyres,
such importation and sale not being, as the Plaintiffs alleged, within the
licence, and they also alleged that the arrangement between the Defendants and
30 *Michelin & Co., of Paris, was such that the Defendants were in effect sub-licensing*

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Michelin & Co. They further alleged that by the clause as to Welch's Patent the Defendants were prohibited from making any tyre under Bartlett's Patent that would also infringe Welch's Patent. The Defendants contended, on the first point, that the licence was a general one and that they were entitled to purchase tyres from any person, and also that Michelin & Co. were manufacturing the tyres as their agents; and, on the second point, that an absolute licence without limitation was given to use Bartlett's invention. These points were decided as points of construction on admissions, and the Plaintiffs subsequently determined to call no evidence to show that the Welch Patent was used in the tyres complained of. The licence also contained a clause prohibiting the Plaintiffs, in events which happened, from granting more than one licence besides the licence above mentioned and one other already granted. The Plaintiffs granted a further licence, which was assigned to the C. Company, and afterwards did certain acts which, the Defendants contended, were breaches by the Plaintiffs of their agreement, and the Defendants counterclaimed in respect of the same. Such acts consisted, as the Defendants alleged, of licensing tyres in Paris for importation into this country, and of licensing in England tyres brought into this country by infringers by allowing the continued use of such tyres on payment of a royalty. The Plaintiffs contended that they were not in any way bound under the contract, which contained a special clause as to infringements, to sue for infringement, and that in the instances complained of they had only done what they were reasonably entitled to do in cases of infringement.

Held, by Byrne, J., in the action—first, that, under the licence, the tyres sold by the Defendants must be manufactured by them, but might nevertheless be manufactured for them by a third party, and that the agreement between the Defendants and Michelin & Co. was for Michelin & Co. to make as agents for the Defendants, and, further, that the arrangement did not amount to a sub-licence; and, secondly, that the Defendants might manufacture according to Bartlett's Patent, and all things that they had done previous to the licence were to be deemed to be within Bartlett's Patent, but they might not manufacture according to Welch's Patent.

Held, on the Counterclaim—first, that the Defendants had failed to connect the Plaintiffs with the acts in Paris complained of; and, secondly, that, as to the acts complained of in England, they only amounted to a fair and reasonable way of dealing with infringers.

The action and counterclaim were both dismissed with costs, including in the costs of the action given to the Defendants the costs of and occasioned by an application made by the Plaintiffs to enable them to raise the point as to Welch's Patent, which application was allowed, and any costs thrown away in consequence of it, with a set-off.

The Plaintiffs appealed (except as to the point with respect to Welch's Patent), and the Defendants served a notice that, in the event of the Court of Appeal

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reversing the judgment in the action, they would ask that the judgment on the Counterclaim might be reversed; as the Plaintiffs' appeal failed, however, the Defendants' appeal was not opened.

Held, by the Court of Appeal, that the licence was a full one, not limited, as the Plaintiffs contended, to "manufacture and sale." The judgment of Byrne, J., in the action was affirmed, Stirling, L.J., expressing the opinion also that Michelin & Co. were agents of the Defendants as held by Byrne, J. The appeal of the Plaintiffs was dismissed with costs, but the Plaintiffs were given any increased costs occasioned by the Defendants' appeal.

10 *Per* VAUGHAN WILLIAMS, L.J.—The words "use and exercise" in the grant of a licence confer, in the absence of anything limiting the construction of them, a full licence on the licensee.

In 1890 Letters Patent (No. 16,783 of 1890) were granted to *W. E. Bartlett* for an invention of "Improvements in tyres or rims for cycles or other vehicles."

15 The first claim of the Specification was as follows:—"The combination of a "grooved rim or metal tyre, and an arched tyre of india-rubber or other flexible "material held in the groove by the pressure of an inflated tube within the "arch which forces its edges against the sides of the groove, substantially as "described." The Complete Specification, together with Fig. 1 of the drawings, 20 will be found in the report of *Gormully and Jeffery Manufacturing Company v. North British Rubber Company* (15 R.P.C. 245).

On the 1st of May 1896 an Agreement was entered into between the *North British Rubber Company, Ltd.*, then the owners of *Bartlett's* Patent, which is hereinafter referred to as "the Patent," of the first part, *W. E. Bartlett*, 25 of the second part, and the *Pneumatic Tyre Company, Ltd.*, of the third part, whereby the *Pneumatic Tyre Company* agreed to buy the Patent, together with other Patents therein mentioned, for 200,000*l.* in cash, and by clause (9) the *Pneumatic Tyre Company* was concurrently with the execution of the assignment of the Patents to grant a licence to the *North British Rubber* 30 *Company* to use the Patent, and the licence was to contain the provisions in the said agreement set out. The Agreement also contained provisions with respect to the litigation then proceeding between the parties.

By a Deed dated the 23rd of July 1896, and made between the *Dunlop Pneumatic Tyre Company, Ltd.* (the assignees of the *Pneumatic Tyre Company, Ltd.*), of the first part, the *Pneumatic Tyre Company, Ltd.*, of the second part (which parties of the first and second parts were therein called the licensors), and the *North British Rubber Company, Ltd.* (hereinafter called the licensees), of the third part, after referring to the Agreement of the 1st of May 1896, and after a clause referring to other Patents, (2) in further 40 pursuance of the said agreements and in consideration of the royalty thereafter reserved or made payable, and of the covenants and agreements on the part of the licensees thereafter contained, the licensors thereby granted unto the licensees full licence under the Patent to use and exercise the invention protected by the Patent during the term of the Patent or any prolongation 45 thereof, paying therefor the royalty next thereafter mentioned. The Deed contained the following clauses (*inter alia*):—" (3) The licensees shall be entitled "to manufacture within the United Kingdom pneumatic tyres under this licence "for sale outside the United Kingdom without payment of any royalty to the "licensors or either of them, but all such tyres shall be marked before being 50 "sent out by the licensees by having the words, 'Not licensed for use in the " 'United Kingdom' or other similar words marked upon them, so as to prevent

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"the reimportation of the same into the United Kingdom by persons to whom
 "they have been sold by the licensees, but on any such sale as is intended under
 "this clause the licensees will obtain an agreement from the purchasers of such
 "tyres not to sell the same in the United Kingdom of Great Britain and Ireland,
 "and will strictly enforce the said agreement. (4) The licensees shall as from 5
 "the 1st day of May 1896, and until the licensors shall have obtained the
 "agreement mentioned in clause 5 of these presents, pay to the parties hereto
 "of the first part a royalty of 5s. per pair upon all tyres manufactured and sold
 "by them under the licence contained in clause 2 of these presents, such royalty 10
 "to be payable half yearly, and to become due and be paid at the end of two
 "calendar months after the expiration of the half year during which the same
 "tyres shall have been manufactured or sold." Clauses 6 and 7 provided for
 "keeping and rendering accounts of all tyres "manufactured and sold" by the
 "licensees. "(8) So long as the licensees shall in each year (calculated from the
 "1st day of May to the 30th day of April in the following year) sell not less 15
 "than 25,000 pairs of pneumatic tyres manufactured under "the Patent "the
 "licensors shall only be entitled to grant one licence (other than and besides
 "the licence already granted and mentioned in the third schedule hereto and
 "the licence granted by these presents) to manufacture and sell the invention
 "protected by" the Patent. "(10) The licensees shall not manufacture or sell 20
 "tyres constructed after the invention of *Charles Kingston Welch* (No. 14,563
 "of the year 1890),* but, subject as aforesaid, the licensees shall be entitled to
 "manufacture all forms of pneumatic tyres heretofore manufactured by them
 "under the name or title of '*Clincher Tyres*,' and shall be entitled to make
 "such modifications in the form of the rims and in the sections of the covers 25
 "as may be necessary to meet the public requirements and to keep up the
 "trade in '*Clincher Tyres*,' and no proceedings for infringement of the said
 "Letters Patent mentioned in the first and second schedules hereto" (which
 "included the Patent) "or of any Letters Patent the property of the licensors, or
 "either of them, shall be commenced against the licensees or any purchaser 30
 "from them in respect of any '*Clincher Tyres*' manufactured by them before
 "the 1st day of May last. (12) The licensors shall at their own expense take
 "all steps and pay all fees necessary to maintain the said Letters Patent
 "mentioned in the first and second schedules hereto during the full term for
 "which they were respectively granted, and shall after notice of infringement 35
 "commence and prosecute such actions against persons infringing the said
 "Letters Patent as in the opinion of Mr. *John Fletcher Moulton*, Q.C., and Mr.
 "Roger William Wallace, Q.C., and Mr. *Arthur James Walter*, Barrister-
 "at-Law, it is desirable or expedient to commence and prosecute. (14) The
 "licensees shall not assign or transfer the licences granted by these presents, 40
 "or either of them, to any person or Company other than their successors in
 "business or grant any sub-licence to any person, persons, or Company."

On the 26th of January 1903 the *Dunlop Pneumatic Tyre Company, Ltd.*, commenced an action against the licensees for infringement of the Patent.

The Plaintiffs by their Statement of Claim alleged that they were the owners 45
 of the Patent, and that the Defendants had infringed the same, and claimed an
 injunction to restrain the Defendants from infringing the Patent by the manu-
 facture, sale, or offering for sale of *Clincher-Michelin* tyres, and other relief.

The Particulars of Breaches alleged—(1) that the Defendants had infringed, 50
 and by advertisements, circulars, and the continuous offer for sale threatened
 to infringe the Patent by making, selling, and offering for sale *Clincher-*
Michelin tyres and parts thereof made in accordance with the invention claimed
 in the Patent; (2) that the Plaintiffs complained of the importation into

* The Specification is set out in the report of *Pneumatic Tyre Company, Ltd. v. Leicester Pneumatic Tyre, & Co., Company*, 16 B.P.C. 551.

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this country from abroad and of one offer for sale and sale by the Defendants of a tyre marked and called by the Defendants and known by the name of the "*Clincher-Michelin*" tyre; (3) that the Defendants on the 24th day of February 1903 sold to *M. S. Foley*, of Meadow Street, Manchester, Lancashire, a pneumatic tyre not of the Plaintiffs' manufacture made in accordance with the inventions claimed in all the claiming clauses of the Patent.

The Defendants by their Defence and counterclaim (stating it shortly)—(1) denied infringement, and alleged that the acts of which complaint was made were done by the Defendants under the licence of the Plaintiffs as thereafter appearing; (2) stated the licence; (3) that by the licence it was provided that the Plaintiffs should (in certain events which had happened) only be entitled to grant one further licence to manufacture and sell the invention protected by the Patent; (4) that by the licence it was provided that the Plaintiffs should, after notice of infringement, commence and prosecute such action against persons infringing the Patent as in the opinion of *J. F. Moulton*, K.C., *R. W. Wallace*, K.C., and *A. J. Waller* was desirable or expedient; (5) that by a deed of the 1st of March 1897 the Plaintiffs granted a licence under the Patent, and that such licence was transferred to the *Clipper Company*; (6) that, prior to this action and to the acts complained of, the Plaintiffs authorised and permitted the *Clipper Company* under their licence to import and sell tyres not of the manufacture of the Plaintiffs or the *Clipper Company* and made in accordance with the Patent; (7) that the Defendants complained to the Plaintiffs of such importations, but the Plaintiffs continued to authorise and permit them, and that by reason of such facts the Defendants contended that the Plaintiffs were estopped from saying that the Defendants were not under their licence also equally entitled to import such tyres ^{and} or to do the acts of which complaint was made by Plaintiffs in the action; (8) that the Plaintiffs had granted licences under the Patent other than the one in paragraph 5 mentioned, and had permitted the importation into and user in this country of tyres made abroad in accordance with the Patent in the manner stated in the Particulars delivered therewith, by reason whereof the Plaintiffs were not entitled in any case to claim any injunction against the Defendants. In the counterclaim the Defendants (9) referred to the deed of the 1st of May 1896; (10) alleged the transfer to the *Dunlop Pneumatic Tyre Company, Ltd.*, of the rights of the *Pneumatic Tyre Company, Ltd.*, under and subject to the terms and conditions in such deed contained; (11) repeated paragraph 3 of the Defence; (12) alleged that the Plaintiffs had granted licences under the Patent contrary to the terms and provisions of the said deeds of the 1st of May 1896 and the 23rd of July 1896, and in breach of the agreements therein contained, whereby the Defendants had suffered serious loss and damage, Particulars being delivered therewith.

The Particulars, as amended, alleged (*inter alia*)—(1) that on the 1st of March 1897 the Plaintiffs by deed granted to *Thomas Couchman Phelps* full licence, power and authority under the Patent to use and exercise the invention protected thereby, and to import and sell tyres made abroad, and in particular had authorised the *Clipper Company* to import and sell tyres made by Messrs. *Michelin & Co.* in France and by the *Continental Caoutchouc and Gutta Percha Company* in Hanover; (2) that the Plaintiffs had prior to and since the issue of the writ in the action licensed the use in this country of the tyres (for vehicles and cycles) of foreign manufacture imported into this country upon motor vehicles and otherwise; that in particular the Defendants complained of licences to use imported tyres granted by Plaintiffs to—(A) *H. P. Salsbury* for three unnamed tyres branded on the 19th of February 1903, "*Undertaking given L. M. Bergin*"; (B) *Charles Siebert*, chaffeur to *L. E. Ralli*, for two *Michelin* tyres and one continental tyre branded on the 14th of April 1903, "*Undertaking given L. M. Bergin*"; (3) that the

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Plaintiffs had prior to and since the issue of the writ in the action licensed the tyres of foreign manufacturers under the Patent for importation into and use in this country ; that in particular *F. G. Fenton* in Paris, as agent of Plaintiffs or of the *Clipper Company*, and with the consent of the Plaintiffs, had from time to time during 1902 and 1903 branded in Paris motor tyres made by 5 *Michelin & Co.* with the words "*Clipper Tyres*, manufactured by the licence "of the *Dunlop Company*," and such tyres had been imported into this country. [The names of the persons who had been supplied with and had used such tyres were given.] (4) (5) and (6) contained further allegations as to the Plaintiffs authorising or licensing the importation of tyres ; (7) that the 10 numbers and dates of the acts of the Plaintiffs contrary to the terms and provisions of the said deeds of the 1st of May 1896 and the 23rd of July 1896, save as therein above stated, were not known to the Defendants, but the Defendants would claim full compensation in respect of all such acts ; the Defendants were unable to give further or better Particulars until they shall have had 15 discovery. Additional Particulars were afterwards given of paragraph 3.

The Plaintiffs by their Reply (*inter alia*) alleged (4) that paragraph 4 of the Defence was irrelevant ; (5) that the Plaintiffs were not estopped as alleged ; and in their Defence to the counterclaim (7) objected that all necessary parties were not before the Court ; (11) denied the facts alleged in paragraph 12 of the counterclaim save that they granted to one *T. C. Phelps*, as they were entitled to do, a licence under the Patent, which licence was owned by the *Clipper Company* ; (12) alleged that, save as aforesaid, they had granted no licence under the Patent ; (13) that, as to the matters alleged in paragraph 2 of the Particulars, the Plaintiffs did not admit any of the matters alleged therein ; 25 the Plaintiffs had in the case of races held in this country permitted as an act of courtesy vehicles with infringing tyres upon them to be used in this country upon condition that such vehicles were taken out of this country after the race ; the Plaintiffs had in other cases where purchasers of cars had imported cars with infringing tyres upon them into this country settled their claims for 30 damages for infringement of Patent against such persons by reselling to the infringers the tyres which would have had to be delivered up to the Plaintiffs as infringements ; that if in either of the cases referred to in paragraph 2 of the Particulars persons had been allowed to retain infringing tyres (which was not admitted) such persons were allowed to retain the same under the circumstances aforesaid ; (14) as to the matters alleged in paragraphs 3, 4, and 6 of the Particulars, the Plaintiffs were the owners of the Patent, and, whilst not admitting any of the facts alleged in such paragraphs, the Plaintiffs as owners of the said Letters Patent were entitled to authorise their licensees, the *Clipper Company*, to have 35 their tyres manufactured at such places as they might think fit ; (15) as to the matters alleged in paragraph 5 of the Particulars, the Plaintiffs, whilst not admitting any of the facts alleged, were entitled as owners of the said Letters Patent to have their tyres manufactured for them at such places as they thought fit ; (16) alleged estoppel by acquiescence on the part of the Defendants. By 40 an amendment made by leave on the 20th of November 1903, after the commencement and adjournment of the trial : the Plaintiffs alleged (17) alternatively that under and by virtue of the licence the Defendants were entitled, subject to the conditions in the licence mentioned, to use and exercise the invention protected by *Bartlett's* Patent ; (18) that under and by virtue of clause 10 of the licence the Defendants were only entitled under the licence to use such forms of 50 pneumatic tyres constructed under *Bartlett's* Patent as were not also constructed after the invention of *Welch* (No. 14,563 of 1890) ; (19) that the *Clincher-Michelin* tyres complained of in the action were such forms of pneumatic tyres constructed under *Bartlett's* Patent as were also constructed under *Welch's* Patent, and in respect of such tyres the Defendants had no licence ; 55 (20) that the Defendants were not entitled to assign or transfer the licence or

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grant sub-licences; and (21) that the acts of the Defendants in the action complained of were an assignment or transfer of the licence or a sub-licence thereunder to Messrs. *Michelin*, and the licence did not authorise or empower the Defendants or grant any licence to the Defendants to sell or deal in tyres
 5 procured by the Defendants from Messrs. *Michelin*. [This amendment was afterwards struck out, or treated as struck out, under the circumstances mentioned below.]

On the 14th of November 1903 a Summons, adjourned from Chambers, for leave to administer interrogatories to the Plaintiffs, came on before *Buckley, J.*,
 10 but the Plaintiffs stated that it would be impossible for them to answer the interrogatories before the case came on for trial, and the Defendants stated that they did not assent to a postponement of the trial, and *Buckley, J.*, under the circumstances, made no Order.

The action came on for trial on the 18th of November 1903. Early in the
 15 course of the trial the Defendants admitted that a tyre produced was made in accordance with the Patent and imported from France by them.

T. Terrell, K.C., and *A. J. Walter* (instructed by *J. B. and F. Purchase*) appeared for the Plaintiffs; *Cripps, K.C.*, *Bousfield, K.C.*, and *W. Neill* (instructed by *J. Nicholls & Son*) appeared for the Defendants.

20 *Terrell, K.C.*, for the Plaintiffs.—This is an action for infringement of *Bartlett's Patent*. The Defendants are licensees of the Patent, and the Plaintiffs say that the Defendants have gone outside the conditions of the licence, and are therefore unlicensed. The licence is a limited one. [The pleadings were referred to.] The question is, whether the Defendants have
 25 done things not authorised by the licence? *Primâ facie* they have infringed. In 1896 the Plaintiffs owned the *Welch Patent*. The Defendants owned *Bartlett's Patent*. [Fig. 2 of the Specification and the claim were referred to.] The Defendants were making tyres according to *Bartlett* and the Plaintiffs sued them on *Welch*, alleging that the edges of the Defendants' tyres were made
 30 inextensible. The Plaintiffs were then alleging that the *Bartlett* tyres would not hold on unless the edges were made inextensible. Under these circumstances the agreement of the 1st of May 1896 was entered into, by which the Plaintiffs bought the *Bartlett Patent* for 200,000*l.* and agreed to grant a limited licence to the Defendants, they paying a royalty of 2*s.* 6*d.* a tyre. On the
 35 23rd of July 1896 the licence was granted. At that time only bicycle or tricycle tyres were contemplated; motor cars were not then practicable. I shall not contend that the Defendants cannot make motor tyres, although the price is very different. Subsequently to the licence, the Plaintiffs and Defendants both commenced to make motor tyres, and two questions now arise, viz.:
 40 Is the licence one enabling the Defendants to import, or only to make and sell tyres? Is it a limited licence to use *Bartlett's* invention provided that *Welch* is not used as well, and, if so, is the tyre complained of therefore outside the scope of the licence as including *Welch*? [The licence was then read.] The words "manufacture and sell" are very important. If the Plaintiffs are wrong, and if
 45 the Defendants do not themselves manufacture, then there is no royalty payable. The important clause as to *Welch* is clause 10. [*Bousfield, K.C.*—The Defendants have had no notice that infringement of the *Welch Patent* was to be raised.] The Plaintiffs are not attacking the Defendants in this action for infringing *Welch*, but say that they are not entitled to make a type of
 50 *Bartlett* tyre involving the use of *Welch*. [*Bousfield, K.C.*—We are taken by surprise as to the *Welch* point. There is also the question whether it is within the pleadings. The writ is only for infringing *Bartlett*, and the Particulars of Breaches complain of nothing more. The Defence alleges that the Defendants are licensed, and comprises a special defence of estoppel. The Reply does not raise the
 55 point.] It is true the point only occurred to the Plaintiffs three days ago, but the pleadings raise the whole question—that what is done is not covered by the licence.

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I do not need to amend ; it is a question only of Particulars. [BYRNE, J.—I will allow amendment upon terms if you like and try the questions of construction and leave the question of terms until application is made for adjournment. I will let you continue the opening until an application is made.] There is an express limitation of the licence. A Defendant may infringe the two Patents 5 by one tyre. This is not a licence to make *Welch* ; clause 10 can only mean in the course of making *Bartlett* you shall not make *Welch* ; that is the only possible construction of the clause. As to importation, the agreement must be looked at as a whole. No royalties are payable unless a tyre is “manufactured “and sold” ; so as to accounts. There are provisions as to manufacturing in 10 England and selling abroad, but there are no provisions as to importing or selling tyres manufactured abroad. Also clause 10 says, “manufacture or sell.” Clause 14 prohibits sub-licensing, but the Defendants are licensing *Michelin & Co.* to sell in England and are acting as intermediaries. The Defendants cannot buy from *Michelin & Co.* so as to cover that. [Cripps, K.C.—We admit that the 15 Defendants have imported, and we submit that they are entitled to do so.] They are entitled to make and sell the tyres, but not to import. The Defendants have full licence to use and exercise the invention, but for the construction of those words the licence must be read as a whole. If the Defendants are right, the Plaintiffs get nothing from the licence so far as motor tyres are concerned. 20 [The form of Letters Patent in the first schedule to the Patents, &c. Act, 1883, was referred to.] The words “make, use, exercise, and vend” are there used. But the words in the licence are “use and exercise,” and these must be read with the other parts of the licence. It was never intended that the Defendants should buy from other persons, thereby really licensing such 25 persons ; whilst by the terms of the licence the Plaintiffs are very strictly limited as to granting other licences. [Cripps, K.C., admitted that a tyre produced was a tyre made in accordance with *Bartlett's* Patent and imported from France by the Defendants.] [An Agreement between the Defendants and *Michelin & Co.* of the 29th of January 1903, which is referred to in the judgment, 30 was then read.] That Agreement is really a licence, and is forbidden by clause 14. On the second point, the licence is not to extend to *Bartlett* tyres which involve the use of *Welch*. Such a tyre, as the admitted tyre, had never in fact been made at the date of the licence. We say that it makes use of *Welch* in fact, even though it may use *Bartlett* too. No motor car tyre can be used without 35 the *Welch* principle, at all events in reserve ; a stiffened edge is necessary, as in the admitted tyre.

Cripps, K.C., and Bousfield, K.C., for the Defendants.—We will, if the Court thinks it convenient, now state our case. We submit that the Defendants are entitled under the licence to import *Bartlett* tyres manufactured abroad. There 40 are three points against us—that the agreement only contemplates manufacture and sale ; that the agreement with *Michelin & Co.* is a sub-licence ; and that the tyre produced is an infringement. Full licence is granted to “use and “exercise” the invention. This means, in the widest commercial sense of the words, that the Defendants may carry on their business in the patented article. 45 The Plaintiffs could not prevent manufacture abroad, so that does not come in question. If someone manufactures in this country and sells to the Defendants they do not infringe, although the manufacturer may. “Use and exercise” must include manufacture and sale, but the Plaintiffs argue that the licence is limited to “manufacture and sell.” The Defendants have never contended 50 that a royalty would not be payable on sale only ; they do not contend that they could escape from royalty by importing and selling. If so, the only result is that royalty is not payable ; but the grant is not cut down. But our contention is that “manufacture and sell” may be read disjunctively. The Defendants are entitled to carry on their business in the tyres in the fullest 55 sense. Then as to the agreement with *Michelin & Co.*, the sale is to take place

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- abroad, no doubt to prevent their being infringers. If they had manufactured here they would be infringers, but the Defendants would not be infringers. The fact that a share of profits in the Defendants' motor-car department is given to *Michelin & Co.* is immaterial. There is no partnership. Manufacture and sale abroad of a patented article is not infringement; but if the sale is in this country there is infringement unless the article is sold by a licensee. Again, it is said clause 10 makes the Defendants liable; this clause does not affect their right to use the *Bartlett* Patent; that was the very question which the Agreements were meant to get over. [BYRNE, J.—It is contemplated that *Bartlett* can be made without infringing *Welch*, but it is arguable that, if wires were put in, it might be *Bartlett* made according to *Welch*.] Clause 10 does not limit the Defendants' rights to make under *Bartlett*. It allows them to go outside the strict *Bartlett* so long as they do not infringe *Welch*. As regards the *Clincher* tyres, we might go on manufacturing them as before. If, as admitted, what we have made is *Bartlett*, then *cadit questio*. The Plaintiffs' own case is that we are making *Bartlett*; that is the very thing that we are entitled to do. [BYRNE, J.—It is said that the tyre complained of infringes *Bartlett* and *Welch* as well.] The Plaintiffs are not under the licence entitled to complain of it; there is no limit to our licence to use *Bartlett*. [BYRNE, J.—Does not clause 10 mean that the Defendants shall not manufacture, even although within the *Bartlett* Patent, if they infringe *Welch*?] I submit not. Clause 10 extends, but does not limit, the licence. "*Clincher*" means a tyre made by the Defendants. It was a question at that time whether *Bartlett* was an infringement of *Welch*, and it was intended to deal with that position. If the Plaintiffs are right as to clause 10, they could set up that the Defendants were left in the same position as before the licence because they infringed *Welch*. [BYRNE, J.—In the document there is a distinction between the two inventions.] As to clause 8, the Plaintiffs wanted the Defendants to sell as many tyres as possible, and the Defendants stipulated that they should have as competitors only one other further licensee. The existing licensees did not manufacture themselves; the Plaintiffs allowed the licensees to get others to manufacture for them, and this was the accepted commercial meaning of the licence. The Defendants were entitled to set others to manufacture for them and to purchase from the manufacturers; the Plaintiffs' interest was that the output should be as large as possible. The licence was to put the Defendants unrestrictedly in the position of the Patentee. The Defendants could not be liable for purchasing from anyone, whether infringer or not, although the infringer could be sued. The licensee has of course to pay the royalty; he could make tyres himself, why could he not purchase? In substance, the Defendants have gone abroad and brought the tyres in. They could set up a manufactory in Holland and import the tyres made there. Then, as to the arrangement with *Michelin & Co.*, no licence is wanted for anything done abroad, so there is no sub-licence to *Michelin & Co.*; no act in this country has been licensed. The question of stiffened edges had been raised before the licence, and no question has ever been raised since as to them. Assuming that the Defendants are using *Welch*, clause 10 is not a condition or limitation on the grant. If there is any right, it is merely one of damages for breach of covenant.
- Terrell, K.C.*, in reply.—This agreement with *Michelin & Co.* is a sub-licence within clause 14. *Michelin & Co.* are to have part of the "profit and advantage" granted by the Patent. *Michelin & Co.* are interested in the resale in England of the tyres, and are sub-licensees. Clause 2 must not be read alone as the grant, for, if so, manufacture and sale are not included. I say they are included, but the Agreement must be read as a whole. Clause 10 licences the pure *Bartlett*, but not the form of *Bartlett* which involves *Welch*.
- BYRNE, J.—This is an action to restrain infringement of what may be called for shortness *Bartlett's* Patent, brought by licensors against licensees. So far

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as I have at present to deal with the matter, the point at issue is whether or not the Defendants can justify what they have done as being lawful by virtue of the terms of their licence from the Plaintiffs. I have been asked by both parties, first, to determine certain questions of construction arising on the licence on admitted facts. These being disposed of, there are, or may be, other questions to be dealt with. The short facts not in dispute are as follows:—In the year 1896 there was a pending litigation between the Plaintiffs, the owners of the *Welch* Patent, and the Defendants, the owners of the *Bartlett* Patent, involving the question whether what was being done by the Defendants under *Bartlett's* Patent was an infringement of the *Welch* Patent. These disputes were put an end to by the terms of an Agreement dated the 1st of May 1896, whereunder the Plaintiffs became the purchasers of *Bartlett's* Patent for 200,000*l.*, and were to grant a licence upon certain terms. The Agreement was carried out. The Plaintiffs became the owners of the *Bartlett* Patent, and they granted a licence to the Defendants, dated the 23rd of July 1896, the terms of which I shall have to refer to particularly later; but to complete the necessary statement of facts before I proceed, the Defendants have entered into an Agreement with Messrs. *Michelin & Co.*, a French firm of tyre manufacturers, dated the 29th of January 1903, the leading part of the Agreement being as follows:—“It is mutually agreed as follows: Messrs. *Michelin & Co.* will manufacture for the *North British Rubber Company, Ltd.*, all such pneumatic tyres for motor cars and other vehicles under the *Bartlett* (British) Patent (No. 16,783 of 1890) as the *North British Rubber Company, Ltd.*, are entitled to manufacture under the licence from the *Dunlop Pneumatic Tyre Company, Ltd.*, dated the 23rd of July 1896, other than cycle, motor cycle, and motor bicycle tyres, and as the *North British Rubber Company* shall require for the United Kingdom upon the terms of remuneration, and subject to the mutual stipulations and conditions contained in a memorandum of such terms to be from time to time agreed upon and signed by the said parties hereto. The *North British Rubber Company, Ltd.*, will not employ any other person to manufacture such tyres for them during the pendency of this agreement, but this stipulation is not to preclude the *North British Rubber Company, Ltd.*, from manufacturing such tyres by their own servants at their own works to the number of not more than 5,000 tyres in any year. All such tyres manufactured by Messrs. *Michelin & Co.* shall be marked, ‘The *Clincher-Michelin* Tyre, *Bartlett's* Patent, manufactured for the *North British Rubber Company, Ltd.*, by *Michelin & Co.*, Clermont Ferrard.’ Nothing in the said memorandum of terms or in the mode of remuneration or in the course of business between the parties shall be construed as making the relationship between the parties other than that hereby created, namely, that Messrs. *Michelin & Co.* shall manufacture such tyres solely as the manufacturing agents for the *North British Rubber Company, Ltd.*, and shall not have the right to make such tyres for, or to supply such tyres to, any person in the United Kingdom other than the *North British Rubber Company, Ltd.*” There was a second Agreement entered into embodying the terms referred to in that Agreement. It will not be necessary for me to go through it and I will avoid mentioning the figures, but I will state what the essential provisions for the present purposes are: “Messrs. *Michelin & Co.* shall deliver the *Clincher-Michelin* tyres as well as the accessories free at Treport, Dunkirk, or any other French port required, at the prices and upon the conditions stated in their confidential tariff.” Then there are provisions for remuneration, and I think the next important one is clause 4, which is that “payment for the tyres, or goods, shall be made on the last day of the month which follows that in which they shall have been invoiced and shipped, and the same shall be nett,” and so on, and the invoice shall be dated on the day when the goods are despatched from Clermont Ferrard. Then in clause 9 there is a provision for taking back goods made

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by Messrs. *Michelin & Co.* which the *North British Rubber Company* do not sell, and, if they refuse to do so, then the *North British Rubber Company* may sell. Then clause 14 provides: "In consideration of the special cession given to the *North British Rubber Company* by Messrs. *Michelin & Co.*, as shown by these terms, the *North British Rubber Company* will give them a share of the profits in the motor tyre department," and then there are provisions for ascertaining this share. Then clause 24 is: "The present contract shall continue in force till the expiration of the *Bartlett* Patent, 1890," subject to something which I need not mention; and clauses 25 and 26 have in view possible litigation. Clause 25 provides that the *Rubber Company* shall intimate to the *Dunlop Company*, their licensors, their intention to have their motor tyres manufactured for them by Messrs. *Michelin & Co.* at Clermont Ferrard, and to import them into the United Kingdom, so that the *Dunlop Company* may be made aware of, and, if they so desire, take steps to check the quantities thus imported by the *Rubber Company*; and then clause 26 is a provision for making some arrangement about litigation, and the costs of litigation. I do not think I need go further into detail.

The Defendants have under these Agreements bought and paid for, and taken delivery of tyres in France which they have brought into England and sold. They admit liability to pay royalty in respect of such goods. It is part of the Plaintiffs' case, and it is admitted by the Defendants, that these are made in accordance with the *Bartlett* Patent, otherwise the Plaintiffs could not get the relief for which they ask in the present action, and until within the last three days the only contest, so far as the case has been heretofore opened before me, was whether or not the Defendants are entitled to purchase and sell *Bartlett* tyres as they have done; but a new question has been since raised, namely, whether or not the tyres, though in accordance with the *Bartlett* Patent, are or are not also in accordance with the *Welch* Patent, and on that ground not within the licence. So far as the new point is concerned, I have held that, so far as it depends on fact, the Plaintiffs may amend so as to raise the question specifically, upon terms, but that the Defendants may have an adjournment to meet this new question on evidence should it become necessary. The Defendants, however, say that they can, on the construction of the licence, get rid of this new point altogether.

The points taken on behalf of the Plaintiffs are, first, that the terms of the licence do not permit the purchase abroad of tyres made by third persons in accordance with the *Bartlett* Patent, and their importation into England and sale by the Defendants; secondly, that even if this be permissible, it cannot be done if the tyres, although made in accordance with the *Bartlett* Patents, are also constructed after the invention of *Welch*; and, thirdly, that the particular bargain made with Messrs. *Michelin & Co.* amounts to a sub-licence, and is contrary to the terms of clause 14 of the licence.

I proceed to consider the terms of the licence itself, which requires examination with some particularity. It recites that the licensors are absolutely entitled to the whole legal and beneficial interest in the inventions and Letters Patent mentioned in the schedules, and then it recites shortly the Agreement of the 1st of May 1896 which I have mentioned. The first clause provides that in pursuance of this Agreement a licence is granted of a Patent not the subject of the present action. Clause 2 is the first important clause. "In further pursuance of the said Agreement, and in consideration of the royalty herein-after reserved or made payable and of the covenants and agreements on the part of the licensees hereinafter contained, the licensors do hereby grant unto the licensees full licence under the Letters Patent mentioned in the second schedule"—that is the *Bartlett* Patent—"to use and exercise the invention protected by the said Letters Patent during the term of such Letters Patent

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"or any prolongation thereof, paying therefor the royalty next hereinafter mentioned. And it is hereby mutually covenanted and agreed between and by the said respective parties hereto as follows." Then follows clause 3: "The licensees shall be entitled to manufacture within the United Kingdom pneumatic tyres under this licence for sale outside the United Kingdom without payment of any royalty to the licensors or either of them, but all such tyres shall be marked before being sent out by the licensees by having the words 'Not licensed for use in the United Kingdom' or other similar words marked upon them, so as to prevent the reimportation of the same into the United Kingdom by persons to whom they have been sold by the licensees, but on any such sale as is intended under this clause the licensees will obtain an agreement from the purchasers of such tyres not to sell the same in the United Kingdom of Great Britain and Ireland, and will strictly enforce the said agreement." Then clause 4 is: "The licensees shall as from the 1st day of May 1896, and until the licensors shall have obtained the Agreement mentioned in clause 5 of these presents, pay to the parties hereto of the first part a royalty of 5s. per pair upon all tyres manufactured and sold by them under the licence contained in clause 2 of these presents, such royalty to be payable half-yearly and to become due and to be paid at the end of two calendar months after the expiration of the half year during which the same tyres shall have been manufactured or sold."

I pause here for one moment to say that any possible question that might have been raised as to the generality of the terms of clause 2, by reason of the absence of the words "manufacture and sale"—the words being simply "use and exercise"—is entirely got rid of by the reference in clause 4 to manufacture and sale under clause 2. Therefore, if clause 2 stood alone, it would be simply a general licence, conferring, I imagine, all such rights as a Patentee can give to a licensee. Clause 3, however, obviously limits, to some extent, what might be done by a general licensee having no terms imposed upon him; because I apprehend that, under a general licence, he would be entitled to sell abroad, and the goods might come back again into England after he had sold them abroad, and I think that that forms one limit to the generality of the preceding words. I may say further that I think, considering the construction of this document, what I have really to do is to consider fairly the meaning of the whole of the terms, and that it will not do to start by saying: "Here is a licence in perfectly general terms, and what comes after is not to be construed as limiting the terms of what goes before." It is a question of construction in each case, looking at the whole instrument, whether what is granted is a full, absolute, and entire licence, or whether it is granted upon terms which really limit the licence. Clause 5 is material for a particular reason. It has not come, I understand, into operation, but it provides that "the licensors shall use their best endeavours to procure" certain firms mentioned "to enter into an agreement or agreements in writing with the licensees by which each of the said three Companies shall agree to increase their prices for pneumatic tyres made under the *Welch* Patent, No. 14,563 of the year 1890, by 5s. per tyre," and in that case there is to be a rise in the royalty paid to the *Dunlop Company*, and there are certain terms mentioned. I refer to this because there is a reference there made to parties entitled to make pneumatic tyres under the *Welch* Patent. Clause 6 provides about keeping books, containing full entries and particulars of all tyres manufactured and sold by the Defendants under the licence granted by clause 2 of the Agreement. Clause 7 provides for the furnishing of accounts of all tyres manufactured and sold by them as aforesaid during the preceding half-year. Clause 8 provides that: "So long as the licensees shall in each year (calculated from the 1st day of May to the 30th of April in the following year) sell not less than 25,000 pairs of pneumatic tyres manufactured under the Patent mentioned in the second schedule hereto,

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"the licensors shall only be entitled to grant one licence (other than and besides the licence already granted and mentioned in the third schedule hereto and the licence granted by these presents) to manufacture and sell the invention protected by the Letters Patent of *Bartlett*." Then clause 9, I do not think I need refer to, but clause 10, which is important on one of the questions, is this: "The licensees shall not manufacture or sell tyres constructed after the invention of *Charles Kingston Welch*, No. 14,563 of the year 1890, but subject as aforesaid the licensees shall be entitled to manufacture all forms of pneumatic tyres heretofore manufactured by them under the name or title of '*Clincher Tyres*,' and shall be entitled to make such modifications in the form of the rims and in the sections of the covers as may be necessary to meet the public requirements and to keep up the trade in the '*Clincher Tyres*,' and no proceedings for infringement of the said Letters Patent mentioned in the first and second schedules hereto, or of any Letters Patent the property of the licensors or either of them, shall be commenced against the licensees or any purchaser from them in respect of any '*Clincher Tyres*' manufactured by them prior to the 1st day of May last." Then clause 11 is about taking proceedings, and clause 12 is that the licensors shall at their own expense do what is necessary to maintain and prosecute actions under certain conditions. Then clause 13 is that the licensees shall not dispute the validity of the Patent, and clause 14 is: "The licensees shall not assign or transfer the licence granted by these presents or either of them to any person or Company, other than their successors in business, or grant any sub-licence to any person or persons or Company."

I have said that it appears to me that clause 2, having regard to what is said in clause 4, begins by a general licence. Clause 3 has a double object. It exempts from royalty. It is for the benefit, so far, of the licensees; and it limits the generality by forbidding what I think might otherwise have been done under the general licence. It is to be observed that, under clause 4, the royalties are payable in respect of the things manufactured and sold, and that expression occurs more than once, and was a good deal dwelt upon by the Plaintiffs in their argument as to the true construction to be put upon this.

As to the first question, I think that the true meaning of the Agreement is that the goods sold under the licence must be manufactured by the licensees, but I also think that they are not the less manufactured by them within the meaning of the clause if they are manufactured for them by a third party, and a price is paid for that. I think that the argument was put too strongly on behalf of the Defendants when it was said that they might buy anywhere from infringers and sell again, but the agreement with *Michelin & Co.* is an agreement with persons, who are themselves entitled to make, and it is an agreement for *Michelin & Co.* to make as agents for the Defendants. I agree that the question is far from being free from difficulty, but I think this is a manufacture by them within the meaning of the licence.

Then as to the second point taken, which turns on clause 10, namely, that the licensees shall not manufacture or sell tyres constructed after the invention of *Welch*, I cannot avoid seeing, looking at this Agreement—and that is why I referred particularly to clause 5 as well as to clause 10—that the parties had in contemplation and must have considered that at the date of this licence there was a *Welch* invention which could be distinguished from the *Bartlett* invention, otherwise the provisions would seem to be most extraordinary. Under clause 5 there are persons referred to who are already licensed to use the *Welch* Patent, and there are provisions contained for inducing them to come to some terms. Then as to clause 10 a good deal of argument was directed to saying that I ought not to read that as in fact being a limit upon the generality of the previous licence, but that I ought to read it solely having regard to the words which occur afterwards in the clause; that the clause was

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intended for the benefit of the Defendant Company, and it should be confined to the precise subject-matter of that clause. But I cannot read it in that way. The words at the beginning of the clause are: "The licensees shall
 "not manufacture or sell tyres constructed after the invention of *Welch*, but,
 "subject as aforesaid, they shall be entitled to manufacture"—putting it 5
 shortly—as they had manufactured *Clincher* tyres before. This clause was, I suppose, put in in order to obviate possible questions arising between the parties as to whether things which had been theretofore manufactured by the Defendants were made in accordance with the *Bartlett* Patent or not, and in effect the clause is, speaking generally: All things which you have heretofore 10
 manufactured as *Clincher* tyres you may go on manufacturing, and you may alter the forms of rims and sections of the covers as therein mentioned, but it is all subject to this, that you must not manufacture or sell tyres constructed after the invention of *Welch*; you may manufacture according to *Bartlett*; all the 15
 things that you have done shall be deemed to be within *Bartlett*, but you must not manufacture according to the invention of *Welch*. What the effect of that clause is, really and truly, must depend upon evidence, and it may be something very small indeed, because there is an undoubted right under the licence to manufacture *Clincher* tyres, and to manufacture according to the *Bartlett* Patent, but it is possible that proof may be afforded that, although manufactured 20
 within the *Bartlett* Patent and being in accordance with it, it is also manufactured in accordance with another invention which the parties had in mind at the time when they entered into this agreement—namely, the *Welch* Patent. What sort of controversy that may lead to I will not venture to prognosticate, but I can see this very clearly, that the Defendants start with this—"We are 25
 "allowed to manufacture in accordance with the *Bartlett* Patent; what you, our "opponents, have to show is, that we have taken something, in addition to or "apart from the *Bartlett* Patent, which is constructed after the invention of "*Welch* within the meaning of the Agreement."

Then there is a short point which turns on clause 14. I do not think that 30
 the agreement which has been made with Messrs. *Michelin & Co.* does amount to a sub-licence or to an assignment. As I read it, it is really an agreement to act as manufacturing agents and to be remunerated partly by payment of a share of certain profits. I cannot say that that is a licence. I am quite disposed to accede to the argument, which was addressed to me, that the meaning of a 35
 sub-licence is a licence to somebody to do something which, without it, he would not be entitled to do, but that does not apply to the present case at all, and the acts are outside the area within which a sub-licence would be granted.

Terrell, K.C., then applied for leave to amend by adding to the Reply and Defence to counterclaim the paragraphs set out above and numbered (17) to 40
 (21); and a discussion ensued as to the terms on which amendment should be allowed and as to the adjournment necessitated by the amendment.

BYRNE, J., allowed the amendment on the terms of the Plaintiffs paying in any event the costs thrown away.* He also pointed out that the decisions 45
 on the two points of construction were given at the request of the parties and on admissions by the parties, and that if it were intended to appeal on these points the exact form of the admissions should be settled between the parties subject to application to the Court if necessary. Ultimately it was ordered that the case should stand over and keep its place in the list, but not come in for hearing until mentioned again. 50

On the 26th of November 1903 *Bousfield*, K.C., mentioned the case, saying that there had been a question as to whether the tyres complained of were or were not

* The exact terms of the Order finally made as to costs appear at the end of the report of the trial.

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made according to *Welch* as well as according to the *Bartlett* Patent, but that since the amendment was made the Plaintiffs had given notice that they did not intend to offer any evidence on that branch of the case, and that practically, for their own reasons, they had dropped the charge of infringement of the

5 *Welch* Patent. He stated that he presumed that the Plaintiffs would not go to the Court of Appeal on the question of the construction of clause 10 after offering no evidence, but he now asked the Plaintiffs to make that clear.

Terrell, K.C.—All I can say is that we took a point of law, which we cannot support by the facts. We cannot give any evidence about it; so that

10 we are not going at all on clause 10. My friend need not fear any further trouble about that.

Bousfield, K.C.—After that statement I shall not put in any answer to their amended pleading; the other point was there before practically.

Terrell, K.C.—You need not trouble about it at all. It would make it simpler

15 if we struck out our amendment altogether.

BYRNE, J.—Yes, all the amendment.

Terrell, K.C.—There are only two points now left for the Court of Appeal to deal with. Then, of course, there is this further—the Defendants have a Counterclaim and a defence of estoppel. I do not know whether they intend

20 to go on with those.

Bousfield, K.C.—Yes, we must offer some evidence.

The day on which the case should come on again was then fixed.

The hearing was continued on the 3rd of December 1903.

Cripps, K.C., for the Defendants.—As to the Defence, the estoppel pleaded in

25 paragraph 7 might become important, although the major point has been decided in the Defendants' favour. [The correspondence between the parties was put in and the licence to the *Clipper Company*.] As to the Counterclaim, the Defendants will prove that they have sold the numbers of tyre mentioned in clause 8 of the licence, and the restriction on the grant of licences by the Plaintiffs there-

30 fore became operative, and the Plaintiffs were not entitled to grant any licence after the licence to the *Clipper Company*. We allege that there have been important and constant breaches by the Plaintiffs of this provision. In view of the decision on the construction of the licence, paragraph 1 of the Particulars becomes immaterial; but paragraph 12 of the Counterclaim and the Particulars

35 in reference thereto are material. [Paragraphs 2, 3, and 4 of the Particulars were referred to.] The decision on the construction of the licence does not affect paragraphs 3 and 4, for it has been held that the acts of the Defendants were justified because *Michelin & Co.* were their agents, and not on the general ground of importation being permissible. The Plaintiffs by their Defence to the Counter-

40 claim object that all necessary parties are not before the Court. [*Terrell, K.C.*—An injunction is asked for by the Counterclaim.] I should ask for an inquiry as to damages; an injunction would not be necessary. The Plaintiffs say that they have since the licence to the Defendants only licensed the *Clipper Company*, and they do not admit the facts alleged in paragraph 2 of the Particulars. The

45 Defendants do not complain as to the racing cars. Their point is that the Plaintiffs have as a practice licensed persons to use tyres on application, and they have got more than if the tyres were sold by the Defendants or the *Clipper Company*. Paragraphs 17 to 21 of the Defence to the Counterclaim have now been struck out. [*Walter*.—But on an admission that without them

50 the pleadings were wide enough to cover the point raised thereby as to sub-licences.] The Defendants do not abandon any part of their Counterclaim, but as to part it is really alternative.

Witnesses were then called on behalf of the Defendants, including Messrs.

H. P. Salisbury, C. Siebart Stuart, late manager of the Defendants, and

55 certain witnesses called as to the matters alleged in paragraph 3 of the Particulars.

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Bousfield, K.C., for the Defendants.—By the Counterclaim, there are two classes of acts complained of; first, tyres of foreign manufacture have been brought into this country and taken to the Plaintiffs' office and stamped as being licensed; secondly, tyres of foreign manufacture have been taken to *Fenton* in Paris and stamped as being licensed for use in this country. We do not now complain of genuine tyres made by *Michelin & Co.* for the *Clipper Company* under their licence. When the Defendants began to work with *Michelin & Co.* instead of the *Clipper Company* doing so, *Michelin & Co.* undertook not to send tyres into this country; but, after the agreement between *Michelin & Co.* and the *Clipper Company* lapsed, persons got tyres which were not manufactured for the *Clipper Company*, and got them stamped by *Fenton* with the stamp used during the existence of the agreement—that is to say, with the words "*Clipper Tyres, manufactured by licence of the Dunlop Company.*" The Plaintiffs well knew what *Fenton* was doing, and sent persons to him for that purpose. As to the first point, a regular practice has grown up of the Plaintiffs stamping any tyres taken to them on payment of a royalty. [Certain correspondence which, the Plaintiffs contended, authorised this was referred to.] The letters were not dealing with a regular practice, but only a particular situation. The Defendants are entitled to say that, apart from any specific direction that may have been given by them, the Plaintiffs could not grant any licence. [BYRNE, J.—Substantially what the Defendants want is a declaration?] Yes, a declaration that the Plaintiffs are not entitled to licence tyres other than those made by themselves or their licensees.

Terrell, K.C., for the Plaintiffs.—First, as to the construction to be put on clause 8 of the licence. Letters Patent are a prohibition against other people manufacturing, selling, or using the invention. Under clause 8 the Plaintiffs were only to grant one further licence to manufacture or sell. It must be so read, and cannot prohibit licences to use, otherwise the result would be that on a sale by the Plaintiffs no licence to use could be given. The effect would be that the first sale of a tyre by the Plaintiffs would be a licence to use, and they could not sell another tyre. Such a construction is impossible. The Defendants say that neither the Plaintiffs nor the *Clipper Company* can import into and sell in this country, for that would be granting a licence to use. However, on the facts, the Plaintiffs told the Defendants in July 1899 that they were going to put a penalty royalty on unlicensed tyres brought into this country, and the Defendants have raised no objection until now. What is complained of was acquiesced in; but I submit also that the Plaintiffs are entitled to do what they have done. If anyone is infringing by an imported tyre, the Plaintiffs say: We will licence you to use it if you pay a penalty royalty. [BYRNE, J.—Or any royalty?] Yes, I must go as far as that. The Plaintiffs also get an undertaking not to infringe. In clause 12 the word "desirable" shows that it was not contemplated that every infringer should be sued. The Plaintiffs were not bound to sue for infringement in the cases complained of. [BYRNE, J.—The Plaintiffs would be *ex post facto* giving a licence to use. Is that contemplated?] Yes. [BYRNE, J.—In that way they could licence any tyres made abroad.] They are not bound to sue, but, as a fact, in the cases before the Court they did threaten, and were right in doing so. So that, as to paragraph 2 of the Particulars, the Plaintiffs only claim a reasonable right, and they say that the Defendants acquiesced. As to paragraph 3, *Fenton* was not the Plaintiffs' agent; and it is not shown that the *Clipper Company* have done anything which they have no right to do, and, if they have, that gives no right of action against the Plaintiffs.

F. C. Baisley was called as a witness on behalf of the Plaintiffs, and stated the course which the Plaintiffs took with regard to infringements; his evidence will be found referred to in the judgment.

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Walter summed up the Plaintiffs' case on the Counterclaim.—Clause 8 of the licence leaves the Plaintiffs unfettered as regards their own acts; the licence must be construed with regard to the business point of view. The Plaintiffs are left free to have their tyres made where and by whom they please. The
5 *Clipper Company* have in fact never manufactured; they have got tyres from *Michelin & Co.* and others; and the Counterclaim is really a claim that the *Clipper Company* are not entitled to do that. [The facts as to paragraph 3 of the Particulars were referred to.] It is not proved that the Plaintiffs were in any way concerned in what was done. As to the English branch of the case,
10 the Plaintiffs have not deprived themselves of the right of settling with infringers; clause 12 governs cases of infringement. The case was opened for the Defendants as founded on a practice of giving licences by the Plaintiffs; that, however, is not warranted by the facts proved. Settling with an infringer is not giving a licence within clause 8. A licence to manufacture implies the
15 right of sale and use; but a licence to sell does not imply necessarily the right of manufacture; also a licence to sell implies granting the right to use. There is under clause 8 no fetter on the Plaintiffs granting licences to use. It is said that the Plaintiffs must not take damages and allow the use of a tyre to continue; but they are not bound to sue at all for infringement. There has been a fair
20 and *bona fide* exercise of the Plaintiffs' rights and not an underhand method of granting licences.

Botsfield, K.C., in reply.—“Manufacture and sell” in the licence includes “use and exercise,” and *vice versa*. One must read in all the four words in clause 8. But then, if the word “and” is not read as “or,” the Plaintiffs
25 may contend that all the rights are not included in a licence granted, and so they might grant any number of licences to sell and not manufacture. The Plaintiffs are not entitled to say that, although they cannot grant the whole rights, they can grant any one. On the facts, I submit that the Plaintiffs have not limited themselves to granting licences to use—in *Salsbury's* case there
30 was sale as well—and, moreover, they have not put any restrictions as to sale on the infringers.

BYRNE, J.—In this case I have questions arising on the Counterclaim to dispose of. There are two matters, and one is with respect to certain acts done to foreign tyres by or through *Mr. Fenton*, the agent of the *Clipper Company*
35 in Paris. What has been done is that persons have bought tyres in Paris, and have gone to *Mr. Fenton* in Paris, and have got him for a payment to stamp on the words, “*Clipper Tyres*, manufactured under licence from the *Dunlop Company*.” This part of the case I think I may dispose of quite shortly. I may say, however, in passing, that the real nature of the act done was a sale
40 to *Mr. Fenton*, and a re-sale by him, the difference in the purchase money really denoting the difference between the English price and the French price. Now I may dispose of this part of the case by saying that the Defendants have failed to prove that the *Dunlop Company* are in any way responsible for the acts of the *Clipper Company*, or of the agent of the *Clipper Company*, *Mr. Fenton*.
45 I think, after hearing the evidence of the Defendants, it is perfectly clear that the acts complained of have been committed by the *Clipper Company* through their agent, *Mr. Fenton*, and the utmost that can be said against the *Dunlop Company* in respect of these matters would be that they have to a certain extent known of this being done, that they admit that they think it is a justifiable
50 proceeding, and that they wrote a letter in which, in substance, they advised some customer, or person applying to them, to take the course of applying to *Mr. Fenton*, the *Clipper Company's* agent in Paris, as to what to do. Well, that is not sufficient. In my opinion the Plaintiffs have failed on the evidence to show that the Defendants are responsible for the acts in respect of which they seek relief.
55 The other matter stands on a different footing. The averment in paragraph 2 of the Counterclaim is that the Plaintiffs have “licensed the use in this country

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" of the tyres (for vehicles and cycles) of foreign manufacture imported into
 " this country upon motor vehicles and otherwise," and then Particulars are
 given of two cases of which the Defendants complain. There is a third, I
 think, referred to afterwards in some further Particulars. Then I will refer to
 what is said in the Reply. Paragraph 13 is : " As to the matters alleged in 5
 " paragraph 2 of the Particulars, the Plaintiffs do not admit any of the matters
 " alleged therein. The Plaintiffs have in the case of races held in this country
 " permitted as an act of courtesy vehicles with infringing tyres upon them to
 " be used in this country upon condition that such vehicles were taken out
 " of this country after the race. The Plaintiffs have, in other cases, where 10
 " purchasers of cars had imported cars with infringing tyres upon them into
 " this country, settled their claims for damages for infringement of Patent
 " against such persons by reselling to the infringers the tyres which would
 " have had to be delivered up to the Plaintiffs as infringements. If in either
 " of the cases referred to in paragraph 2 of the Particulars persons have been 15
 " allowed to retain infringing tyres (which is not admitted) such persons were
 " allowed to retain the same under the circumstances aforesaid." With reference
 to the case of vehicles brought here for races, we have nothing to do with that ;
 no evidence has been gone into, and I do not understand that any complaint
 has been made with respect to that matter. But undoubtedly the Plaintiffs 20
 have, when it has been called to their attention that there were infringing tyres
 brought into this country, used their best endeavours to find out and deal with
 such cases. It is common ground between the parties that it is alike the duty
 and the interest of the *Dunlop Company* to put a stop to such infringements.
 It is also admitted on the part of the *North British Rubber Company* that it is 25
 advantageous that—if I may use the expression—too severe an exercise of a
 Patentee's right to press things to a conclusion in every accidental case would
 be most injurious as well to themselves as to the *Dunlop Company*. Now see
 what happens. Since the year 1889, according to the evidence which I have
 heard to-day, not more than 300 cases or thereabouts of any such dealings have 30
 happened, but, taking the class of cases with which we are dealing, in about
 ten cases or thereabouts—the witness, Mr. *Baisley*, could not bind himself of
 course to exact figures in any way, but he says speaking to the best of his
 belief—in about ten cases there has been a voluntary coming to the *Dunlop*
Company, and a request to have tyres, which have been acquired abroad, 35
 licensed for use in this country, and what has been done then is this—whether
 the Company find it out for themselves, or whether the individual comes
 and asks to be allowed to use this tyre, it is dealt with on this footing. They
 say, " Is this an intentional infringement ? " They consider the circumstances
 of each case, and they do not consider themselves bound to issue a writ and 40
 to get an injunction in the case of every gentleman who happens to bring
 a tyre from abroad into this country, but they consider themselves justified
 in taking from such persons a certain payment which they call a penalty
 royalty, and an acknowledgment or undertaking. The acknowledgment is :
 " I have infringed and have handed you " so much—the one before me 45
 now is 3*l.*—" to cover damages and costs in respect of such infringement,
 " and I hereby undertake that I will not at any time hereafter import, deal
 " in, sell, or use tyres which infringe the said Letters Patent." It appears
 to me that that is, so long as it is fairly used, a most proper way of dealing
 with cases that the Plaintiffs think are what I may term innocent infringements— 50
 that is to say, not tyres imported from abroad for the purpose of being sold and
 dealt with in this country, but tyres that generally come over used or partly
 used upon cars that have been used abroad. Sometimes a gentleman takes his
 car abroad, and he has to replace his tyres with foreign tyres. Of course there
 are many different ways in which the matter could arise, but it is deposed to 55
 by Mr. *Baisley* that in no case have they ever given a licence or permission to

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anybody to bring tyres into this country. The case is not the case that I rather gathered was sought to be made on the opening, that a practice was indulged in by the *Dunlop Company*, which if pursued, would materially interfere with the trade and business of the English manufacturers, including the

5 *North British Rubber Company*, in this country. They are in rather a curious position about the matter, because in 1899 this course of dealing was called distinctly to the attention of the *North British Rubber Company*, and they were told that the *Dunlop Company* proposed to take this course, and although it may be that they did not anticipate that these cases would occur in any
10 very large number, from that time forward till some time in the year 1902—I think in November—they took the stand that they did not approve of this practice. It is said, and truly said, that they have not given an indefinite leave to the *Dunlop Company* to go on always following the practice that theretofore had been followed, and that they were entitled to insist upon
15 their legal rights as from the time when they dissented from that course being pursued. The question is whether, in what has been done, and so long as it is confined to cases similar to those which have been proved before me, and which have been mentioned by Mr. *Baisley*, that is an infringement of the licence granted. Really and truly it is a step for the protection of the invention—a
20 compromise on terms that are as good as the undertaking which would be exacted by the Court in a case of an infringement, and not insisting upon the delivery up of the goods, which would have been ordered to be delivered up by the Court had the matter been gone through. Having regard to this, that it would and did occasion intense unpopularity amongst the persons who use
25 these tyres—amongst the customers of both the Plaintiff Company and the Defendant Company and others, when the rights of the *Dunlop Company* in respect of this Patent were insisted upon very strongly—I mean insisted upon in numbers of cases in which they pressed the matter on to injunction—in the view I take, the method proved before me is a fair and reasonable
30 way of dealing with cases of infringement, and the case differs altogether from any course of business where tyres manufactured abroad were licensed for use in England for commercial purposes, or to an extent which would be likely to invade the trade of the *North British Rubber Company*.

Under these circumstances I do not think that a case has been made out
35 for granting damages for what has been done. Curiously enough—and that shows the position of matters—an injunction was asked for, but at the Bar it was stated the injunction was not wanted, and, I think, rather at my suggestion whether the Defendants would like a declaration, they stated that they would like a declaration, so that I have taken that into consideration as well, but I do not
40 think I could grant a declaration unless what had been proved was shown to be a case giving rise to the necessity for making such a declaration. Consequently it does not become necessary for me to consider the point that has been argued on the construction of the licence itself, and I must not be understood to have expressed an opinion upon that matter of construction either the one
45 way or the other, because I can see that it is quite possible that the matter may be raised in an entirely new way, or it may disappear altogether. I think, under the circumstances, I ought to refuse the relief asked for in this case on the Counterclaim.

The action was dismissed with costs, including in the costs of the Defendants
50 the costs of and occasioned by the Plaintiffs' application to amend, and any costs thrown away in consequence of it. The Counterclaim was dismissed with costs and a set-off directed.

The Plaintiffs appealed, and the Defendants served notice that, "on the
" hearing of the Plaintiffs' appeal from the judgment of Mr. Justice *Byrne* in
55 " this action, in the event of the Court of Appeal reversing the judgment of

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" Mr Justice *Byrne* upon the claim as to the construction of the licence of " the 23rd of July 1896, the Defendants will contend that they are entitled to " succeed upon their Counterclaim, and will ask that the judgment of Mr. " Justice *Byrne* upon the Counterclaim may be reversed." The Plaintiffs applied to the Court of Appeal to set aside this notice as irregular and 5 embarrassing, but the application was refused.

The appeals came on for hearing on the 1st of March 1904.

The same Counsel appeared as in the Court below.

Terrell, K.C., for the Appellants in the first appeal, that of the Plaintiffs.—
The question on this appeal is whether under the terms of their licence the 10 Defendants can import tyres from abroad and sell them here. In form the action is for infringement, because the Plaintiffs contend that only a restricted licence is granted, and that, so far as the Defendants' acts are outside the licence, the Defendants are infringers. [The facts were stated.] The licence is only to manufacture and sell; but the Defendants do not manufacture 15 the tyres complained of, but have entered into an Agreement with *Michelin & Co.*, and the Defendants sell tyres made by them. The present state of things is different from that at the time of the licence, motor-car tyres not being then contemplated in fixing the royalty. [The Agreement of the 1st of May 1896 was read, and also the assignment of the Patent and the licence of the 20 23rd of July 1896.] Clause 8 of the licence forbids the licensors to grant any other licence except as therein mentioned. The licence is treated as a personal one. [*STIRLING, L.J.*—Could the Plaintiffs grant another licence to sell and not manufacture?] The Plaintiffs must be entitled to licence purchasers from them to sell. Clauses 8 and 14 work together; under clause 14 the licensees are 25 not to bring in other persons either as assignees or sub-licensees. Subject as therein mentioned, the Plaintiffs and Defendants were together to have the working of the Patent. Clause 14 is not inserted as a matter of course in drawing a licence. It depends whether the royalty is the main thing or other matters—*e.g.*, controlling the trade. A Patentee can make what restrictions he 30 pleases as to locality, user, or otherwise. The licence deals with "manufacturing "and selling," and the royalty is on tyres "manufactured and sold." One question is whether the Defendants were entitled to make *Michelin & Co.* their agents for manufacture. The Plaintiffs, however, contend that this is not the real effect of the Agreement between the Defendants and *Michelin & Co.* [The 35 Agreement was referred to.] The provision that *Michelin & Co.* shall take back unsold tyres is important. The Defendants make themselves the selling agents of *Michelin & Co.* [*VAUGHAN WILLIAMS, L.J.*—In an ordinary licence does "manufacture and sale" mean on the licensee's own premises?] It means by his own servants. In this licence "manufacture" means "manufacture by 40 "themselves." [*STIRLING, L.J.*—The Defendants are a Corporation and must act by agents.] I submit that the licence is meant to be personal, and that the Agreement with *Michelin & Co.* is a sub-licence. The manufacture must be by the Defendants; they cannot go and buy tyres where they like. A licence is something that gives a person some of the profit and advantage of the Patent; 45 here *Michelin & Co.* are given some of the profit of the Patent. [The judgment was read.] Really the Defendants buy the tyres from *Michelin & Co.* at a French port, dividing the profits with *Michelin & Co.* The words "manufacture "and sell" are contradistinguished from "purchase and sell." It would be curious if the Defendants were within the licence if they bought abroad, but not 50 if they bought in England. [*STIRLING, L.J.*—Could not the Defendants employ any firm in England to manufacture for them?] The manufacturers would be infringers. [*STIRLING, L.J.*—If the Defendants employed them to manufacture as agents for them?] The Defendants may manufacture by their servants, but not by agents in this way. [*VAUGHAN WILLIAMS, L.J.*—I am 55 disposed to agree if the person who makes could sue for goods sold and delivered

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as opposed to work and labour done.] Under this Agreement *Michelin & Co.* could only sue for goods sold and delivered. [COZENS-HARDY, *L.J.*—A licence legalises that which would be illegal; an injunction against infringement restrains the Defendants, his servants, and agents.] Yes, but it is possible to
 5 limit a licence so as not to cover manufacture by agents, and I submit that is the case here. The substance of the Agreement with *Michelin & Co.* must be regarded. [*Dixon v. London Small Arms Co.* (L.R. 1 App. Cas. 632) was mentioned.]

Cripps, K.C., and *Bousfield*, K.C., for the Respondents.—It was held in that case
 10 that the defendants were contractors, not agents. In the licence here clause 2 contains a general grant. Clause 3 does not interfere with that generality; it makes a special exemption from royalty. As to clause 4, no question has arisen on it as to royalties; it is common form. Whatever construction may be put on it, it does not cut down the grant. [VAUGHAN WILLIAMS, *L.J.*—Could you
 15 buy and export?] Yes, that does not matter to the licensor. As to the words “manufacture and sell” in clause 4, probably they should be read “manufacture “or sell,” but in any case the grant is not affected. [VAUGHAN WILLIAMS, *L.J.*, referred to “manufacture” in clause 3.] But for that clause the royalty would be payable on tyres therein referred to. Clause 8 shows that the wish of the
 20 licensors was that the Defendants should sell as largely as possible. As regards clause 14, it cannot be said that the Defendants have sub-licensed *Michelin & Co.*, who are abroad. Really the only point made is that the royalty clause points to some limitation. As to the construction of the Agreement with *Michelin & Co.*, we submit that the judgment is right. [VAUGHAN WILLIAMS, *L.J.*—I do not
 25 think there is anything in the sub-licence point. But if *Byrne*, J., was right as to the limitation of clause 2, I am not sure that what has been done under your agreement with *Michelin & Co.* was justified by the licence.] We submit that clause 3 in no way cuts down clause 2. [STIRLING, *L.J.*—If the Defendants pay the royalty, they could manufacture here and sell abroad without the
 30 restrictions of clause 3?] Yes, clause 3 only operates to exempt from royalty. [VAUGHAN WILLIAMS, *L.J.*, referred to the passage in the judgment of *Byrne*, J., commencing “I pause here.”] Clause 4 is said to introduce “manufacture and sale” into clause 2, but we submit “use and exercise” are in themselves the widest possible terms. As to the royalty, we have paid on all tyres dealt in.
 35 [VAUGHAN WILLIAMS, *L.J.*—The measure of the royalty is “manufactured and “sold.” [COZENS-HARDY, *L.J.*—At the end of clause 4 the words are “manufactured or sold.”] In a licence “manufacture” *prima facie* includes manufacture by agents. Here the penalty in case the Defendants did not manufacture and sell as many as possible is important. It is contended for the Plaintiffs
 40 that there is a restriction in this licence on the class of agents. “Manufacture “and sell” are the common-form words in a royalty clause, even in the case of an exclusive licence.

Terrell, K.C., replied.

VAUGHAN WILLIAMS, *L.J.*—In my judgment, the licence granted by
 45 the second clause, which is what we have to deal with, is a full licence, and there is nothing to restrict it at all. The words are, “The licensors do “hereby grant unto the licensees full licence under the Letters Patent mentioned in the second schedule hereto to use and exercise the invention “protected by the said Letters Patent during the term of such Letters Patent.”
 50 It seems to me that, if there had been nothing else at all in this licence, these words “use and exercise” would have enabled the licensees to exercise all the powers under the Letters Patent; they would be entitled to use, exercise, and also to make and vend.

Then, that being so, the suggestion is made that, notwithstanding the generality
 55 of that clause in the licence, it is cut down by what follows. Mr. Justice *Byrne* takes the view that it is cut down by clause 3. I confess I cannot

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agree in that view. All that clause 3 does is to relieve the licensees from payment of a royalty in the particular case of manufacturing the goods for export abroad provided that the goods are marked "Not licensed for use in the "United Kingdom," or other similar words. But Mr. Justice *Byrne* does not take that view. He says in his judgment, "I pause here for one moment to say 5
"that any possible question that might have been raised as to the generality of
"the terms of clause 2 by reason of the absence of the words 'manufacture and
"sale'—the words being simply 'use and exercise'—is entirely got rid of by
"the reference in clause 4 to 'manufacture or sale' under clause 2." So far I follow him and understand it. "Therefore if clause 2 stood alone, it would be 10
"simply a general licence conferring, I imagine, all such right as a Patentee
"can give to a licensee." So far I still agree with Mr. Justice *Byrne*. Then comes, "Clause 3, however, obviously limits to some extent what might be
"done by a general licensee, having no terms imposed on him, because I
"apprehend that, under a general licence, he would be entitled to sell abroad, and 15
"the goods might come back again into England after he had sold them abroad;
"and I think that that forms one limit to the generality of the preceding
"words." I do not agree with that. It seems to me that the only effect of
clause 3 is not to limit the generality of the licence, but to relieve the licensees from the payment of royalties in the particular case upon certain express conditions. That being so, the learned Judge passes on to the additional clauses, and afterwards continues, "I have said it appears to me that clause 2, having regard to
"what is said in clause 4, begins by a general licence. Clause 3 has a double object.
"It exempts from royalty. It is for the benefit, so far, of the licensees, and it
"limits the generality by forbidding what I think might otherwise have been 25
"done under the general licence. This is to be observed, that under clause 4 the
"royalties are payable in respect of the things manufactured and sold, and that
"expression occurs more than once, and was a good deal dwelt upon by the
"Plaintiffs, naturally, in their argument." Then the learned Judge goes on,
"As to the first question, I think that the true meaning of this Agreement 30
"is that the goods sold under the licence must be manufactured by the licensees,
"I also think that they are not the less manufactured by them within the meaning
"of the clause if they are manufactured for them by a third party and a price is
"paid for that." If I took the same view that the learned Judge does apparently
there as to the generality of the licence being limited by the user, in these 35
clauses, of the words "manufactured and sold," I do not think that I should agree with him that in such a case the mere purchase in a shop or from a maker came within the words controlling the licence. But I do not agree really in the first stage of this. I do not think that when these words "manufactured and
"sold," as they appear in all these various clauses, are looked at, they are 40
intended or should be allowed in any way to control the general grant in clause 2. I think that these words are only used for the purpose of the measure of that upon which the royalty is to be paid; and I think they are not intended in any way to limit the grant. It is quite plain that, generally speaking, these words "manufacture and sell" would form a 45
complete and convenient measure of the royalties to be paid. It is not intended that a royalty should be paid under this licence if the licensees simply manufacture and keep something for themselves. What is practically intended is that, if they manufacture and sell they should pay, and that is why these words are introduced here. It would have been better if the words had run "manufac- 50
"tured or sold," but they do not. They run here "manufactured and sold," but
I think that really one ought to read the words here as if they had been
"manufactured or sold." As Lord Justice *Cozens-Hardy* has pointed out, at the end of clause 4 you find the very words "manufactured or sold,"
and they are used in respect of the identical subject-matter, the measure of 55
the royalty.

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Under these circumstances, I think we ought to hold that the general licence granted by clause 2 is not cut down by these words to which our attention has been called and the effect of that will be that we must, under those circumstances, support the judgment of Mr. Justice *Byrne*, although, as far as I am
5 concerned, not quite upon the same grounds as the learned Judge puts it.

STIRLING, *L.J.*—I am of the same opinion. The first question is as to the meaning of the words “use and exercise” in the second clause of the licence. By that clause the licensors, who are the owners of the Patent, granted to the licensees full licence under the Patent to use and exercise the invention protected
10 by the Patent. Now the grant, by the Crown, which is contained in a Patent, is a grant to “make, use, exercise, and vend the invention.” Only two words are used in the licence—“use and exercise”; but it seems to me quite plain on the licence itself that the four words were meant to be included, and that the licence is to be read just as fully in favour of the licensees as if had run “to
15 “make, use, exercise, and vend the invention protected by the Letters Patent.” I come to that conclusion, first of all, because the language of clause 2 is “full “licence under the Patent”—not intended to be a limited licence—and, secondly, because it is quite plain from the language of clause 4 that “manufacture and “sale” were intended to be amongst the matters which were to be authorised
20 by the licence.

Then we come to this question—is there any limit introduced into this wide grant in clause 2 by the use of the words “manufactured and sold” in clause 4? I think not. In the first place, I agree with what has been said by my Lord that clause 3 does not limit the grant; that the object of it is simply in the
25 particular circumstances to exempt from the payment of royalties, not to limit the operation of the grant; and I also think that the true meaning of clause 4 is not to limit the operation, even as regards royalties, in the way in which I was at first inclined to read it. I think that the royalty is not confined to tyres which are both manufactured and sold by the licensees, but that really the word “and”
30 there ought to be read as “or” in substance. I say so because I think that is agreeable to the general scope of the licence. If the full words “make, use, exercise, and “vend the invention” had been found in clause 2, “and” there would certainly not have meant that the licensees were to do a combination of all those four things together, but that the licence intended them to be done separately, and that
35 whether the invention was used by itself, or exercised by itself, or made by itself, or vendied by itself, it was within the scope of the licence. Equally, it seems to me that in clause 4, whether the tyres are manufactured or whether they are sold, royalties are to be paid for them. That makes the whole scheme of the licence fit together, and does justice between the parties.

But I must add, for myself, that even supposing the true construction were that “use and exercise” were simply “manufactured and sold,” and that “and” were to be read in the strict literal meaning, I still think that the judgment of the learned Judge is correct. I think that the licensees were entitled to manu-
40 facture by their agents, and upon the documents which are in evidence before us, I cannot come to any other conclusion than that *Michelin & Co.*, the French manufacturers, were for this purpose agents of the licensees.

COZENS-HARDY, *L.J.*—I am of the same opinion. Mr. Justice *Byrne* decided against the Plaintiffs on two grounds. First, that the licensees may manufacture by an agent, and is not bound to manufacture at his own works.
50 I agree with that proposition. He also held that *Michelin & Co.* were agents of the licensees. I certainly do not desire to be considered as in way dissenting from that conclusion, although I do not think it necessary or desirable to express a positive opinion upon that point. I prefer to base my judgment upon the broader ground pointed out by my Lord. It seems to me that the generality
55 of the grant contained in clause 2 cannot properly be cut down by referring to the language in the royalty clause.

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Cripps, K.C.—The appeal will be dismissed with costs.

VAUGHAN WILLIAMS, L.J.—Yes.

Terrell, K.C.—May I ask your Lordship what you are going to do with the next appeal, which is the Defendants' appeal in this case?

Cripps, K.C.—The Defendants gave this notice:—"Take notice that on the 5
"hearing of the Plaintiffs' appeal from the judgment of Mr. Justice *Byrne* in
"this action, in the event of the Court of Appeal reversing the judgment of
"Mr. Justice *Byrne* upon the Claim as to the construction of the licence of
"July 23rd 1896, the Defendants will contend that they are entitled to succeed
"upon their Counterclaim, and will ask that the judgment of Mr. Justice *Byrne* 10
"upon the Counterclaim may be reversed." The Defendants do not want to go
on with that at all.

Terrell, K.C.—I ask that the appeal be dismissed.

Cripps, K.C.—There are no costs involved in it.

Terrell, K.C.—There are indeed. It is a separate and totally different 15
thing.

STIRLING, L.J.—If there are any extra costs occasioned by that notice to the Plaintiffs, the Defendants ought to bear them.

Cripps, K.C.—How can there be any extra costs involved?

Terrell, K.C.—The whole of the printing of the shorthand notes. 20

VAUGHAN WILLIAMS, L.J.—You must not suppose that, even if you are right, the whole of the printing of the shorthand writer's notes would be included in the costs allowed.

Terrell, K.C.—The Defendants' appeal is on a totally different ground 25
altogether.

VAUGHAN WILLIAMS, L.J.—So I understand, and there may be some trifling costs, and those you ought to have.

Terrell, K.C.—The whole of the evidence was on the cross appeal. There was no evidence taken on the point just decided. The learned Judge treated the matter as two cases. He heard the first case first and gave judgment upon it, 30
and then he heard the Counterclaim and gave judgment on it.

VAUGHAN WILLIAMS, L.J.—The Taxing Master will deal with it.

Terrell, K.C.—I understand the Plaintiffs are to have such costs as have been occasioned by the appeal of the Defendants on the Counterclaim.

Cripps, K.C.—I cannot imagine that there has been anything incurred as 35
regards that. If there is anything I suppose the Defendants will have to pay it.

VAUGHAN WILLIAMS, L.J.—Yes, the increased costs.

Neostyle Manufacturing Company, Ltd. v. Ellam's Duplicator Company.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BYRNE.

December 4th, 5th, 8th, 9th, 10th, and 21st, 1903.

NEOSTYLE MANUFACTURING COMPANY, LD. v. ELLAM'S DUPLICATOR
COMPANY.

Passing off.—Trade name of goods.—Description of accessories for use in connection with Plaintiffs' machine.—No exclusive right in Plaintiffs to name in connection with accessories.—Judgment for Defendants.

The Neostyle Manufacturing Company, which traded in duplicating machines
10 and manufactured and sold accessories for use therewith, which machines and accessories they sold under the name "Neostyle," commenced an action to restrain another Company from passing off ink, paper, and stationery not of the Plaintiffs' manufacture or merchandise as and for the goods of the Plaintiffs by the use of the word "Neostyle" or otherwise, and from infringing their Trade
15 Mark "Neostyle," registered in Class 39 in respect of paper, stationery, and bookbinding. Before the trial the Trade Mark was ordered by the Court of Appeal to be removed from the Register on the ground that the Plaintiffs had not an exclusive right to the word "Neostyle" for such goods (Neostyle Manufacturing Company's Trade Mark, 20 R.P.C. 803). The Defendants
20 alleged inter alia that the term "Neostyle" was not distinctive of the Plaintiffs' goods, and that, as applied to paper ink and accessories, it meant that such paper, ink and accessories were suitable for use in the "Neostyle" machine. The Defendants had described their accessories as being "for the Neostyle," and had used the term "Neostyle Ink" in a catalogue meant for the trade, and two
25 cases of sale of "Neostyle Ink" were proved. At the trial the Plaintiffs adduced evidence to establish a case of passing off by means of the tins in which the Defendants sold their "ink for the Neostyle," which tins had not in all cases the Defendants' name on them.

Held, that, although the word "Neostyle" had become identified in England
30 with the Plaintiffs' duplicating machines, they had never had any exclusive right to the word in connection with duplicator accessories; that the Defendants

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might sell ink and paper for use on the "Neostyle" machine, and so describe them, provided that they did not by words or get-up represent their goods as those of the Plaintiffs; that there had been no passing off by the Defendants; and that the Plaintiffs had failed to establish a case entitling them to an injunction; but the Court suggested that the Defendants' name should always appear on the tins of ink sold by them. The action was dismissed with costs.

On the 15th of July 1902 the *Neostyle Manufacturing Company, Ltd.*, commenced an action against *Ellam's Duplicator Company* claiming an injunction to restrain the Defendants, their servants and agents, from in any manner passing off any ink, paper, stationery or other requisites not of the Plaintiffs' manufacture or merchandise as or for the Plaintiffs' goods, whether by the use of the name under which the same was sold or otherwise nowsoever; and from selling or offering or exposing or advertising for sale, or procuring to be sold, any such goods as aforesaid under the name "Neostyle" or under any other name which, by colourable imitation of such name or otherwise, was calculated to represent or lead to the belief that such goods were the Plaintiffs' goods; and from in any way infringing the Plaintiffs' registered Trade Mark No. 241,492, and for other relief.

The Plaintiffs by their Statement of Claim alleged—(1) that they were a limited Company, which carried on business as manufacturers and vendors of stationery and similar articles; (2) that the various articles manufactured by or for the Plaintiffs and sold by them were distinguished by them from all goods of a similar character by the Trade Mark and trade name "Neostyle," which was specially invented for and had for several years past been used by them and their predecessors in business for that purpose, and such name indicated exclusively that the inks, paper, and other articles of stationery sold thereunder had been manufactured by or for the Plaintiff Company, and the same carried their guarantee of excellence in respect of the make, quality, and style of the goods; (3) that in October 1901 the Plaintiff Company obtained registration of the said invented and distinctive word "Neostyle" as their Trade Mark No. 241,492 in respect of paper (except paper-hangings), stationery, and bookbinding in Class 39, and the same was standing on the Register in their name*; (4) that the Plaintiffs had expended large sums of money in advertising their said goods under the name and Trade Mark aforesaid, and by reason of the excellence of such goods, and of the novelty and distinctiveness of the said word "Neostyle," and of the Plaintiffs' energy and expenditure, such goods had become and were well known to the public under such name and Trade Mark as aforesaid, and anyone who asked for or ordered "Neostyle" ink, paper, stationery or the like, intended and expected to receive the goods of the Plaintiff Company and no others; that the said name and Trade Mark were of great value to the Plaintiffs, and it was of extreme importance to them that the same should not be copied or imitated by others; (5) that the Defendants, who carried on in London a business of a similar character to the Plaintiffs, had recently begun to offer for sale and sell and invoice articles of stationery such as ink, paper, and the like under the said name "Neostyle," and thereby to cause such goods to be passed off and sold as and for the goods of the Plaintiff Company; that previously to their commencing to do so the Defendants were in the habit of selling similar articles under other names, and

* This mark was, however, before the trial ordered by the Court of Appeal to be removed from the Register (see *Neostyle Manufacturing Company's Trade Mark*, 20 R.P.O. 803) on the ground that *David Geisler* had certain rights in the word and the Plaintiffs were not exclusively entitled to the use of it.

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the adoption and use by the Defendants of the said name "Neostyle" in manner aforesaid had taken place with full knowledge on their part of the Plaintiffs' rights, and could only have originated in a desire to imitate the Plaintiffs' goods; and (6) that the use by the Defendants of the said name "Neostyle" in manner aforesaid was calculated to pass off their goods as the goods of the Plaintiffs, and that the Plaintiffs had suffered damage.

The Defendants by their Defence alleged—(1) that the term "Neostyle" was in the year 1889 invented by and had been continuously used by *David Gestetner* to indicate pens, ink, paper and other stationery manufactured and sold by him both in this realm and in the United States; (2) that *David Gestetner* was not the predecessor in business of the Plaintiff Company, and the term "Neostyle" was adopted by the Plaintiff Company without the leave or licence of *Gestetner*; (3) that the term "Neostyle" was not distinctive of the goods of the Plaintiff Company as alleged or at all; (4) that there were no predecessors in title of the Plaintiff Company; that one *Klaber*, who was for several years in the employment of *Gestetner* in the United States, and was afterwards in the employment of the *Neostyle Company* of America (a Company formed to deal in the goods of *Gestetner* in the United States) left the employment of the said Company in the year 1899, and came to this country and purported to convey to the Plaintiff Company the right to use the name "Neostyle"; that *Klaber* had no business in connection with the term "Neostyle" or any business at all, and had no power to grant to the Plaintiff Company the right to use the term "Neostyle" and no business to convey in connection with such term; (5) that the word "Neostyle" was wrongly registered by the Plaintiff Company as its Trade Mark; that it was not invented by or for the Plaintiffs, but was a word in common use in the trade to describe the goods of *Gestetner**; (6) that the said word "Neostyle" was improperly placed upon the Register by the Plaintiff Company and should be removed, and that a motion to the Court was pending in which *Gestetner* was moving to rectify the Register by the removal of the said mark; (7) that if the Plaintiff Company had by reason of Trade Mark or user acquired any right to the term "Neostyle," which was wholly denied, the said right had been so acquired in connection with the use by the Plaintiff Company of the said term to describe a particular kind of copying machine manufactured and sold by them and no further or otherwise; (8) that in connection with the said copying machine paper of a suitable size and quality, and ink of a suitable quality, and other stationery of a suitable size and quality was used; (9) that the Defendants, who were manufacturers and sellers of paper, ink, stationery and copying accessories suitable for all classes of copying machines, described the ink, paper and accessories, so sold by them for use with each different kind of copying machine, as paper, ink or accessories for such and such machine, and *inter alia* paper, ink and accessories for use in the "Neostyle" machine was so described, or, shortly, was described as "Neostyle" paper ink or accessories, the term "Neostyle" being the abbreviated title by which the Plaintiffs' copying machine was commonly known; (10) that the term "Neostyle" as applied to paper, ink and accessories did not mean that such paper ink or accessories were manufactured by the Plaintiff Company, but that such paper ink and stationery were suitable for use in the "Neostyle" machine; (11) that the use of the term "Neostyle" in connection with paper, ink and stationery, in the meaning set out in the preceding paragraph, was common to the whole trade in typewriting and copying machine accessories, and such term was used by the whole trade with such meaning, and the use of the said term in the said connection was so understood by the whole trade and public, and no person had

* See footnote on page 186.

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or could be deceived into believing that by such use of the term "Neostyle" the goods manufactured by the Plaintiff Company were intended, nor could, nor had the goods of the Defendants been passed off as the goods of the Plaintiffs by any such use of the term "Neostyle"; (12) save as therein admitted the Defendants denied each and every of the facts alleged in the Statement of Claim, as if the same were specifically denied. 5

Asbury, K.C., and *L. B. Sebastian* (instructed by *C. Urquhart Fisher*) appeared for the Plaintiffs; *T. Terrell, K.C.*, *A. J. Walter*, and *C. Terrell* (instructed by *Pritchard, Englefield & Co.*) appeared for the Defendants.

Asbury, K.C., opened the Plaintiffs' case.—The Trade Mark has since the commencement of the action been ordered by the Court of Appeal to be removed from the Register, and the Plaintiffs can now rely only on passing off. [The facts were then stated.] "Neostyle" has in England become identified with the Plaintiffs and their goods; they are known as the *Neostyle Company*, and their duplicator is called the "Neostyle." Since 1900 they have done an enormous business in "Neostyle" goods; *Gestetner* has only used the word on goods exported by him to America. The Defendants will say that the use of "Neostyle" for accessories means that the goods are for use in "Neostyle" instruments, and will also rely on the decision of the Court of Appeal that the Plaintiffs were not entitled to have the word on the Register, as that might interfere with *Gestetner's* use. But the decision does not deal with any question of passing off, and only makes the proof of the secondary meaning of the word more difficult. If "Neostyle" means the goods of the Plaintiffs, then, if *Gestetner* sold his goods in England under that name, he would be in no better position than the Defendants. It has not been held that *Gestetner* is entitled to the use of the word in this country. The Defendants have followed the get-up of the Plaintiffs' goods. [*Walter*.—That is not alleged in the pleadings.] There will be evidence of an intention to pass off. The Defendants sell "Neostyle Ink" in tins which fit the tops which we supply to our customers, instead of the Defendants selling square tins as formerly. [The judgments of the Court of Appeal in the *Neostyle Manufacturing Company's Trade Mark* (20 R.P.C. 803) were then read, and the judgment of *Kekewich, J.* (20 R.P.C. 329) was referred to.] The Plaintiffs may not have such an exclusive right as to entitle them to registration, but still the word may have a secondary meaning denoting their goods. *Gestetner's* goods have never been on the market in this country under the name "Neostyle." No one has a right to pass off his goods as those of another person; there is no limitation to that proposition. 10 15 20 25 30 35

The evidence for the Plaintiffs was then taken. The following witnesses were called :—*A. D. Klaber, A. S. Newmark, J. F. M. Bowden, G. Davidson, W. B. Perry, M. J. Douglas Carter, M. Macfarlane, E. F. Innes, V. Jones, G. Barrett, F. Payne, R. Hanger, M. Bartholomew, F. W. Schafer, A. E. George, E. Wyatt, and C. U. Fisher.* 40

Walter opened the Defendants' case.—The case for the Plaintiffs must be that they have acquired an exclusive right to the word "Neostyle"—that is to say, that it denotes their goods and the goods of no one else, and that this applies not only to the duplicating machine but to ink and stencil paper. The Plaintiffs knew of *Gestetner*, and that he was doing a large trade in stencil paper, and their witnesses would not swear that "Neostyle" was not on it. It is proved that a machine called the "Neostyle" is well known on the market, and that ink and paper for use in various duplicating machines are made and are described by the machines with which they are to be used. There is no custom limiting the manufacture to the maker of the machines. "Neostyle Ink" and "Neostyle Paper" mean merely ink and paper for use in "Neostyle" machines. The exclusive right is not established by the Plaintiffs' evidence, and I shall call a large body of trade evidence on the point. Since 45 50 55

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1889 every sheet of stencil paper circulated by *Gestetner* in this country has had the word "Neostyle" on it. No case of passing off has been made out.

The following witnesses were called on behalf of the Defendants :—*F. Ellam*, one of the partners in the Defendant Company ; *A. Foote*, *D. Gestetner*, *A. Cattell*, *F. J. Odden*, *S. Eldod*, and *G. F. Ackhurst*.

Terrell, K.C., summed up the Defendants' case.—This case is important in this way, that it deals with a system by which a name is given to an article, and then confusion is introduced between the name of the article and that of the seller, so that when ordering the article one cannot help using the name of the seller. Here the Plaintiffs have so contrived with regard to the "Neostyle" machine, which is a machine of a particular construction, and the *Neostyle Manufacturing Company*, that people cannot deal either in the machine or its fittings and accessories without using the word "Neostyle," and then the Plaintiffs contend that the word indicates their goods. This case is like *Singer Manufacturing Company v. Loog* (L.R. 8 App. Cas. 15), where it was held that a person might describe a sewing machine as being made on the "*Singer*" system. The present case was launched both as a Trade Mark case and a passing off case, but the Court of Appeal have decided that the word "Neostyle" was not the exclusive property of the Plaintiffs, and therefore it cannot have been descriptive of the Plaintiffs' goods at the date of its registration. [The facts were then referred to.] *Gestetner* was the first to use the word, and has had a right to use it from 1889 onwards ; he could have registered it in the first instance. The Plaintiffs have taken the word knowing of his rights ; and, if they cannot stop *Gestetner*, they cannot stop the Defendants from using it. Secondly, the Defendants have an absolute right to the use of the word—it belongs to the public by reason of its use ; at all events it is not the Plaintiffs' property ; *Gestetner* may have a right to register it as being the first user. Assuming for this part of the case that the Defendants have not got the absolute right to use the word, is what they do calculated to deceive ? They have a right to sell the particular ink and to describe it ; how can they do it except by saying it is for the "Neostyle ?" If there is any mistake it is due to the Plaintiffs calling the machine and their Company by one name. There is no case in which it has been held to be passing off to use merely a word to which the Plaintiffs have not an exclusive right. On the facts I submit that what the Defendants have done is not calculated to deceive.

Astbury, K.C., in reply.—The case has materially altered since its commencement. As to the allegation that the word did not at the commencement of the action mean exclusively the Plaintiffs' goods, there would be a difficulty in the Plaintiffs' way in the absence of fraud, and if the case depended on the use of the word *simpliciter*. But directly it is shown that the Defendants' conduct is dishonest, then it is not necessary to prove an exclusive right to or meaning of the word. The Defendant *Ellam* has really admitted that the word "Neostyle" used *simpliciter* means the Plaintiffs' goods, and that "Neostyle Ink" means their ink. The words "for the Neostyle" are at least ambiguous, and, if anything is done to assist in a deception, then there can be no defence. It does not matter how many other people are entitled to use the word "Neostyle" if, as I submit on the facts, the Defendants have committed a fraudulent deception and passed off their goods as the Plaintiffs', they are liable in damages. *Singer Manufacturing Company v. Spence* (10 R.P.O. 297) shows that this is so. The Defendants might in their catalogue have described their ink as "*Ellam's Ink for the Neostyle*" if they had really wanted to distinguish. Then the Defendants make their tins of such a size and shape that the tops which the Plaintiffs furnish for use with their own tins fit the Defendants' tins. The question is, whether the Defendants are passing off their goods as those of the Plaintiffs (*Reddaway v. Banham*, 13 R.P.C. 218 ; L.R. (1896) App. Cas. 199). Even though *Gestetner* may with certain precautions and

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under certain circumstances use the word "Neostyle," that does not entitle the Defendants to pass off their goods as those of the Plaintiffs. [*Perry v. Truefitt* (6 Beav. 66) was referred to.] A passing off case is a common law action on the case for fraud (*Rodgers v. Nowill*, 3 D. M. & G. 614); the action had its origin in the old action of deceit. [BYRNE, J., pointed out that in an action of deceit the Plaintiff alleges that he is deceived.] The Plaintiff in a passing off action must establish that he has been injured by a wrongful act on the part of the Defendant which injures the Plaintiff's business by reason of the Defendant's goods being passed off as his. In modern times the action has been extended to cases in which there is no dishonest intention if the mark or expression used refers exclusively to the Plaintiff's goods. [The facts were further referred to.]

Judgment was reserved, and delivered on the 21st of December 1903.

BYRNE, J.—This is an action by the *Neostyle Manufacturing Company* to restrain the Defendant Company from passing off ink, paper, stationery &c., not of the Plaintiffs' manufacture or merchandise as and for the Plaintiffs' goods by use of the name "Neostyle" or otherwise, and from infringing the Trade Mark "Neostyle."

So much of the case as is founded on Trade Mark has gone, because the mark has been struck off the Register by order of the Court of Appeal. The mark was struck off at the instance of Mr. *Gestetner*, a witness in the present case, because, in the opinion of the Court of Appeal, the present Plaintiffs had failed to establish such an exclusive right to the word "Neostyle" as to entitle them to registration.

The Defendants in the present case were not parties to the proceedings to rectify the Register, and although the Plaintiffs' Counsel appreciated and mentioned at the outset the difficulties in his way, owing to the decision in the Court of Appeal and to the Trade Mark having gone, he elected to proceed with the action, proposing to establish a case of passing off. A good deal of the evidence which I have heard is a repetition of the evidence already given in the other proceedings. I must, however, shortly deal with the facts. *Gestetner* was sole licensee in America for a Patent for a duplicating machine known as the "Cyclostyle," which he was also entitled to sell in England. On the 3rd of October 1884 an Agreement was entered into between *Gestetner* and *Klaber* whereunder *Klaber* was to sell "Cyclostyle" goods in America, such goods to be supplied by *Gestetner* from England. For use with duplicating machines certain accessories are necessary, such as ink, stencil paper, and other paper, and occasionally pens, and in this particular case stencil paper and pens were supplied. This Agreement of the 3rd of October 1884 was acted upon until the date of the next Agreement. Late in 1887, or the beginning of 1888, *Klaber* says he invented the word "Neostyle" for application to a machine invented by him in America. In 1888 *Gestetner* made some improvements in the "Cyclostyle" machine and began to use the word "Neo-Cyclostyle" in connection with it. He went to America in this year, and there was some discussion about adopting the word "Neostyle" for goods thereafter to be sent to America by *Gestetner*. On the 15th of January 1889 a second Agreement was entered into between *Gestetner* and *Klaber* which varied the rights of the parties. *Gestetner* went on supplying goods as before, but the word "Neostyle" was applied to goods so supplied by *Gestetner*—certainly to pens and prepared paper and the words "Cyclostyle" and "Neostyle" were treated as synonymous. On the 30th of August 1893 an Agreement was entered into between *Gestetner* and the *Neostyle Company*, a new American Company, to whom *Klaber* had assigned his interest. *Klaber*, though not a party, knew of and assented to this Agreement. Under it all "Cyclostyle" pens and paper were to be purchased from *Gestetner* at stipulated prices. In the Agreement there was a clause whereby it was "covenanted and agreed that should the party of the first part

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- "cancel this Agreement as herein provided for, then all labels, Trade Marks, and designations in use by the party of the second part appertaining to 'Cyclostyle' pens and 'Cyclostyle' paper shall revert to and become the sole property of the party of the first part, and the party of the second part shall not thereafter
- 5 "employ or use said labels, Trade Marks, or designations for any purpose whatsoever." The party of the first part was *Gestetner* and the American Company, the *Neostyle Company*, was the party of the second part. *Klaber* was the person mainly interested in the American Company. The Court of Appeal have held that any rights *Klaber* had, either in the original Trade Marks, or in
- 10 any Trade Marks subsequently adopted, passed from *Klaber* to the new Company; but it was said by Lord Justice *Vaughan Williams* there was very little to pass as far as *Klaber* was concerned. The Lord Justice, after reading a portion of the last Agreement, said: "One thing is quite plain under that Agreement, that any rights that *Klaber* had either in the original
- 15 "Trade Marks used (including unregistered Trade Marks) or in any Trade Marks which were afterwards adopted passed from *Klaber* to the new Company so far as *Klaber* was concerned, but really so far as *Klaber* was concerned there was very little indeed to pass, because by the seventh clause of the Agreement of 1889 it was provided that 'the said party of the
- 20 "second part is also hereby exclusively licensed or empowered for the United States to use the title, Trade Mark, or designation of "Cyclostyle" or any variation, modification, addition, change, or alteration made and adopted or used by the said party of the first part in connection with duplicating or copying apparatuses. Nor shall he sell any "Cyclostyle" machines unless the same
- 25 "shall have properly affixed thereto the label and Trade Mark of the party of the first part hereto." In January 1899 *Klaber*, being minded to establish a business in England for the sale of goods similar to some of those sold by the American Company, sent over two clerks to see if they could establish a business in London, and they traded as the "*Neostyle Manufacturing Com-*
- 30 "*pany*," using the word "Neostyle" to designate their machine. *Klaber* received reports from time to time and determined to come to England himself, which he did in the month of November 1899. He got rid of most of his interest in the American Company, retaining only a few shares. *Klaber* pushed the business in England and caused the Plaintiff Company to be registered as a
- 35 limited Company about February 1900, under its present name. The Plaintiffs' duplicating machines have always been sold as the "Neostyle," and the accessories for such machines have been sold by them in connection with the same name. There can be no doubt that in England the word "Neostyle" has become identified with the machine of the Plaintiffs, but they (the Plaintiffs)
- 40 have certainly never had any exclusive right to the word in connection with duplicator accessories. *Gestetner* has sold and sells in England, apart from goods he still supplies from England to America, large quantities of stencil paper with a caution upon it in these terms: "Caution. Each genuine sheet of 'Cyclostyle' or 'Neostyle' or 'Neo-Cyclostyle' paper must bear the
- 45 "signature of the Inventor, as follows: '*D. Gestetner*.' Any sheet not bearing this signature is a worthless imitation and will be found to clog and spoil the pen and give very inferior results." I am satisfied that similar paper with this caution upon it has been sold in large quantities by *Gestetner* for at least ten or twelve years past.
- 50 The truth appears to be that there has been a user by *Klaber* and the Plaintiff Company of the word "Neostyle," and they could not, so far as I can see, now be stopped from using the word to designate their machine and goods, but they have never acquired a right to say that the word designates their goods and no others.
- 55 There are a large number of duplicating machines upon the market, and it appears to be a common practice for the makers who manufacture their own

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accessories, to make and sell accessories also for other machines. The Plaintiff Company does so itself, and a type-written list of theirs used for instructions to agents was produced, in which they include sizes and price of typo-stencil papers manufactured by themselves—amongst other things, "For use on 'Cyclostyle,' Order as Cyclo-Typo, stating size," "For use on *Ellam's Mimeo-* 5
"graphs and Typewriter Duplicators" (that is on the Defendants' machines), "Order as Mimeo-Typo, stating size." This, which was, I think, dated after the institution of the present action, *Klaber* describes as carrying the war into the enemy's camp. They also sell ink for all copying machines. Mr. *Sinclair*, a witness who was called for the Plaintiff Company, sells ink which he calls 10
ink "for the Neostyle." He says he would not call it "Neostyle Ink," that he should not give his ink if asked for "Neostyle Ink," he would sell ink as ink "for the Cyclostyle," but not as "Cyclostyle Ink"; he has sold ink "for use with the Neostyle" without any other name on it. I think this is making a very fine distinction; at all events he justifies selling as the Defendants do in tins 15
"Ink for the Neostyle." The form of Admiralty tender refers to tenders for ink "for use with the Neostyle." *Sinclair* now holds a Government contract and supplies paper of his own manufacture.

The Defendants, besides making their own machine and accessories, sell accessories for all apparatuses, and certain matters appear by the evidence 20
though not pleaded or alleged as part of the Plaintiffs' case upon which they ask for judgment. The Defendants have sold and sell ink "for the Neostyle," meaning the Plaintiffs' machine, in tins with labels upon them to this effect: "Ink for the Neostyle—Purple, Best Quality, Odourless." This ink is sold in tins with this label upon it, and without any name appearing upon the tin. 25
The tins are usually, if not always, sold in boxes similar to the one I now hold in my hand, a coloured box. I am told, though I have not seen any other specimens of the label, that the labels are printed in the colour of the ink contained in the tin. The actual form of tin is common, but the special size was copied from the Plaintiffs' size. The tins, it is said, and I believe truly 30
said, though there seemed to be a difficulty in fitting in some cases, are made of such a size as to enable lids which are sold with the Plaintiffs' goods to be fitted into those tins just in the same way as they can be fitted into the Plaintiffs' tins. Then there was put in evidence a catalogue of the Defendant Company, who describe themselves as "The largest makers in the world of Duplicators, 35
"Stencil Paper for all copiers, Stencil Ink for all copiers, Impression Paper, "Ribbons, Carbons, Letter Copiers," and so on, and at page 11 they have this advertisement: "Stencil Ink for all apparatuses, for hand and typewriting, in "all colours—Black, blue, purple, green, red. Unequalled the world over for "softness and ease of working. It never tears or spoils the stencil." Then 40
there are some prices given. Then, "Copying inks also supplied. Neostyle inks " (any colour), small 4s., large 7s. 6d." I may say at once that I do not think this last catalogue is calculated to deceive anyone. It is an advertisement obviously meant for the trade and is one which, I think, to anyone looking at it would show that it was an advertisement of persons selling goods of their 45
own make. They also sell stencil paper marked "For the Neostyle."

There were two cases of sale by the Defendants proved, one to a lad in the employment of the Plaintiffs' Solicitor, and the other to *Alfred George*, of Defendants' ink in the tins as "Neostyle Ink"; Neostyle ink being asked for, and invoices being given describing the goods as "Neostyle Ink." Except as 50
appears by the invoices I cannot attach much weight to the case of the purchase by the lad *Hanger*. It was in July 1902, and the witness's recollection was not very clear as to what took place. The other case, which was in January 1902, I do not think carries the matter further than the description in the invoice.

A reference to the Statement of Claim shows that the whole complaint was 55
founded on a sole right to the use of the word "Neostyle" in any form, which

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would prevent anyone other than the Plaintiffs selling ink for use in the "Neostyle" machine as they would not be able to describe what it was.

This contention cannot be upheld. I am clearly of opinion that the Defendants and other manufacturers may sell ink and paper for use on the
5 "Neostyle" machine, and to do it they must say so, but of course they must not by words or get-up represent their goods as the Plaintiffs' goods. I cannot say that the Defendants have done this. Their get-up is wholly different, though the tins are the same shape and size. I think it would be right for the Defendants to put their own names on all their labels showing that they are selling
10 their manufactures, as the absence of it may cause confusion or mistake, but really this was never complained of by the Plaintiffs, nor does it form any part of the case made by the pleadings, which are directed against any use of the word "Neostyle."

In substance I think the only possible ground of complaint would be that
15 the Defendants do not put their names on their labels. But this point was not made until it was seen that the case as originally made could not be sustained, and there is no suggestion that the labels resemble the Plaintiffs' labels. The real issue between the parties was whether or not the Plaintiffs have such an exclusive right to the word "Neostyle" as to prevent any use of it whatever.
20 The charge grounded on this was one of fraud, and ought to be made out strictly as alleged.

On the whole of the facts I do not think that the Plaintiffs have made out a case to entitle them to an injunction in this action. I should be glad to know that the Defendants, notwithstanding that, will accept my suggestion and put
25 their names on their future tins of ink. Otherwise, it is a thing that is likely to cause confusion, not so much with regard to their immediate buyers as when it gets into the hands of other people. If it got into the hands of a dishonest retailer I think it might possibly lead to confusion.

U. Terrell.—I am instructed that the word has not been made use of in that
30 way for twelve months. The Defendants are grateful for your Lordship's suggestion and will adopt it.

The action was dismissed with costs.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE FARWELL.

February 16th, 1904.

ROBERTS v. GRAYDON.

*Patent.—Agreement.—Construction.—Infringement by making goods outside 5
the Agreement.—Judgment for Plaintiff.*

*R. being the owner of a Patent relating to revolving heel pads, and G. having
filed a Provisional Specification relating to the same subject, R. and G. entered
into an Agreement by way of compromise of an action as follows:—that R.,
admitting G.'s right to manufacture and sell his heel pads in accordance with 10
his Provisional Specification, would undertake not to interfere with such
rights, and would not, further, allege that G.'s heel pads were an infringement
of any of R.'s Patents or repeat threats to G. or his customers; and that
neither party should be at liberty to question the validity of the other's Patents
for revolving heels or heel pads. R. subsequently brought an action against G. 15
alleging that G. was selling heel pads not protected by the Agreement, and
claiming a declaration to that effect and an injunction against infringement.*

*Held, that the Defendant was selling certain heel pads not in accordance with
his Provisional Specification as construed by the parties in the Agreement. A
declaration was made and an injunction was granted accordingly. 20*

On the 12th of September 1896 Letters Patent (No. 20,239 of 1896) were
granted to *George Wood* for "Improvements in revolving heel plates or pads."

The Complete Specification was as follows:—"This invention has reference
"to certain improvements in or in connection with protectors for use on boots
"and shoes and for other purposes for which Letters Patent were granted to 25
"one John Milnes No. 4723 of 1890. In the Specification of the said recited
"Patent are described certain small studs or protectors for boots and shoes
"formed with grooves or channels, into which fits a metal plate, by which the
"studs or protectors are secured to the boot heel by a screw or screws.
"My invention consists in adapting a revolving heel pad or false heel on the 30
"principle of the said Patent, which is to be made in rubber, leather, paper, or
"a combination of guttapercha, and such substances as can be suitably applied
"and made for wear. The object of my invention is to provide a substitute to
"wear on the heel of boots and shoes, so as not to wear down the original heel
"of the boot or shoe, and in case one portion of the pad should become worn, 35
"a fresh surface may be readily presented.

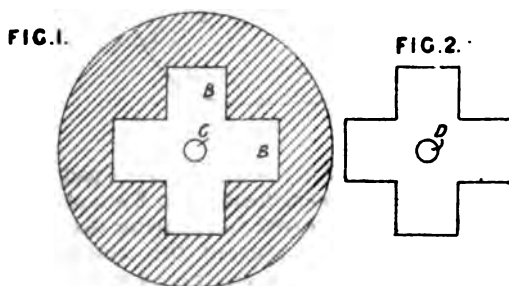
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"In carrying out my invention, I form a disc or circular piece of rubber or other suitable material, and make it of various sizes or thicknesses, so as to be adaptable to the largest or smallest heels, and this piece of rubber is so made or moulded that an ordinary screw or nail shall, with the following
 5 "devices, be sufficient to hold it in position, and allow it to be revolved as required. The pad of leather, rubber, composition, or material, of which my revolving heel plate is made, is preferably formed circular in shape, and is grooved or channelled on its exterior surface for the reception of a metal plate, which fits
 10 "into the said grooves deeply, so as not to come in contact with the ground when being worn. This metal plate is now bored at a central point, and into the hole thus formed a screw nail is inserted to fix the pad to the boot heel. The metal plate may be in the form of a cross, and made to fit into corresponding grooves in the pad or any other suitable shape may be adopted. The pads
 15 "instead of being formed circular may be heel shaped or they may be of any desired form or thickness.

"In the accompanying drawings, Fig. 1 represents the heel pad of rubber or other material grooved on its external surface at B, and formed with a central hole C. It may be ribbed as shewn. Fig. 2 shews the metal plate preferably
 20 "cross-shaped, and provided with a central hole D, which fits into the groove B formed for its reception in the pad represented in Fig. 1. When the plate is placed in position, the screw shewn in Fig. 3 is passed through the central holes in the metal plate, and rubber pad respectively, and tightened on the boot heel, but nevertheless so as to allow the pad to revolve on the surface
 25 "of the boot heel. The whole arrangement and construction of my improved heel plate or pad when fixed is shewn in Fig. 4.

"To prevent fraying of the edges, the rubber pad may be encased with a metal case, which will considerably prevent wear."

The Patentee claimed :—"In revolving heel plates or pads, cutting or grooving or channelling rubber or similar pad represented in Fig. 1 in such
 30 "a way as to receive metal plate shewn in Fig. 2, and providing the same with a central hole for the reception of a screw for fixing to the boot heel, the said pad being free to revolve, and present a fresh surface for wear, substantially as described."



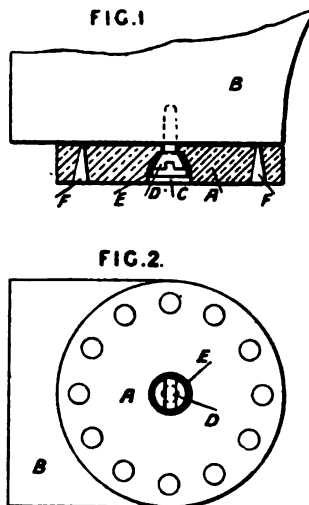
This Patent became vested in *Peter Edwards Roberts*, trading as the *Revolving Heel Company*. On the 21st of May 1901 *Frederick Horsfall Graydon* applied
 35 for Letters Patent for "Improvements in heel plates, or pads for boots, shoes, and the like." The Patent was granted and numbered 10,495 of 1901, but at the date of the Agreement of compromise hereafter mentioned the Complete Specification had not been left at the Patent Office.

The Provisional Specification was as follows :—"The object of my invention
 40 "is to construct rotary or movable heel plates or pads for boots, shoes, or the like so as to be self-adjustable without friction and always maintain a level or straight heel."

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"I preferably form my improved heel plates or pads of one or more leather
 "or wood discs, the diameter of such pad corresponding with that of the boot
 "heel; in the centre of this disc is a perforation, through which passes a screw
 "for attaching the pad to the boot heel. By this construction of revolving heel
 "pad I dispense with the use of metallic discs, plates, or the like for securing the
 "pad to the boot heel thereby allowing the pad to revolve more freely, and
 "automatically adjust itself in such a manner as to wear equally upon its
 "whole surface, so greatly prolonging the life of such pad. I may if desired
 "employ an eyelet within the central perforation for still further reducing the
 "friction of the pad upon the central screw. My improved pad may if desired
 "have a series of metallic pegs inserted around or near the edge for still
 "further increasing its durability."

The Complete Specification, so far as material to this report, was as follows:—
 "The object of my invention is to construct rotary or movable heel plates or
 "pads for boots, shoes, or the like, so as to be self-adjustable, easily attached,
 "without friction, and always maintain a level or straight heel.



"Fig. 1 is a sectional elevation of my improved heel pad showing method of and
 "means for attaching same to a boot heel. Fig. 2 is a plan of Fig. 1. Fig. 3 is a
 "sectional elevation of eyelet employed in securing the pad to the boot heel in
 "order to reduce the friction and prevent the central perforation in the pad
 "from becoming enlarged from any cause. Fig. 4 is a sectional elevation of my
 "improved heel pad showing same constructed of two discs. Fig. 5 is a
 "sectional elevation of my improved heel pad without the use of the metallic
 "eyelet shown at Figs. 1, 2, 3, and 4.

"I preferably form my improved heel plates or pads of one or more discs
 "A of leather, wood, or other suitable material or combination of materials,
 "the diameter of such pad corresponding with that of the boot heel B; in
 "the centre of this disc is a perforation C, through which passes a screw D for
 "attaching the pad to the boot heel. Also, in order to make the pad revolve
 "more freely upon the boot heel and prevent the expansion of the central hole
 "C (which expansion causes the pad to become too slack or have too much play
 "upon the attachment screw D with objectionable results), I employ preferably
 "a brass or other metallic eyelet or cup E of a section corresponding with the

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"hole C and the head of the attaching screw D; the metallic eyelet encircling the screw lessens the friction, and while allowing an easy and automatic movement of the pad upon the said screw, yet always keeps the said pad in close contact with the boot heel. Also to increase the durability I employ a series of metallic pegs F driven into the said pads near the edge or in any other convenient position. By this construction of revolving heel pad I dispense with the use of metallic discs, plates, or the like for securing the pad to the boot heel thereby allowing the pad to revolve more freely and automatically adjust itself in such a manner as to wear equally upon its whole surface so greatly prolonging the life of such pad."

The Patentee claimed:—"Constructing rotary heel pads for boots, shoes, and other foot coverings, of one or more discs A of leather, wood, or other suitable material or combination of materials provided with a central perforation C and eyelet E, such pad rotating upon and secured to the boot or other heel by means of a central screw D or the like, substantially in the manner and for the purposes set forth."

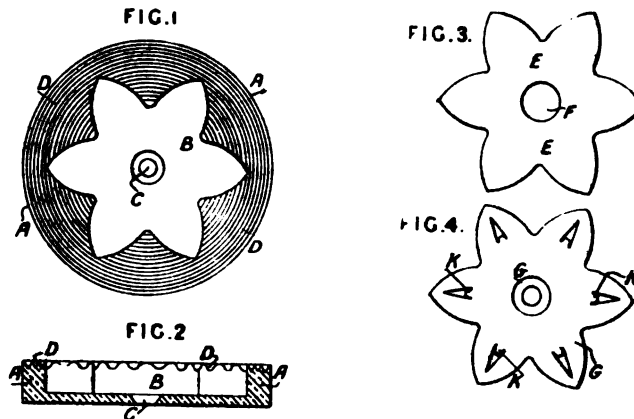
In 1901 *Graydon* commenced an action against *Roberts* for an injunction to restrain him from threatening *Graydon's* customers on the ground that his goods were an infringement of *Wood's* Patent. This action was compromised by an Agreement dated the 18th of November 1901, which contained the following clauses:—"1. Defendants admitting Plaintiff's right to manufacture and sell his heel pads in accordance with his Provisional Specification will undertake not to interfere with such rights, and will not further allege that Plaintiff's heel pads are an infringement of any of their Patents, or repeat their threats to Plaintiff or his customers. (4) Neither party shall be at liberty to question the validity of the other's Patents for revolving heels or heel pads." On the 15th of November 1902 *Roberts* commenced an action for infringement of Patent against *Graydon*, but further proceedings in that action were stayed in view of the action next mentioned. On the 16th of April 1903 an action was commenced by *Roberts* against *Graydon* claiming "A declaration that the revolving boot plates manufactured and sold by the Defendant since the 17th of September 1902, or some of them, are not within clause 1 of the Agreement made the 18th day of November 1901 between the Plaintiff and Defendant, and that such plates are infringements of Letters Patent No. 20,239 of 1896 belonging to Plaintiff; and an injunction to restrain the Defendant, his servants and agents, from infringing the Plaintiff's Letters Patent No. 20,239 of 1896 by the sale of such plates or otherwise save so far (if at all) as provided by the said Agreement," and the Plaintiff claimed certain consequential relief.

The Plaintiff by his Statement of Claim, after stating the grant of the Patents to himself and the Defendant, and alleging the compromise already mentioned, further alleged as follows:—(6) That the Defendant had since the 17th of September 1902 manufactured and sold, both before and since the issue of the writ in the action, revolving heel plates not of the class described in clause 1 of the said Agreement. [Particulars of sales complained of were then given.] (7) That the Plaintiff claimed a declaration that such pads, and pads similar to them, were not of the class described in clause 1 of the Agreement of the 18th day of November 1901, and that the Plaintiff was at liberty to allege that such pads or certain of them were an infringement of his Patent without breach of the said Agreement. (8) The Plaintiff further said that such of the said revolving heel pads as were not of the class of the pads referred to in clause 1 of the said Agreement were an infringement of his Patent, and he would claim full damages for all such pads manufactured or sold in infringement thereof, though he was unable until after he should have obtained discovery to give particulars of the manufacture or sale of such pads other than the sales of such pads (if any) as might be included in paragraph 6.

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The Defendant by his Defence admitted paragraphs 1 to 5 of the Statement of Claim, and after certain allegations as to the negotiations for the compromise (4) denied the allegations of paragraph 6 of the Statement of Claim, and denied that he had since the Agreement sold revolving heel pads other than those which he was under the Agreement entitled to sell, and, after referring to other proceedings between the parties, (6) denied that under the Agreement the Plaintiff was entitled to take any proceedings for infringement of *Wood's* Patent against the Defendant in respect of any revolving heel pads manufactured or sold by the Defendant; (7) if the Plaintiff was so entitled the Defendant, upon the true construction of *Wood's* Patent in view of the state of the art, denied infringement; (8) that the Defendant proposed to refer to the following matters and documents as showing the state of the art at the date of *Wood's* Patent [the paragraph then set out certain alleged common users of revolving heel plates and washers with screws and referred to several Specifications of Patents]; (9) that the Defendant was the owner of Patent No. 10,495 of 1901, and was the owner of and had obtained provisional protection No. 21,070 of 1902 for a further invention of improvements in revolving heel pads; (10) that under and by virtue of the said Agreement the validity of the Defendant's Patent and provisional protection was admitted by the Plaintiff, and the Plaintiff (*sic*) was entitled to manufacture revolving heel pads protected by each of the said Patents. The Defendant also delivered a counterclaim claiming (*inter alia*) rectification of the Agreement.

The following is the Complete Specification of the Patent, No. 21,070 of 1902, so far as material for the purpose of this report :—"The object of my invention is to construct rotary or moveable heel plates or pads for boots, shoes, or the like, so as to be self-adjustable, easily attached, silent, without friction, and always maintain a level and straight heel until thoroughly worn.



"Fig. 1 is a plan of rubber disc forming part of my improved rotary heel pad for boots, shoes, and the like. Fig. 2 is a sectional elevation of Fig. 1. Fig. 3 is a plan of leather plate or insertion fitting within corresponding recess in Fig. 1. Fig. 4 is a plan of eyelet or plate for attachment to leather insertion." . . . [Other figures were described.]

"I construct my improved heel pad preferably of an indiarubber disc A, with a suitable recess B formed on its exterior surface of the shape preferably of a six pointed star, and of a suitable depth, with a central countersunk hole or perforation C, annular grooves D are also formed upon the wearing surface of this rubber disc A.

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“ Within this recess fits a correspondingly shaped piece of leather E, in which
“ is a central perforation or hole F, at the back of this leather insertion E, I
“ preferably employ a metallic eyelet or plate G, the extended flange of which
“ also corresponds in shape with the aforesaid leather E, and has a number
5 “ of spikes or pins K formed upon it which pierce the leather E and bind the
“ two together, a central screw pivot or the like H, secures the said pad to the
“ boot heel J.”

The Patentee claimed :—“ 1. Constructing rotary heel pads for boots, shoes,
“ and the like, of a rubber disc A having a recess such as B, within which fits a
10 “ correspondingly shaped leather plate or filling E attached to a flanged metallic
“ eyelet G, the whole being secured by and rotating upon a central screw or
“ the like, substantially as set forth.”

The heel pads complained of by the Plaintiff, so far as relied on at the trial,
were exhibits D and E. Exhibit D was substantially the heel pad shown in the
15 figures of the Specification of Patent No. 21,070 of 1902. Exhibit E had a
similar metal plate, but no leather piece.

The action came on for trial before FARWELL, J., on the 16th of February,
1904.

Moulton, K.C., *Bousfield*, K.C., and *H. F. Moulton* (instructed by *R. H.*
20 *Bentley*, agent for *Roberts and Riley*, of Burnley) appeared for the Plaintiff;
Uppjohn, K.C., and *A. J. Walter* (instructed by *Helliwell, Harby, and Evershed*,
agents for *Jubb, Booth, and Helliwell*, of Halifax) appeared for the Defendant.

Bousfield, K.C., for the Plaintiff, referred to the pleadings and the Agreement,
and continued :—The Agreement was entered into before the Defendant had
25 filed his second Provisional Specification. The Defendant is now selling heel
pads made under the Plaintiff's Patent and not under the Defendant's. [The
Specifications were referred to.] The Defendant cannot dispute validity, and
is not entitled to refer to prior Specifications on the construction of *Wood's*
Specification (*Jandus Arc Lamp and Electric Company, Ltd. v. Johnson*,
30 17 R.P.C. 361). There are two fallacies in the Defendant's case—first, the
contention that the Agreement did not refer to his existing Patent only ;
secondly, that an Agreement not to dispute the validity of his Patent is a
licence to let him make anything that he chooses to make. The Defendant's
35 1901 Patent was for dispensing with the metal disc ; it was impractical, and the
Defendant first put a leather plate in the centre of the pad ; that did not succeed
and he added a metal plate as well. Finally he dropped the leather altogether
and uses the Plaintiff's heel pad, except that the metal is different in shape.
[Answers to Interrogatories were put in, and *Uppjohn*, K.C., on behalf of the
Defendant admitting the identity of exhibits C, D, and E, no witnesses were
40 called.]

Uppjohn, K.C., and *Walter* for the Defendant.—The Patents are really
identical. [FARWELL, J.—Is not the use of a metal plate excluded in that of
1901 ?] What is an eyelet but a plate with a hole in it ? [A prior Specification
of *Norton* was proposed to be referred to, but was objected to.] [FARWELL, J.—
45 I have nothing to do with validity. I have only to construe the Agreement.]
On the construction of the Agreement, it was not confined to existing Patents.
Its true meaning was that either party might take out what Patents he liked
and sell what he liked. Rubber is not of the essence of the Plaintiff's Patent,
nor is leather of the essence of the Defendant's. The functions of the plate
50 and eyelet is the same ; the difference is merely one of size. The Defendant
has not departed from the terms of the Agreement of compromise.

No reply was called for.

FARWELL, J.—If it had not been for the able and energetic arguments which
I have heard from Mr. *Uppjohn* and Mr. *Walter*, I should have thought this case
55 was unarguable. It is not a question of Patent law at all. It is a mere question
of the construction of an Agreement. One gentleman took out a Patent in
1896, claiming :—“ In revolving heel plates or pads, cutting or grooving or

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"channelling rubber or similar pad represented in Fig. 1 in such a way as
"to receive metal plate shown in Fig. 2, and providing the same with a central
"hole for the reception of a screw for fixing to the boot heel, the said pad
"being free to revolve, and present a fresh surface for wear substantially as
"described." The Provisional Specification which formed the subject-matter 5
of the Agreement was for an invention "To construct rotary or moveable heel
plates or pads for boots, shoes, or the like so as to be self-adjustable
"without friction, and always maintain a level or straight heel. I preferably
"form my improved heel plates or pads of one or more leather or wood
"discs. By this construction of revolving heel pad I dispense 10
"with the use of metallic discs."

I say nothing whatever about the validity of the Patents beyond this: that
these two rival owners of Patents met together and settled their differences by
an Agreement which in effect comes to this. The owner of the 1896 Patent
said to the owner of the 1901 Patent: "You by your Provisional say that you 15
"dispense with the use of metal discs. Very well; so long as you do that I
"am content that you should make what you please in accordance with your
"Provisional. Do it and I will not attack you." The sole question is whether
what the Defendant is doing is in accordance with his Provisional Specification.
I am clearly of opinion that it is not in accordance with the Provisional as 20
construed by the parties in their Agreement, because he does not dispense with
the use of the metal discs, and in fact, so far as I can judge on a view, his
revolving heel plate is as nearly as possible identical for all practical purposes
at any rate with that of the Plaintiff.

In my opinion there has been a clear breach of the Agreement, and the relief 25
must be granted as asked.

Bousfield, K.C.—There will be a declaration construing the Agreement, and
an injunction.

FARWELL, J.—Yes, construing the Agreement in this sense—that the two
articles D and E exhibited to the Answers to Interrogatories are not within 30
clause 1, and then on that the injunction will be granted.

Bousfield, K.C.—I will take, if your Lordship pleases, an inquiry as to
damages.

FARWELL, J.—That must be an inquiry limited, of course, to the sales of
D and E; and I give the Plaintiff the costs of the action. 35

Bousfield, K.C.—The costs of the previous action, which was stayed, were
made to depend upon this. They were ordered to be costs in an action to be
brought to determine what plates were authorised to be sold, and that is this
action.

FARWELL, J.—Then I direct those costs to be treated as costs in this action, 40
and you will get the costs of that action.

Heine, Solby & Co. v. Coninco Incandescent Light Company.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE SWINFEN-EADY.

December 12th, 1903.

HEINE, SOLBY & CO. v. CONINCO INCANDESCENT LIGHT COMPANY.

5 *Patent.—Action for infringement.—Practice.—Delay in making application to advance trial for which leave was given to Plaintiffs on interlocutory motion for injunction.—Motion by Plaintiffs to advance the trial.—Motion refused.—Costs to be the Respondents' in any event.*

This was an action for infringement of Letters Patent (Nos. 24,459 of 1889, 10 17,093 of 1901, and 9198 of 1892) granted for certain improvements in pocket automatic gas lighters.

On the 20th of February 1903 an interlocutory motion for an injunction was brought on. No Order was made on the motion, but leave was given to apply to advance the trial as soon as the action was set down, which was done on the 15 4th of December. On the 12th of December 1903 the Plaintiffs moved to fix the trial for the 15th of December, but at the Bar asked that it should be on the 14th of January 1904. The Defendants opposed the motion.

W. C. Godwin (instructed by *Edgar Francis Weldon*) appeared for the Applicants; W. Neill (instructed by *Armitage and Armitage*) appeared for the 20 Respondents.

SWINFEN-EADY, J.—This is a motion to fix the trial of the action for Tuesday, the 15th of December, on the ground that "it is important that the action should be tried " during the present Sittings, as, if the trial is postponed until the next Sittings " (I am reading now from the affidavit in support), "and then takes its place in 25 " the list, the Plaintiffs and the Defendants will both have lost this season's " market, which is only a valuable market during the earlier winter months." It is now said at the Bar that that is not asked for, and cannot be pressed; but I am asked to fix the trial for the 14th of January. It was on the 20th of February last that leave was given to apply to advance as soon as the action 30 was set down. The pleadings were closed in March. Notice of trial was not given or the action was not set down until the 4th of December. Under these circumstances, if the matter were in my own paper, and I was hearing witness actions, I should decline to advance the hearing. When leave is given to the Plaintiff to apply to advance, he is given it with the view that he shall 35 proceed promptly on his part if he desires a speedy trial, and, after waiting from February until December, if the matter remained in my own paper, I should certainly not advance the hearing. But it does not rest there, because now it is agreed that it cannot be disposed of in these Sittings, and must go before Mr. Justice *Farwell*, who is taking witness actions next Sittings, and in 40 no case could I interfere or fix a day for him to try any particular action. That will be a subject-matter which will have to be dealt with by himself.

The result is that the motion fails, and the costs must be the Respondents' in any event.

Heine, Solby & Co. v. The Coninco Incandescent Light Company.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE FARWELL.

February 4th, 1904.

HEINE, SOLBY & CO. v. THE CONINCO INCANDESCENT LIGHT COMPANY.

Patent.—Combination.—Action for infringement.—Subject-matter.—Novelty. 5
—Utility.—Patent held to be valid and the Defendants to have infringed.—
Practice.—Amendment of writ.—Particulars of Breaches.—Patents, Designs,
&c. Act, 1888, section 29 (1).

The owners of three Patents for improvements in pocket automatic gas lighters 10
commenced an action for infringement. The Defendants denied infringement,
and alleged that the Patents were invalid by reason of being anticipated, of
want of subject-matter, of novelty, and of utility. The Writ as originally
issued alleged infringement of one Patent only. Subsequently it was amended
by the inclusion of two others. From the Statement of Claim it appeared that,
although the Plaintiffs ultimately became the assignees of all the Patents, at the time 15
of the issue of the Writ they were not the assignees of the two added under the Order
giving leave to amend. The Particulars of Breaches delivered related to articles
sold before the Plaintiffs had acquired a title to these two Patents, and no
amended Particulars of Breaches were delivered. The Plaintiffs were not
able to bring their Particulars of Breaches within the first Patent. Upon 20
objection being taken to the Plaintiffs proceeding, it was arranged by consent
that the question of the validity of one only of the three Patents (i.e., one of
the two subsequently added) should be tried, together with the question of
infringement thereof, the Plaintiffs waiving any inquiry as to damages.

Held, that the invention was a new application of an old form of protecting 25
cover in combination with old and well known attributes of platinum black so
as to produce a useful commercial article; that the Patent was valid; and that
the Defendants had infringed.

On the 26th of August 1901 Letters Patent (No. 17,093 of 1901) were granted 30
to C. E. J. Berthold for "An improvement in pocket automatic gas lighters."

The Complete Specification, which was accepted on the 25th of June 1902,
was as follows:—"My invention relates to a construction of automatic gas
"lighter in which, when not in use, the igniting pellet is protected against deterio-
"ration by the atmosphere by being enclosed in a casing formed of two parts so
"formed and arranged that in one position thereof the pellet is completely 35

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"enclosed, while on moving the one part relatively to the other part to a limited extent when required for use openings are uncovered through which a gas jet to be ignited can gain access to the igniting pellet.

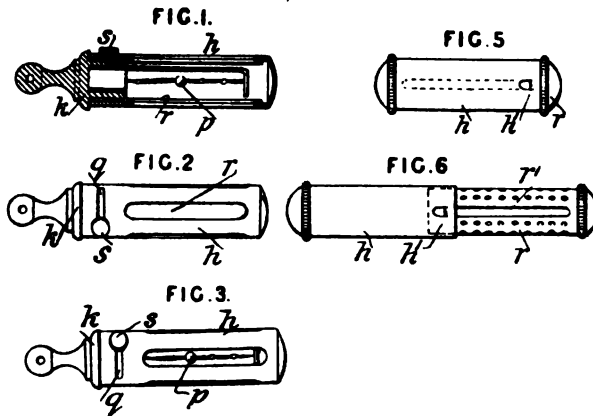
- 5 "On the accompanying drawing are shewn various forms of pocket automatic gas lighters constructed according to my present invention. In the construction shewn respectively in longitudinal section, two side views and a cross section at Figs. 1, 2, 3 and 4, the igniting pellet *p* which may be of any known form for effecting the ignition of gas by catalytic action, is contained in a cylindrical part *r* fixed to a socket piece *k* constituting a handle, 10 "over which part *r* is fitted a cylindrical sheath *h*, which can be turned round within certain limits thereon. Both *r* and *h* have a series of longitudinal slots so arranged that when the two parts are in the relative position shewn at Fig. 2, the solid parts between the slots of *h* cover the slots of *r* and thus effect the complete enclosure of the igniting pellet. When the part *h* is turned upon *r* 15 "so that the slots of the two parts face each other as at Figs. 3 and 4, the gas can gain access to the pellet *p* and be ignited thereby. For allowing of this relative motion of *h* and *r*, without permitting the former to be removed from the latter, the part *h* has a slot *q* formed in it, through which passes a pin *s*, screwing into *r* and *k*, and thus also serving as a stop for limiting the rotation 20 "of *h*, and for securing the part *r* to the handle *k*.
- "In the construction shewn at Figs. 5 and 6, the inner receptacle *r* containing the igniting pellet is formed with a series of perforations while the outer sheath *h* has no openings, but can be slid longitudinally upon *r* from the position at Fig. 5 in which it entirely encloses *r*, into the position shewn at 25 "Fig. 6 in which it uncovers the perforations and allows the gas to penetrate to the pellet. The extent to which *h* can be slid outward upon *r* is limited by means of a slot or groove *r*¹ formed in *r*, in which is engaged a tongue *h*¹ stamped out of the part *h* and bent inwards into the slot or groove. Or the two parts may be secured together as shewn in the section at Fig. 7, where the inner 30 "perforated part *r* has its mouth *r*² slightly widened, and fitting in the outer sheath *h* of a correspondingly enlarged size, while the latter has screwed to it a part *h*² that fits the outer surface of *r*, so that when the latter is drawn outwards, as shewn, its enlarged end serves as a stop for preventing it from being entirely drawn out of *h*. It will be obvious that in the arrangements where 35 "the outer part *h* slides longitudinally upon the inner part *r*, the casing need not be of cylindrical form but can be of any other sectional shape, such as square, triangular, polygonal, oval, or the outer part *h* may even be made with a spherical or other shaped outer surface as indicated at Fig. 8, and may be of ebonite, wood, or any desired material. In this case the parts are secured 40 "together by a pin *h*³ screwing through *h* and engaging with a slot or groove in the part *r*.

- "Figs. 9 and 10 shew a side view and cross section at X—X of an arrangement similar to Figs. 5 and 6 in which the outer part *h* has a raised groove *h*⁴ 45 "formed by embossing into which fits an embossed projection *r*³ on the inner part *r*, the groove *h*⁴ being formed with an elbow and extending to the outer end, so that when desired to separate the two parts, the inner part can be turned slightly so as to bring its stud opposite the outer part of the groove *h*⁴."

- The claims were as follows:—"1. An automatic gas lighter in which the 50 "igniting pellet is enclosed in a casing formed of an inner and an outer part, capable of a certain limited motion relative to each other, the inner part containing the pellet being formed with slots or perforations, which in one position of the outer part are covered so as to prevent the air gaining access 55 "to the pellet, while in another position thereof they are uncovered, substantially as described. 2. An automatic gas lighter such as is referred to in the first claim, wherein the inner and outer parts of the casing are formed with longitudinal slots, the outer part being capable of being turned upon the

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"inner part to a limited extent so that in one position of the outer part its slots
 "are brought opposite those of the inner part, while in another position the outer
 "part closes the slots of the inner part, substantially as described. 3. An
 "automatic gas lighter such as is referred to in the first claim, wherein the
 "inner part of the casing is formed with openings or perforations, while the
 "outer part, which has no openings, can be slid longitudinally to a limited
 "extent upon the inner part so as in one position to cover the openings of the
 "latter, and in another position to uncover them, substantially as described."



The action was commenced on the 31st of January 1903 in respect to one
 Patent only—viz., No. 24,459 of 1899. On the 20th of February 1903 leave was
 obtained to amend the Writ by the addition of two Patents. The Plaintiffs
 were the assignees of all the Patents at the date of trial, but it appeared from the
 Statement of Claim that two of the Patents (No. 17,093 of 1901 and No. 9198 of
 1902) had not been assigned to them at the date of the commencement of the
 action, at which date the Plaintiffs were the sole agents in England for the
 Patentee, but were assigned between the dates of the issue of the Writ and its
 amendment. At the trial objection was taken that the Plaintiffs were not
 entitled to proceed in respect of the particular acts of alleged infringement, the
 dates of which as given in the Particulars were prior to their title. FARWELL, J.,
 suggested that the objection might be met by a waiver of the claim to damages
 in respect to anything done before the amendment of the Writ. The Defen-
 dants objected on the ground that the Particulars of Breaches delivered related
 to specific articles sold before the Plaintiffs had become owners of the Patents
 added by the amendment, and that no amended Particulars of Breaches had
 been delivered. The Plaintiffs then urged that before the action came on there
 had been an interview between the solicitors of the parties, and that the Defen-
 dants had agreed to contest the validity of one Patent only and not to contest
 the infringement. The Defendants at the Bar, while admitting that there had
 been an informal conversation, denied that any agreement or admission had
 been made. Finally, the Plaintiffs offered to withdraw the claim to damages
 and to proceed upon one only of the Patents, viz., No. 17,093 of 1901, and it
 was arranged by consent that its validity should be tried, together with the
 question of infringement, the Plaintiffs waiving any claim to damages.

By their amended Statement of Claim the Plaintiffs stated *inter alia* that—
 (1) they were the registered legal owners of Patent No. 17,093 of 1901, 35
 acquired by Assignment dated the 18th of February 1903 and duly
 registered, of Patent No. 24,459 of 1899, acquired by Assignment dated the

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16th of January 1903, registered the 26th January 1903, and of Patent No. 9198 of 1902, acquired by Agreement dated the 7th of February 1903, and confirmed by Assignment dated the 6th of April 1903; (2) the Defendant Company had infringed the said Patents in the manner appearing by the
 5 Particulars of Breaches. They claimed—(1) an injunction restraining the Defendant Company, their servants and agents, from selling or offering for sale or in any manner dealing with any articles constructed in infringement of the Patents; (2) damages, or an account of profits at the Plaintiffs' option; (3) delivery up or destruction of all articles in Defendant Company's
 10 possession constructed in infringement of the said Letters Patent.

The Particulars of Breaches stated that—(1) the Defendant Company had infringed the Plaintiffs' Letters Patent No. 17,093 of 1901, No. 24,459 of 1899, and No. 9198 of 1902 by selling and offering for sale *Berthold's* pocket gas lighters constructed in accordance with the inventions described in the
 15 Complete Specification of the said Letters Patent; (2) the Defendant Company on the 17th of January 1903 sold to the *Oxford Incandescent Supply Stores*, 20 Rathbone Place, Oxford Street, E.C., one dozen of the aforesaid pocket gas lighters constructed as aforesaid; (3) on dates not known to the Plaintiffs the Defendant Company sold to Messrs. *Morgan and Green*, 60 Baxter Gate,
 20 Loughborough, and to *G. Northeast*, 13 Blackwood Street, Walworth, respectively, one and a half dozen and two and a half dozen of the pocket gas lighters constructed as aforesaid; (3) the Plaintiffs were unable until they should obtain discovery to give better Particulars of the Defendant Company's infringements, but would claim to recover full compensation for all infringements of the
 25 Letters Patent committed by the Defendant Company.

By their amended Defence the Defendant Company stated that—(1) they had not infringed the Letters Patent, or any of them as alleged, or at all; (2) all of the Letters Patent were invalid for the reasons stated in the Particulars of Objections.

30 The following were the material portions of the amended Particulars of Objections upon which the Defendants relied:—(1) None of the alleged inventions were useful. (2) The Complete Specification of each of the alleged inventions did not distinguish what parts of the alleged invention were new and what were old. With regard to the Patent No. 17,093 of 1901—(3) The
 35 alleged invention claimed in all the claiming clauses of the Specification of the alleged invention was not novel, having been published in this realm prior to the date of the said Patent by the publication at the Patent Office of the following Complete Specifications, the whole being relied on in each case with respect to all the claims of the Complete Specification of the alleged invention:—
 40 (a) *Fritz Deimel* (No. 11,537 of 1899); (b) *James Osborne Spong* (No. 24,459 of 1889). (4) The alleged invention was also published in this realm prior to the date of the Patent by the manufacture, use, sale, and disclosure to the public of automatic gas lighters by *Bernard Pordes*, of 74 Milton Street, London, in or about the months of July, August, September, October, November,
 45 and December, 1899. (5) The alleged invention was also published in this realm prior to the date of the Patent by the public general manufacture, use and sale of receptacles for needles, pencil leads, drugs, and various small articles consisting of two parts, one sliding or rotating within the other, and provided with springs capable of being brought together when desired. (6)
 50 The alleged invention claimed in all the claims of the Complete Specification of the alleged invention was not proper subject-matter for Letters Patent, having regard to the state of common knowledge and to paragraphs 3 and 4 hereof, and to the publication at the Patent Office of the following Complete Specifications, the whole of which are relied on in each case:—(a) *Hugo*
 55 *Borchardt* (No. 13,095 of 1897); (b) *Hugo Borchardt* (No. 30,906 of 1897); (c) *Adolf Martini* (No. 24,392 of 1899). (7) Having regard to paragraphs 3 to 6 hereof, the person to whom the said Letters Patent were granted was not the

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true and first inventor of the alleged invention. The Particulars of Objections extended to the other Patents sued upon, viz., No. 24,459 of 1899 and No. 9198 of 1902.

The action came on for trial on the 4th of February 1904.

Robert Wallace, K.C., and *W. C. Godwin* (instructed by *Edgar Francis Weldon*) appeared for the Plaintiffs; *W. Neill* (instructed by *Armitage and Armitage*) appeared for the Defendants.

Robert Wallace, K.C., opened the Plaintiffs' case.—The invention relates to an improvement in pocket automatic gas lighters. The Patentee *Berthold* (No. 17,093 of 1901) has succeeded in inventing a new and useful article. Anterior to the Patent the properties of platinum black in relation to the ignition of gas were known. The difficulty was how to apply that knowledge. The atmosphere has a most deleterious effect upon the platinum-black ball if it is not protected, and within a week it loses its power. *Berthold* has applied the knowledge successfully. He has two cases—an inner and an outer case—one sliding or rotating upon the other. The inner case is perforated with a number of holes, and in it is a platinum wire with balls upon it. The outer case has no openings. When used to ignite gas the outer case is drawn out leaving the balls exposed to the gas. The outer case is then pushed back and the atmosphere is absolutely excluded. The platinum ball is protected by this means both from the atmosphere and from injury by contact with external objects—e.g., pockets, &c. The invention of *Spong*, an alleged anticipation, only afforded protection to the igniting medium from contact with the pocket, &c., and did not protect from the atmosphere. [FARWELL, J.—What is the invention?] It is the application of certain well-known principles—none of them by themselves being sufficient to become the subject-matter of a Patent, but in combination producing a novel result. The atmosphere being excluded the platinum ball can be used as a commercial article and an article of utility. The case comes within the principle laid down in *Cannington v. Nuttall* (L.R. 5 H. L. 205). Previously to the Patent the pocket automatic gas lighter was only a toy. Now it is a commercial article.

J. T. Norman (analytical chemist) was called for the Plaintiffs. He stated that *Spong's* Patent did not deal with the atmospheric action on the black ball, but only with mechanical pressure. In a few days the black ball would become inefficient. *Berthold's* invention extended the life of the ball to such a length as to make the article of practical use. The igniting pellets were protected from atmospheric influences, in which were included dust and the action of certain gases present in the atmosphere. It made a scientific curiosity into a practical commercial article. The cross-examination of the witness was directed to common knowledge and the alleged anticipations set forth in the Particulars of Objections, and to the fact that the Defendants' article was not constructed according to the Specification of Patent No. 17,093 of 1901.

The Defendants called no evidence.

W. Neill for the Defendants.—The Defendants have not infringed. The article they have sold is wanting in one of the essentials of the Plaintiffs' Patent—i.e., the exclusion of the atmosphere. It has an opening through which the air can enter. [FARWELL, J.—You cannot evade the Patent by making an opening. The whole point is whether, admitting this to be old, the particular application is not novel.] Platinum black was old. Its use for ignition was old. The knowledge that it was hygroscopic was old, and that, unless it was made non-hygroscopic or was protected from the atmosphere, it would deteriorate. *Deimel's* Patent covered that. The whole thing is contained in *Spong* except that the air is not excluded. It was known that if you used platinum black you must either exclude the air or prepare the pellet in such a way that it would not be hygroscopic. *Berthold* uses the hygroscopic pellet, and therefore he must protect it from the air. [FARWELL, J., referred to *Brooks v. Lamplugh* (15 R.P.C. 33).] There it was a new application and an ingenious one. In

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Cannington v. Nuttall there was a new discovery, and in *Brooks v. Lamplugh* the Patentee found out a way to utilise the girder principle. In the present case nothing new was found out. The method of shutting the platinum ball in a box is very old. It comes within the propositions laid down by *Lindley, L.J.*, in *Gadd v. Mayor, &c. of Manchester* (9 R.P.C. 524). There is here no invention, nor is there an exercise of ingenuity sufficient to support a Patent. It may have been an improvement in a sense, but the article is not new. [FARWELL, J.—If Claim 2 is bad, the Patent cannot be supported until the Specification is amended.] [Wallace, K.C.—It is only a claim for an alternative method of doing it—that is, turning the outer case round instead of pulling it out.]

FARWELL, J.—These cases are very difficult because they are very near the line. The principles are well settled, but whether in any given case there is sufficient invention to support a Patent or not is always a matter of very great difficulty. I have come to the conclusion in the present case that there is enough. The thing to be aimed at was that the known platinum-black ball (I think it is called) required protection from atmospheric influences in order to make it available for the useful purpose for which it was desired to be used. It had been used under a former Patent but in a manner which was not effective, and, as Mr. Wallace put it, it was rather a pretty plaything than a useful article.

This is a new application of what is certainly nothing but an old form of covering consisting either of a perforated case within an unperforated case and fitting closely, or a case, with slots longitudinally cut, inside another case and turning round so that you can have it open or shut to the air as you please, which is as old as possible of course. But it is the application of this old form of protection to the old known attributes of the platinum-black ball, as they were existing, so as to make a useful commercial article which is the subject-matter; and it seems to me to be good. I think the case nearest to it, if I have to go upon cases, is the bicycle saddle case I referred to, where the Court of Appeal held that the application of the old idea of a truss, which is familiar in bridges, to the framework of a bicycle saddle was sufficient subject-matter to support a Patent. The same principle applies here, although I agree it is very near the line. I cannot doubt that the Defendants' article, which is sold by them, is an infringement. They are not doing anything more than making a little hole in it, which, while it does not quite spoil it, makes it a little worse. Thereby they hoped they were evading the Patent. It does not make the matter any better that they get their articles from Germany.

An injunction was granted restraining the Defendants from infringing Letters Patent No. 17,093 of 1901. A certificate of validity was also granted, and, by consent, no costs were given to either side.

Dunlop Pneumatic Tyre Company, Ltd. v. Hyde Rubber Company.

IN THE HIGH COURT OF JUSTICE.—KING'S BENCH DIVISION.

Before MR. JUSTICE BUCKLEY

(Sitting as an additional Judge of the King's Bench Division).

February 24th and 25th, 1904.

DUNLOP PNEUMATIC TYRE COMPANY, LD. v. HYDE RUBBER COMPANY. 5

Patent.—Action for infringement.—Issue of infringement.—Judgment for Plaintiffs.

The owners of the Welch Patent for "Improvements in rubber tyres and metal rims or felloes of wheels for cycles and other light vehicles," having brought an action for infringement, the Defendant denied infringement. The fourth claim of the Plaintiffs' Specification was for "a rubber or elastic tyre having the form of a saddle or arch in section lined with canvas in combination with two wires or sufficiently inelastic cores for securing the same to the rims or tyres, substantially as herein described." The Defendant had an arrangement partly of string and partly of wire in the edges of his tyre, which he contended was not the equivalent of and did not perform the functions of the Plaintiffs' wires or inelastic cores, and did not in use lie in the same position in the rim. 10 15

Held, that the Defendant had infringed. Judgment was given for the Plaintiffs. 20

On the 27th of August 1903 the *Dunlop Pneumatic Tyre Company, Ltd.*, and the *Pneumatic Tyre Company, Ltd.*, commenced an action against the *Hyde Rubber Company* (under which name the Defendant traded) for infringement of Welch's Patent (No. 14,563 of 1890) for "Improvements in rubber tyres and metal rims or felloes of wheels for cycles and other light vehicles," claiming the usual relief and costs as between solicitor and client. 25

Claim 4 of the Complete Specification was as follows:—"A rubber or elastic tyre, having the form of a saddle or arch in section lined with canvas, in combination with two wires or sufficiently inelastic cores for securing the same to the rims or tyres, substantially as herein described." The full Specification with certain of the drawings thereto will be found in the report of *Pneumatic Tyre Company, Ltd. v. Leicester Pneumatic Tyre and Automatic Valve Company* (16 R.P.O. 531). 30

The Plaintiffs by their Statement of Claim alleged that they were the proprietors of the Patent; that the Patent was valid and had been so certified; and that the Defendant had infringed. 35

The Particulars of Breaches alleged—(1) that the Defendant had infringed the Patent by making, selling, and offering for sale pneumatic tyres and parts thereof made in accordance with the invention claimed in the Patent; (2) that

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the Defendant on the 7th of August 1903 sold to Mr. J. Warde, of &c., a pneumatic tyre not of the Plaintiffs' manufacture made in accordance with the inventions claimed in the claiming clauses of the Patent; and (3) reserved the right to recover in respect of all infringements.

5 The Defendant by his Defence denied that he had infringed the Patent in the manner set forth in the Particulars of Breaches or at all. Before the trial the sale of the tyre referred to in paragraph 2 of Particulars of Breaches was admitted, but not that the tyre was an infringement of the Patent. This tyre will be found described in the judgment.

10 The action came on for trial before BUCKLEY, J., on the 24th of February 1904.

A. J. Walter (instructed by J. B. and F. Purchase) appeared for the Plaintiffs; the Defendant appeared in person.

Walter for the Plaintiffs referred to Claim 4 of the Specification and to
15 Fig. 15 of the Drawings, and continued:—Claim 4 covers both wires and “sufficiently inelastic cores.” In many decisions on the Patent, tyres having cores in the edges inextensible in use have been held to infringe the Patent; for instance, in *Pneumatic Tyre Company, Ltd. v. Casswell* (13 R.P.C. 164), where there were convolutions of wire, but the ends of the wire were not
20 connected. Here there are two inextensible things in each side of the tyre complained of. There is a string which is wound round four times, and which is strong enough by itself to hold the tyre on; and there is a wire added to that. The ends of the wires are put into a brass tube or sleeve, which is slightly bent, and a high degree of friction is obtained between the wires and the tube.
25 The Defendant's tyre holds by reason of the inextensibility of the cores in use.

Messrs. Baisley and Adams were called as witnesses on behalf of the Plaintiffs.

The Defendant, in cross-examining and in addressing the Court, said that his case was that the cores in his tyre lay at the bottom of the rim and not on the shoulder of it, which was the *Welch* position, and that the inner tube when
30 inflated pressed on the edges of the tyre and held the tyre on; that the edges of the tyre were not in fact inextensible; and that the tyre did not hold on by reason of inextensibility.

No witnesses were called on behalf of the Defendant.

BUCKLEY, J.—The Defendant in this case has a cover, in the edge of which
35 there are four convolutions of string; there is also a wire which goes all round the edge of the cover but is not brazed at its two ends; the two ends go into a metal sleeve in the circumference of the rim, which is neither straight nor curved, but is of a pointed form, like the gable of a roof with a very obtuse angle in the gable. The ends of the wire pass into the two sides of that sleeve. The
40 convolutions of the cord are very “tacky” with indiarubber solution; and the Plaintiffs' case is that the result of the convolutions of the cord, and the wire, in one pocket, with some sticky material to make them cling, and the locking of the two ends of the wire into the sort of gable which I have described, have the effect, so soon as the cover is subjected to pressure by the blowing up of the inner
45 tube, of producing an inextensible edge. The Defendant's case is that he does not use his convolutions of cord and his wire for the purpose of getting an inextensible edge, but that the whole object of them is to give initial contraction when the cover is put on to the rim, in order that the edges of the cover may be induced to lie in the very bottom of the rim, and that, when the inner
50 tube is blown up, the cover, thus placed, is exposed to friction between the inflated inner tube and the rim, and that it is friction alone which holds his cover on. Of course the obvious question that arises, under these circumstances, is, Why take so much trouble to have four convolutions of cord, with the wire, and the gable to hold the ends of the wire, when you would achieve your purpose very
55 much better by having a strong piece of elastic in it that would bring it down to the bottom of the rim, if all you want is to get it there and then to blow it up and hold it on? That obviously is not the object of the arrangement at all. The

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object is to have something that will hold the tyre on. Now how is this held on? It has been proved that when you put the Defendant's tyre on the rim, and subject it to the pressure of the expansion of the inner tube, the edges of the cover do not remain in the bed of the rim, but assume the position which is assumed by the inextensible wire under the *Welch* Patent: they lie 5 in the shoulder of the rim, and the Defendant's tyre is held on by the existence in it of a core which is inextensible in use. The result of putting it on and inflating is, that you get an inextensible edge which, being of a diameter less than the diameter of the edge of the rim, cannot come off, which is the well-known *Welch* manner of holding on a cover. Having said this, I do not think 10 I need say any more for the purpose of showing that this is nothing but an attempt to make use of that which is the subject of the *Welch* Patent, by substituting a core, which is practically inextensible, in a slightly different form. There is infringement and I grant the injunction asked.

Judgment was given for an injunction and costs, an inquiry as to damages 15 and delivery up of infringing tyres. A Certificate as to the Particulars of Breaches was given.

BUCKLEY, J.—The Registrar tells me that I must initial the Particulars of Breaches. I have never done such a thing when sitting in the Chancery 20 Division.

Walter.—Neither have I heard of it in the King's Bench Division.

BUCKLEY, J.—I do not want to put the Registrar in a difficulty, but I decline to do it because I think it is unnecessary. I object to the Judge being asked to initial all sorts of matters which seem to be unnecessary. I 25 decline, but nevertheless if it is necessary I will do it.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE KEKEWICH.

January 15th, 1904.

TINLEY v. SMART AND PARKER, LD., AND J. S. SMART.

Design.—Action for infringement.—Motion treated as trial.—Judgment for 30 Plaintiff by consent.—Costs of affidavits.

In an action for infringement of a registered Design (No. 393,886) for Fenders the Plaintiff gave notice of motion for an interlocutory injunction. On the hearing of the motion,

E. P. Hewitt (instructed by *Belfrage & Co.*, agents for *T. W. Robinson*, of 35 Birmingham) appeared for the Plaintiff; *J. C. Graham* (instructed by *Harrison*

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and Davies, agents for Hooper and Ryland, of Birmingham) appeared for the Defendant Company; and J. F. Galbraith (instructed by John Westcott, agent for Wright and Marshall, of Birmingham) appeared for the other Defendant.

5 Hewitt stated that both Defendants consented to the hearing of the Motion being treated as the trial, and submitted to a perpetual injunction with an inquiry as to damages, but the Defendant Company raised a question as to their liability to costs on the ground of certain offers made by them.

10 KEKEWICH, J.—If the Company is prepared to submit to a perpetual injunction and an inquiry as to damages they are *prima facie* liable also to pay the costs.

Graham.—On the 10th of December last the Defendant Company's solicitors wrote to the Plaintiff's solicitor the following letter:—"Referring to your
15 "correspondence herein, we beg to inform you that the fenders in question
"were made without knowing that they were your client's property, but we
"have advised our clients that, notwithstanding this, they are liable, and they
"at once—as notice was given to your client—gave orders for an immediate
"stoppage of any dealings with them. Our clients are quite prepared to give
"an undertaking not to repeat the infringement, and also to pay such fair and
"reasonable damages as are in accordance with the number of infringing
20 "articles sold. If your client chooses to take any proceedings we shall consent
"to an injunction and file an affidavit setting forth the profits made by our
"clients in the matter. We give you notice that we shall not contest your
"client's claim, and that therefore there will be no necessity for more than one
"brief to Counsel in the matter. We also give you notice that we shall read
25 "this letter on the hearing of any application you may make to the Court."
Up to the date of that letter the Plaintiffs were of course entitled to all costs, but since the date of the letter they have been filing a number of affidavits, which was unnecessary. I ask your Lordship to make the same Order that was made in *Slazenger v. Pigott* (12 R.P.C. 439).

30 KEKEWICH, J.—You cannot have that form of Order, because on your offer there could not have been a consent Order made in Chambers. The Motion must be brought on with one Counsel.

Graham.—It is the unnecessary costs of filing affidavits that I object to.

35 Hewitt.—We have proceeded in a cheap and summary way in order to determine the matter. On the 15th of December the other side wrote asking for copies of our evidence. I submit that there is no ground for depriving the Plaintiff of any costs.

KEKEWICH, J.—Have you verified the letter of the 10th of December?

40 Hewitt.—It is in the bundle of correspondence which is exhibit T. 2 to the Plaintiff's affidavit.

KEKEWICH, J.—I think that the Defendant Company ought not to pay the costs of any affidavits other than the affidavit verifying the correspondence which is exhibit T. 2 to *Francis Rowland Tinley's* affidavit. I think after the letter of the 10th of December there was no occasion to file evidence at all.

45 Hewitt.—Subject to that the Order will go?

KEKEWICH, J.—Yes I reserve the costs of the inquiry as to damages.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE FARWELL.

January 18th, 19th, and 20th, 1904.

WEINGARTEN BROTHERS v. ROSENTHAL.

WEINGARTEN BROTHERS v. SHERWOOD & CO.

5

*Trade name.—Actions for injunctions to restrain use of.—Descriptive term.—
 Prior user by one Defendant.—Actions dismissed.*

*W. B., an American firm, began to sell corsets in this country in February 1901 under the title of "Erect Form Corsets." Their sales prior to action were not large. In February 1902 they commenced an action against W. R. to 10
 restrain him from passing off his corsets as theirs by the use of "Erect Form," and in April 1902 they commenced a similar action against H. S. & Co. The two actions were in the list for trial on the same day, and were in effect tried together.*

*Held, that "Erect Form" as applied to corsets was a descriptive term, and 15
 had not acquired a secondary signification as denoting the Plaintiffs' corsets, and that the term had been in fact first used in this country by the Defendants S. & Co. Both actions were dismissed with costs, the Defendant W. R. being allowed the costs of three Counsel.*

*These were two actions by Weingarten Brothers of a similar character to the 20
 action of Weingarten v. Bayer, reported 20 R.P.C. 289 and 649. In each of the two present actions the Plaintiffs claimed an injunction to restrain the Defendants, their servants and agents, from selling or offering or exposing or advertising for sale or from procuring to be sold any corsets not of the Plaintiffs' manufacture under the name of "Erect Form Corsets" without clearly distinguishing such 25
 corsets from the Plaintiffs' corsets, and from in any manner passing off, or enabling or assisting others to pass off, any such corsets aforesaid as or for the Plaintiffs' corsets, and other consequential relief.*

*In the Statement of Claim in the action against W. Rosenthal, after alleging large sales of their "Straight Fronted Corsets" under the name of "Erect 30
 "Form Corsets" in this country in and since February 1901, and that the name "Erect Form Corset" was universally understood as indicating that the corsets in respect of which it was used were the Plaintiffs' corsets, the Plaintiffs alleged as follows:—"In the month of February 1902 the
 "Plaintiffs discovered that the Defendants, who carry on business as manu- 35
 "facturers and vendors of corsets at No. 15, London Wall, in the City of
 "London, and who were already manufacturing and selling under other names
 "'Straight Fronted Corsets' similar in pattern and style to the Plaintiffs' said*

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" 'Straight Fronted Corsets,' had begun for the first time to adopt and use in respect of their 'Straight Fronted Corsets,' instead of any of the names previously used by them, the said name 'Erect Form Corsets' used by the Plaintiffs as aforesaid, and to print the words 'Erect Form' on the boxes in which such corsets were sold. On the same boxes on which the Defendants have begun to use the said words 'Erect Form' there also appear, though in very much smaller type, the words 'W. R.' 'Whalonia Straight Fronted Corsets,' such word 'Whalonia' being a registered Trade Mark of the Defendants, and such description being the description under which the same corsets were sold by the Defendants before they adopted the said words 'Erect Form' for the same without any justification and solely in order to compete unfairly with the Plaintiffs."

By his Defence the Defendant alleged that the term "Erect Form Corsets" was not a distinctive name for corsets of the Plaintiffs' manufacture, but was a descriptive name in common use, and usually applied to corsets giving an erect form to the figure of the wearer.

In the action against *Sherwood & Co.* the Plaintiffs by their Statement of Claim (after similar allegations to those above mentioned as to their sales and the meaning of the term "Erect Form Corsets") alleged that—"In the month of March 1902 the Plaintiffs discovered that the Defendants, who carry on business as manufacturers and vendors of corsets at No. 12, London Wall, in the City of London, and who were already manufacturing and selling 'Straight Fronted Corsets,' similar in pattern and style to the Plaintiffs' said 'Straight Fronted Corsets,' had begun for the first time to describe such corsets as 'Erect Form Straight Fronted Corsets,' and to print the words aforesaid on their said corsets. There was no legitimate reason for the introduction of the said words 'Erect Form' into the description of the Defendants' said corsets, which were already correctly and sufficiently described as 'Straight Fronted Corsets,' and the Defendants adopted and used the said words 'Erect Form' for their corsets as aforesaid without any justification and solely in order to compete unfairly with the Plaintiffs."

By their Statement of Defence the Defendants denied that they first used the words "Erect Form" in March 1902, and stated that they had used the words "Erect Form" in connection with their corsets as early as the year 1900," alleging in fact a use of "Erect Form" as a name for corsets prior to the use thereof by the Plaintiffs in this country.

The actions came on for trial before Mr. Justice FARWELL on the 18th of January 1904. At first the actions were taken separately, but ultimately they were in effect tried together.

Levett, K.C., John Cutler, K.C., and Sebastian (instructed by *C. Urquhart Fisher*) appeared for the Plaintiffs; *Astbury, K.C., J. W. Gordon, and D. M. Kerly* (instructed by *Edwards and Cohen*) appeared for the Defendant *Rosenthal*; *Bramwell Davis, K.C., and Cann* (instructed by *Tippetts*) appeared for the Defendants *Sherwood & Co.*

John Cutler, K.C., opened the Plaintiffs' case, and called evidence in support thereof. At the close of the Plaintiffs' evidence *Levett, K.C.,* summed up the Plaintiffs' case.

Evidence was then called for the Defendant.

The Defendant *Sherwood* deposed that he adopted the term "Erect Form" in consequence of something that he had heard from Miss *Paton*, who was in charge of his stall at the Exhibition of 1900, as to American ladies inquiring for corsets as "Erect Form," and that he then arranged with *Russell*, the manager of his factory, to put "Erect Form" on all the new shapes of his straight fronted corsets for the next season, and that these goods were in his travellers' hands in the first week in January 1901, and that they took orders for the same in January 1901. He also proved subsequent orders, and was corroborated by

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Miss *Paton, Russell, Aston*, one of his travellers, and some customers. *Howitt*, manager of *R. and W. H. Symington, Ltd.*, deposed that his firm put on the market in 1886 a corset called the "American Corset." *Adolf Rosenthal* (who was not connected with the Defendant *Rosenthal*) deposed that some of his advertisements in 1900 contained the words "Straight Fronted American Shaped Corsets," and that he began to use "Erect Form" in 1902 because he considered it common property. The Defendant *Rosenthal* was called, and said that, after consulting his solicitor in November 1901, he put on the market the "W. R. American Shaped Corset." He called his corset "American Shaped" to let the public know that they were American shaped, but not American—"W. R." and "Whalonia" distinguished his corsets from others.

Astbury, K.C., said he had other witnesses to prove that "Erect Form" meant the shape of the corset and not the maker, but he did not propose to call them.

Judgment was then given as follows:—

FARWELL, J.—In my opinion this is a plain case. In fact, I think I might almost go so far as to congratulate the Plaintiffs on their courage in bringing such an action.

The Plaintiffs in the year 1892 registered in America a Trade Mark, which consisted of a crown with the letters "W. B." in the centre. They carried on business as corset-makers in America, with that as their Trade Mark. In the beginning of 1901 they sent an emissary over here to try and extend their trade in England, the trade being then under the Trade Mark registered in America in 1892—a crown with "W. B." in the middle. The particular form of corset they were endeavouring to press was a straight-fronted corset, which they told me they had designed in May 1900. The phrase "Erect Form" was certainly used in the course of their attempting to push this corset which, as I say, was then being sold under the registered American Trade Mark in America, and it was brought over by that description to England. The phrase "Erect Form" was certainly used. Then in July 1901, in consequence of some complaints or proceedings taken by a firm of *Pretty*, claiming to be the owners in England of a registered Trade Mark "W. B.," the Plaintiffs dropped that title altogether, and in October 1901 they registered in America "Erect Form" as their Trade Mark. Of course they have never registered that in England, nor do I think they would have any prospect of successfully attempting to do so. From July 1901 their traveller pressed the sale of their corsets, describing them as "Erect Form."

In the year 1900 Mr. *Sherwood* had had a stall at the Earl's Court Exhibition, exhibiting corsets, and in consequence of a certain conversation which the lady in charge of the stall had with some American ladies, it occurred to him that the words "Erect Form" would be admirably adapted to describe the straight-fronted corsets which had recently been introduced from America, and which produced on the figure that desirable consummation, an erect form. Accordingly, early in the year 1901, he adopted the term "Erect Form"; and he put it on the tape which has been applied to his corsets since then, which was some months before the Plaintiffs sold, or attempted to sell, in England. Prior to action, the whole extent of the Plaintiffs' business of selling under "Erect Form," appears to be this—They took, or, rather, the lady took, a single room in Great Portland Street, the rent of which she cannot remember (from which I infer it was not large); she did not put up the name of the firm, and there was no outward or visible sign that the corsets were being sold there, or that any business was being done there. There she remained for about six months. Then she went on to the City, and there there were certain numbers of sales. If I followed her evidence aright, she said that the customers all told during the period were, according to her present recollection, 28, although in her former evidence she thought there were 24. I will give her the benefit of the doubt, and say there

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were 28. So far as regards the state of the history at the period when the action was commenced.

On that the Plaintiffs say that the words "Erect Form" denoted to the English world at large corsets made by *Weingarten*, and nobody else. A
 5 more astounding proposition I do not think I ever heard. It is a mere question of fact. I am not going into the cases, but I will just take the way that it is put by Lord *Halsbury* in the "Cellular" case,* because it sums up the matter quite clearly. I think Mr. *Levett*, when he once found that I was satisfied that the words were descriptive, as indeed the Court of
 10 Appeal have already held they were in another case, felt that the difficulty was insuperable. Lord *Halsbury*, quoting one of the Scotch Judges, says:—"An invented name has either no meaning at all, or no meaning
 "in relation to the goods which it denotes; and it has been held that a trader
 "who selects such a name for the purpose of distinguishing his goods from
 15 "those of other traders is entitled to be protected in the use of the sign which
 "he has chosen. In such a case the mere fact of the use of the arbitrary sign
 "by a rival trader raises a presumption of a design to pass off his goods under
 "false colours which it is not easy to displace." Then he goes on: "I think it
 "must be admitted that the word 'Cellular' has not lost its descriptive signifi-
 20 "cation according to the use of the cloth trade: in other words, that the primary
 "meaning has not been displaced by the secondary meaning which the
 "Pursuers allege and have in part proved."

It seems to me unless and until you have either shown that the words are not, properly speaking, descriptive, or that the trade has been so large in extent
 25 and so widely known—the difficulties in proving which are almost insuperable—that the primary signification in respect of the goods in question is lost and the secondary signification has attached to those words that they mean goods made by the Plaintiff, instead of the primary signification, you cannot succeed. In this case it is absolutely impossible for anyone to hold that the Plaintiffs
 30 have carried on business in such a way or to such an extent as to have any reputation at all at the time of the issue of this writ in England as attaching to these words.

That the words are descriptive, if it were not for Mr. Justice *Joyce's* judgment in the former case, I should have thought was plain beyond argument. The
 35 particular case before him was not the same as the present case. There the words were printed in a particular fantastic fashion and there might have been something in the mode in which they were printed. I am not really concerned with that—it was a question of fact just as this is—and if I were concerned with it the Court of Appeal reversed the learned Judge, so the decision would
 40 be the same as I am coming to in the present case.

Mr. *Levett* attempted to make a distinction which was so subtle that I really think it eluded me, but so far as I am concerned I can see no difference as to descriptiveness, whether the word which describes the goods be an ordinary
 45 adjective, or whether the adjective is one which describes the effect which the goods do produce upon the person to whom they are supplied. Whether I say that some patented food is tasteful, or whether I say that it is strength-producing, it appears to me to be descriptive in either case. The one describes the effect it has upon my palate, the other describes the effect it has upon my strength; it is a distinction I do not follow.

50 In my opinion it is plain that these words are clearly descriptive, and there is no sort of right in the Plaintiffs to claim them at all.

I do not think it is worth while to go through all the evidence. I have submitted to take it at considerable length because the parties tell me that they are

* *Cellular Clothing Company v. Maxton and Murray*, 16 R.P.C. 397.

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proposing to go so far as the House of Lords with this case. Accordingly, I have allowed a great deal of evidence to go in, but I do not think I need go through it now. I must say this that my own opinion, as to these words being descriptive, is entirely confirmed by the evidence of the Plaintiffs' own witnesses, and by the advertisements that I have seen. It is quite plain to my mind that in every case, both of advertisement and what the witnesses have said, the words are used in order to call the attention of the wearers to the fact that these corsets produce an erect form, and that in my opinion is descriptive. 5

As for deception, of course there is no question of deception if the Plaintiffs have no right to the words, but to my mind it is almost ludicrous to talk of deceiving by the use of such words as these. The Defendants in both cases sell under their ordinary well-known Trade Marks. They do not simply describe these as "Erect Form," and nothing more. So far as the Defendant *Rosenthal* is concerned his box has upon it "American Shaped Corset, Erect Form," and in the corner his well-known, ancient Trade Mark "Whalonia," and "W. R." also on the side. No one has been called to say that they have been deceived. No one has said that anyone could be deceived. On the contrary, it seems to me it is quite plain no one could be deceived. 10 15

With regard to the other case the box is even more plain. I have not got it before me, but, according to my recollection, I do not think the words "Erect Form" appear outside the box at all. The corset inside does not contain any representation. "Erect Form" is printed in an ordinary way, and is apparently on the face of it, descriptive and as far as regards the words "American Shape" I think they are intended to represent, not that the corsets are made in America—I do not see how the Plaintiffs can possibly say that it means they are made in America when they have themselves set up a factory in England and make them here—but they represent that they are of a shape which was not even invented in America but in Paris, but which apparently the Plaintiffs, and a great many of the other traders, thought was invented in America. 20 25 30

Then, as regards Mr. *Rosenthal* in particular, he has given his evidence in the box with great candour. He says: "Yes, I knew that there were several people using the words 'Erect Form'; I knew of four advertisements; I did not know which of them used it; I consulted my solicitors and took Counsel's opinion; I did not desire to do anything wrong; I was advised that 'Erect Form' were simply descriptive words, and that I could use them and have done so." I entirely agree with him. I see no reason whatever why he should not. 35

Then, as regards Mr. *Sherwood*, his position is even stronger. It seems to me that he was first in the field. If anybody had any reason to complain he might have a cause of complaint as against the present Plaintiffs. 40

The result is that on the evidence that I have heard, and also on the question of construction of the words so far as it is for me, I am of opinion that the Plaintiffs' case fails in both instances and both actions must be dismissed with costs. 45

The costs of three Counsel were allowed to the Defendant *Rosenthal*.

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IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, STIRLING, and COZENS-HARDY.

March 25th, 28th, and 29th, 1904.

IN THE MATTER OF BURROUGHS, WELLCOME & CO.'S TRADE MARKS,

5

and

IN THE MATTER OF THE PATENTS, DESIGNS, AND TRADE
MARKS ACTS, 1883 to 1888.

*Trade Mark.—Fancy word.—Motion to expunge Trade Marks from the Register.—Motion dismissed.—Appeal dismissed.—Patents, Designs, and Trade
10 Marks Act, 1883, section 64, subsection 1 (c).*

*In and previously to the month of March 1884 B. W. & Co. were manufacturing and selling compressed drugs in a solid form and of a lenticular or bi-convex shape. In 1884 B. W. & Co. registered the word "Tabloid" in Classes 3 and 42, and in 1885, in the same classes, a device
15 consisting of a frame with the word "Tabloids" inside. They had previously registered and used the word "Tablet" for the same goods. H. S. W. (who was the surviving partner of the firm of and traded as B. W. & Co.) invented the word "Tabloid." B. W. & Co. commenced an action against T. and C. complaining of their selling goods not of the Plaintiffs' manufacture in response to orders and
20 prescriptions for drugs under the designation of "Tabloids," or "Tabloids—" "B. & W.," or "Tabloids—Burroughs, Wellcome & Co.," preceded or followed by the name of the particular drugs required. The Defendants denied any passing off, and, as to the Trade Marks, moved to expunge them from the Register on the ground that "Tabloid" was not a fancy word; that it
25 was descriptive; that it was used by B. W. & Co. in 1884 and onwards to denote the various articles so sold; and, further, that it had not acquired an exclusive meaning as denoting the goods of B. W. & Co., but, on the contrary, had acquired a meaning connoting any compressed medicine made up in a bi-convex or similar shape, and denoted as well the goods of other manufacturers
30 as those of B. W. & Co. The Plaintiffs' contention was that "Tabloid" and "Tabloids" were fancy words and that they meant exclusively the goods of B. W. & Co. It was held at the trial that "Tabloid" was a fancy word as applied to the goods for which it was registered, and that the Motion to rectify*

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failed and must be dismissed; and that the Plaintiffs had made out their case and were entitled to an injunction to restrain the Defendants from using the word "Tabloid" or "Tabloids" so as to pass off goods not manufactured by the Plaintiffs as or for the goods of the Plaintiffs. The Defendants appealed from the judgment so far as it dismissed their Motion.

Held, by the Court of Appeal, that "Tabloid" was at the date of registration not descriptive, and was a distinctive fancy word not in common use. The appeal was dismissed with costs.

When it is sought to remove from the Register a mark which has been long registered on grounds depending on the proof of facts existing at the date of registration, the Court will give the registered owner the benefit of any doubt. 10
Chesebrough Manufacturing Company's Trade Mark, 19 R.P.C. 342; L.R. (1902) 2 Ch. 1 followed.

H. S. Wellcome, a manufacturing chemist, the surviving partner of the firm of and who traded as Burroughs, Wellcome & Co., on the 17th of January 1903 15 commenced an action against Thompson and Capper, who were chemists carrying on business at Manchester and elsewhere. The Plaintiff claimed— (1) an injunction to restrain the Defendants, their servants and agents, from in any manner passing off, or attempting to pass off, any preparation not of the manufacture of the Plaintiff as or for a preparation of the Plaintiff; (2) and from 20 selling or offering, or exposing or advertising for sale, or procuring to be sold; any such preparation as aforesaid under the name of "Tabloid" or "Tabloids," or "Tabloid B. W. & Co." or "Burroughs, Wellcome & Co.'s Tabloids," or under any other name which by reason of colourable imitation thereof or otherwise was calculated to represent or lead to the belief that such preparation 25 was a preparation of the Plaintiff; (3) and from selling or supplying any such preparation in response to orders for "Tabloid" products or a preparation of Burroughs, Wellcome & Co.; (4) and from in any manner infringing the Plaintiff's registered Trade Marks Nos. 36,154, 36,155, 42,378, 42,379, 225,812, 225,813, 225,814, 245,815, and 225,816, or any of them; (5) an Order for delivery 30 up, &c.; (6) damages, or an account of profits; and (7) costs.

By his Statement of Claim the Plaintiff stated that his was an old-established and extensive business, and that (2) in the year 1884, or prior thereto, he was desirous of inventing and adopting a new and distinctive Trade Mark and trade designation for goods of his which should effectively distinguish them from 35 the goods of all others engaged in a similar business, and to this end he invented and adopted as his Trade Mark and trade name the word "Tabloid," which had never existed before and was absolutely new and unknown. (3) On or about the 14th of March 1884 he applied for and in due course obtained, in the name of his firm, the registration as of that date of the word "Tabloid" as his Trade 40 Mark No. 36,154 in Class 3 in respect of chemical substances used in medicine and pharmacy. He further subsequently, on or about the 27th of January 1885, applied for and in due course obtained similar registration as of the last mentioned date of the word "Tabloids" in a frame as his Trade Mark No. 42,378 in respect of the same goods in Class 3. Both the registrations had been duly 45 renewed and were standing in the name of the Plaintiff. (4) On or about the 14th of March 1884 he applied for and in due course obtained, in the name of the firm, the registration as of that date of the word "Tabloid" as his Trade Mark No. 36,155 in Class 42 in respect of preparations of food for human use. He further subsequently, on or about the 27th of January 1885, applied for and 50

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in due course obtained similar registration as of the last mentioned date of the word "Tabloids" in a frame as his Trade Mark No. 42,379 in respect of the same goods in Class 42. Both the registrations had been duly renewed and were standing in his name. (5) At or about the date of the first registration he began to use, and had ever since used, the word "Tabloid" as his distinctive Trade Mark in respect of a very great variety of goods of his manufacture. Such user had been on an enormous scale within the United Kingdom, and had been both on the bottles and receptacles in which the goods were sold, and also in numberless advertisements and other documents circulated among the trade, the medical profession, and the public, for the purpose of advertising and popularising his goods. In addition to the British trade the mark had also been used most extensively in connection with goods exported by him to all parts of the world. (6) By reason of such user and of the novelty and distinctiveness of the Trade Mark and trade name, and of the very great expenditure of the Plaintiff in advertising and making it known, the same had become and was very familiar to the trade and the medical profession and also to the public as indicating exclusively that any preparation to which it was applied or in respect of which it was used was a preparation of the Plaintiff's, and anyone who ordered or asked for any preparation by that name intended and expected to receive a preparation of a particular make—*i.e.*, the Plaintiff's make and no other. (7) The Defendants carried on business as chemists in Manchester at two shops, No. 51, Piccadilly, and No. 39, Deansgate, respectively, and were in the habit of supplying preparations not being the Plaintiff's preparations in response to orders for "Tabloids" or "Tabloid" preparations, even when the name *Burroughs, Wellcome & Co.* or "B. W. & Co." was expressly mentioned. Amongst the Particulars given were the following:—(1) a verbal order for "*Burroughs, Wellcome & Co.'s* Cascara Sagrada Tabloids"; (2) a written order for "Tabloid Potassi Chlorate—B. W. & Co."; and (3) a written order for "Cascara Sagrada Tabloids—B. W. & Co."; and nine other orders, written and verbal, for "Tabloids" of various kinds. (8) The goods supplied in response to such orders were in no single instance the Plaintiff's goods, and the Defendants were deliberately and knowingly selling other preparations in place of the Plaintiff's preparations and in response to orders for the Plaintiff's preparations, and were thereby representing that they were in fact the Plaintiff's preparations, and were by so doing deceiving the public and injuring the Plaintiff, and unless they were restrained by the Order and injunction of the Court from continuing so to do they would still further deceive the public and injure the Plaintiff. The Plaintiff claimed the relief stated above.

By their Defence the Defendants stated that—(1) the word "Tabloid" was not a new word or an invented word, but was merely the word "Table" with the common suffix "oid." The word was not distinctive of the Plaintiff's goods, but was a word commonly used in the medical and pharmaceutical professions and in ordinary literature to indicate shape or form; (2) they admitted the registrations set out in paragraphs 3 and 4 of the Statement of Claim. Such registrations were improperly made, and the Defendants were moving to rectify the Register by removing such marks therefrom. The Defendants had not infringed such Trade Marks or any of them; (3) they admitted that the Plaintiff had largely used the word as a descriptive word upon and in connection with medical preparations put up in tabloid form. Save as in the Defence admitted the Defendants denied that the said word had been used by the Plaintiffs; (4) they denied all the matters alleged in paragraph 6 of the Statement of Claim; (5) save as to the sales referred to in paragraph 7 of the Statement of Claim to *W. H. Sykes*, to *W. B. Davies*, and to *T. Smith*, the Defendants had no knowledge of the sales referred to in such paragraph, but as they claimed the right to sell medical preparations in tabloid form under their ordinary description

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of "Tabloids," they were prepared for the purposes of the action to admit the sales referred to in such paragraph other than the sales to *Sykes, Davies, and Smith*; (6) they did not supply to *Sykes, Davies, or Smith* any goods not of the manufacture of the Plaintiff as and for the goods of the Plaintiff. As to *Sykes and Davies*, both such purchasers were in terms informed by the Defendants' salesman that the goods supplied to them were not the goods of the Plaintiff but the goods of the Defendants. As to *Smith*, the order was not in writing, but was given verbally, and no mention was made by *Smith* that the goods of the Plaintiff were required, nor was any written order given for such goods; (7) they admitted that the word "Tabloid" coupled with the letters "B. W. & Co." and the name "*Burroughs, Wellcome & Co.*" meant goods of the Plaintiff and no others. They had not supplied, and were not in the habit of supplying, any goods other than the goods of the Plaintiff under orders in which the word "Tabloid" was coupled with such letters or name; and they were and always had been ready to give any undertaking not to sell under orders so given any goods other than those of the Plaintiff. No notice of any such claim, or any notice at all, had been given to the Defendants prior to the issue of the writ in the action; (8) they denied each and every of the facts alleged in paragraph 8 of the Statement of Claim; (9) save as specifically or impliedly admitted they denied each and every of the allegations in the Statement of Claim as if the same had been specifically denied.

The Defendants gave notice of a Motion to rectify the Register by expunging the Plaintiff's trade marks; and the Particulars of Objections upon which they relied in support of their Motion were as follows:—"(A) As to all the 'Trade Marks—(a) the word 'Tabloid' is not an invented word; (b) the word 'Tabloid' has reference to the character and quality of the goods to which it is applied; (c) the word 'Tabloid' does not consist of or contain any of the essential particulars specified in section 64 of the Patents, Designs, and Trade Marks Act, 1883; (d) the word 'Tabloid' was prior to the date of the registration of the marks the word commonly and generally used to describe small tablets or pilules. (B) As to Trade Marks Nos. 42,378 and 42,379—(a) the marks were registered without any disclaimer under section 74 of the Patents, Designs, and Trade Marks Acts of the word 'Tabloid.' And the Applicants claim that such marks should be removed, or, alternatively, that the Register should be rectified by the addition to the Register of a disclaimer of any right to the exclusive use of the word 'Tabloid'; (b) the marks are not used by the Respondents"; (c) the Objections set out in paragraph (A). (C) As to the Trade Marks Nos. 225,812, 225,813, 225,814, 225,815, and 225,816—(a) the Objections set out under paragraph (A); (b) none of such marks have been used upon any of the goods in Classes 1, 2, 39, 44, or 48, in respect of which the mark has been registered.

The Action and Motion were tried together, judgment being given on the 14th of December 1903 by *Byrne, J.*, who decided that "Tabloid" was a fancy word as applied to the goods for which it was registered, and that the Motion failed; an injunction was granted in the action (*ante*, p. 69).

The Applicants on the Motion to rectify appealed from that part of the judgment dismissing the Motion.

Walter and Gray for the Appellants.—This is an appeal from *Byrne, J.*, on a Motion to rectify the Register. The first two marks are the word "Tabloid," registered in Classes 3 and 42, and the next two marks are the word "Tabloids" within a device consisting of a frame. The marks were registered under the Act of 1883. An attempt was made to crave in aid of the Act of 1883, but under section 27 of the Act of 1883 these marks were subject to the liability of being removed under section 90 of the Act of 1883; and the Motion is for rectification by "persons aggrieved" on the ground that the word could not be registered

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- under section 64 of the Act of 1883. "Invented words" were only introduced by the Act of 1888. [Section 64 (1) (c) of the Act of 1883 was read.] It was held by *Byrne, J.*, that the words "Tabloid" and "Tabloids" were distinctive fancy words not in common use. We submit that this was wrong. It was held under
- 5 the Act of 1883 that no words came within the Act which had reference to the character or quality of the goods. [Section 64, as amended by the Act of 1888, was read.] In the "*Solio*" case it was held that (d) and (s) are to be read disjunctively. It was proved in the present case that before registration
- 10 Mr. *Wellcome* had used and registered the word "Tablet" to describe doses of medicine put up in compressed form, and he wanted a more euphonious word, and invented, as he said, "Tabloid." He had also used "Ovoid" for other articles. The word "Tabloid" was used as early as 1885, but there was no
- 15 reference to the mark in advertisements until 1888. It is important to see how the mark was at first used. The first user was "Tabloids of," &c., on the goods. Next, in 1888, "Tabloids" was printed in inverted commas; then
- 20 "Trade Mark" in small letters was added; in 1896 "Tabloid System" appeared. [The Respondents' advertisements were referred to.] All the above were used in the advertisements; also "Tabloid Brand" and "Tabloid Products." These users were to describe articles, not distinctively, but
- 25 to describe tablets. It was a new word for the same article—compressed bi-convex drugs. "Tablet" was dropped in 1888 or 1889, but the words were from 1885 to 1888 used interchangeably for the same article. "Tabloid" was a word full of meaning, and the dictionaries show what everyone took it to mean. We refer to the literature on the subject.
- 30 [*Neville, K.C.*—The word had never been used before registration, and I submit that any literature subsequent to the date of registration is irrelevant.] The termination "oid" has the meaning of "like." [*VAUGHAN WILLIAMS, L.J.*—It excludes the thing that it is like, as in anthropoid.] So "Tabloid" is like a tabula. [The following works were also
- 35 referred to:—The Practitioner, article on "Tablet Triturations"; the Century Dictionary of 1889; *Foster's* Encyclopædic Medical Dictionary of 1892; *Cassell's* Encyclopædic Dictionary; *Chamber's* Twentieth Century Dictionary, 1901; Standard Dictionary, 1895; Encyclopædia Britannica; Dr. *Foster's* Reference Book of Practical Therapeutics; and Latin Grammar of Pharmacy.] This
- 40 literature shows the meaning of the word in general use. The dictionaries refer to the word as "Table" plus "oid," and give the same meaning of it. Some have recently added, "used as a trade mark" at the instance of the Respondents, but they keep the derivation and meaning, and the addition has no effect. The evidence of the witnesses shows that when they first met the
- 45 word they all thought it was formed from "Table" and "oid," and gave the meaning to it accordingly. We rely on *Van Duzer's Trade Mark* and *Leaf's Trade Mark* (4 R.P.C. 31; L.R. 34 Ch. D. 623); applying the tests there laid down—Is tabloid fanciful in its application to the article to which it is applied? One has to know the article to which the word is
- 50 proposed to be applied. Knowing this anyone would say the word meant like or having the form of a table or tablet. The word suggests descriptiveness. [*COZENS-HARDY, L.J.*—What would it suggest with regard to malt, for instance?] It has never been used for that, and the registration might be limited. The law as laid down in *Van Duzer's Trade Mark* has never been
- 55 departed from. Then there is *Re Trade Mark Bovril* (13 R.P.C. 382; L.R. (1896) 2 Ch. 600). Applying the test there laid down, "Tabloid" did at the date of its registration describe the goods. "Tabloid," if it had no definite meaning, at all events suggested one. A word to be a fancy word must be non-descriptive and meaningless as applied to the goods. The actual word in this case differs from
- "Bovril" because "oid" is a well-known termination. Even as an invented

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word under the Act of 1888 "Tabloid" would not stand the tests laid down in the "Solio" case (*Eastman's Photographic Materials Company's Application*, 15 R.P.C. 476; L.R. (1898) App.Cas. 571). "Tabloid," although a new word, was not an invented word within the meaning of the Act. [COZENS-HARDY, L.J.—I do not think it is enough that it was never seen before—e.g., "Uneeda" 5 was invented in that sense.] "Tabloid" is made by merely adding a suffix to an ordinary English word. [VAUGHAN WILLIAMS, L.J.—How would Lord Herschell have dealt with "Satinine" as an invented word? He would have struck it out. [The passage from Lord Herschell's judgment referring to "Satinine" was read.] [VAUGHAN WILLIAMS, L.J.—I gather that if he had 10 arrived at the conclusion that "Satinine" was an invented word, then, unless there was some other reason for it not being an invented word, he would have held that it was an invented word, notwithstanding that it was "Satin" plus a termination.] He says, "if the word be an invented word"; it was not before him to consider whether it was. [VAUGHAN WILLIAMS, L.J.— 15 It may be that the word "Satinine" was objectionable on other grounds—that is to say, that he did not think that Lord Justice Kay's objection to it, that it did not involve much invention, was a good one.] I do not suggest that the quantum of merit has to be considered, but Lord Herschell is not expressing any approval of "Satinine." [VAUGHAN WILLIAMS, L.J., referred to Lord 20 Herschell's judgment as to a Trade Mark not being registered as a reward of merit, and added: Although you may say that the word is compounded of familiar parts, this word deprives no one of any right.] It prevents the proper development of the English language; a mere variation of the orthography or termination of a word does not make an invented word. It cannot be that any 25 word not previously used, however made, is an invented word. "Tabloid" trespasses against all the judgments in the "Solio" case. There is no invention in merely altering the termination of a word. [VAUGHAN WILLIAMS, L.J.—What would you say to "Pastiloid" for lozenges? It would be bad. "Electroid" has been held to be bad (*Hannah's Trade Mark*, 7 R.P.C. 46); that was a new 30 word. [VAUGHAN WILLIAMS, L.J.—Is there any purely English word in which "oid" has been used as a suffix? "Crystalloid" is of Greek origin. "Table" is of Latin origin. [VAUGHAN WILLIAMS, L.J.—Are there any words of Latin origin ending in "oid"? Yes, fungoid and ovoid. Zincoid is in a dictionary, and is made from an English word. "Savonol" has been held to be a 35 good invented word (*J. C. and J. Field, Ld. v. Wagel Syndicate, Ld.*, 17 R.P.C. 266), but it was held to have no meaning. In *Meaby & Co., Ld. v. Triticine, Ld.* (15 R.P.C. 1), "Triticumina" was held not to be a fancy word. A fancy word has no meaning. The use and advertisements of tabloid show that it was descriptive, and "Tabloids" in itself shows that "Tabloid" had a meaning; 40 "Tabloids" was used on a box of bi-convex articles as descriptive of them. The Respondents themselves dedicated the word to the public as a descriptive word. In *Grossmith's Trade Mark* (6 R.P.C. 180), "Emollio" was held not to be a fancy word. [VAUGHAN WILLIAMS, L.J.—Is it not, as *North, J.*, puts it, not whether the words are capable of a meaning, but whether they, as used, 45 were intended to describe a quality? Here the first user shows the descriptive meaning of "Tabloid." *Linoleum Manufacturing Company v. Nairn* (L.R. 7 C.D. 834) was not a case of registered Trade Mark, but on this point the principle is the same. When the Trade Marks were first registered the Respondents used "Tabloid" descriptively, and it cannot have been distinctive at any 50 time. The word has passed into the language, and is used in current literature. [Several instances were quoted.] The Appellants had never used the word on goods, but what was complained of in the action against them was that they had supplied tablets in response to written orders for "Tabloids." There is no difference in meaning between "Tablet" and "Tabloid." It is submitted that 55

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- the word "Tabloid" is not distinctive and is not a fancy word. "Distinctive" governs everything in section 64 (1) (c). "Distinctive" means indicating goods of a particular person (*Kerly* on Trade Marks, 2nd edition, page 132). [VAUGHAN WILLIAMS, *L.J.*—Should not the Trade Mark Acts be construed so far as possible to prevent fraud?] But people ought not, in the words of *Fry, L.J.*, be allowed to appropriate parts of the open common of the English language. The word "Tabloid" must be considered as a whole and its meaning, when invented, to the ordinary intelligent members of the public with knowledge of what it is to be applied to. Under the Act the true test is whether, knowing the article, the word has a descriptive meaning or whether it suggests one; as examples of the rule, new words formed merely by adding suffixes to ordinary words are not distinctive fancy words. In the "*Bovril*" case the Lords Justices directed themselves as jurors on the principle of the "*Melrose*" case. [The judgment of *Byrne, J.*, was read.] One has to take the word "Tabloid" in connection with goods of the kind for which it was used, *i.e.*, medicine in tablet form, and with the knowledge of the use of "Tablet." The question is whether the word was obviously non-descriptive of the goods to which it was applied. The evidence as to the origin of the word is important. The intention of the inventor of a word is not conclusive, but it is material.
- [VAUGHAN WILLIAMS, *L.J.*—A fancy word is not generally chosen haphazard. The mere fact that the train of thought in the inventor's mind can be traced back is not fatal to the word. The fact that the characteristics of the article may have suggested the word does not make it bad; what does make it bad is that the name should describe a characteristic of the article.] By reason of what had taken place before, the word was aptly descriptive of the article, and Mr. *Wellcome* knew this. Just as "ovoid" was formed from *ovum*, Mr. *Wellcome* made "Tabloid" from tablet, meaning of the shape of a tablet. The use of the suffix "oid" was well known in 1884. If a literary man was asked in 1884 to coin a word to aptly describe something of the form of a tablet, he could not have made a more apt word. [VAUGHAN WILLIAMS, *L.J.*—A literary man who did not happen to be a scholar.] "Tablet" means a little table. [VAUGHAN WILLIAMS, *L.J.*—Then in making "Tabloid" you leave out all that makes the diminutive.] No word has been upheld as a Trade Mark in which every syllable has a meaning; if "Tabloid" is good, any word ending in "oid" is good. In 1884 anyone seeing "Tabloid" would associate it with "Tablet," which the Respondents had used to describe compressed drugs. The word would suggest not table, but compressed drugs known as tablets, and tabloid is formed similarly to ovoid, fungoid, and so on. The dictionaries at once attached a meaning to the word and included it:
- Moulton, K.C.*; and *Neville, K.C.*, for the Respondents.—The first principle applicable here is that the question of the propriety of the registration must be judged as at the date of registration, namely 1884. No subsequent matters can affect the question. A mark rightly registered can only be destroyed by the behaviour of the owner. Thus the use of the word in literature in the passages quoted is immaterial. [VAUGHAN WILLIAMS, *L.J.*—It is not contended that we must not take the date of registration.] Secondly, it is no objection to a mark that it is not used on all the traders' goods, and, if used on some only, the word comes to denote the particular goods as well as the trader; thus "Kodak" got to denote the goods and then got to be used as a verb, but never to denote goods which did not come from the *Eastman Company*. It is a fallacy to say that the word must not describe the goods as well as the origin; it would be different if the owner had applied the mark to goods of other traders. "Vaseline" was unquestionably applied to denote petroleum jelly that came from the *Chesebrough Company*. "Tabloid" has never meant anything except the Respondents' goods.
- Dictionaries have been quoted against us. [COZENS-HARDY, *L.J.*—That did

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not impress me.] [VAUGHAN WILLIAMS, *L.J.*—It made no impression on me.] The real issue is whether in 1884 the word was a distinctive fancy word not in common use. It had never been used, so it was not of course in common use. And by adoption by the Respondents it could be made a distinctive word, for it was not a mere descriptive word. [COZENS-HARDY, *L.J.*, referred to "Uneda."] That was a mere mis-spelling. In 1884 people would not know the meaning of "Tabloid"; it was a fancy word, and could be made distinctive. As to whether the word was a "fancy word"—the history of the law must be kept in mind. An extended meaning was formerly given to the judgments in *Van Duzer's* case. [VAUGHAN WILLIAMS, *L.J.*—No one says now, as was said in that case, that a "fancy word" must be absolutely meaningless.] Until the "*Bovril*" case that was supposed to be the effect of *Van Duzer's* case, the considerations are different when one is not dealing, as in *Van Duzer's* case, with an existing word. [COZENS-HARDY, *L.J.*—The mere fact that the word is new is not enough, is it?] The fact that the word is new and has no meaning is sufficient. [COZENS-HARDY, *L.J.*—Does not your argument involve that *North, J.*, was wrong in the "*Triticumina*" case?] That word would be registered since the "*Solio*" case, and so would "*Emolio*." The test of a new fancy word is whether it had a meaning to ordinary people. [COZENS-HARDY, *L.J.*, referred to the Respondents' use of the words "*Tabloids*" "of" at or about the time of registration.] That referred to the Respondents' goods, and not those of other traders; it is not a descriptive user, but always of their goods. [COZENS-HARDY, *L.J.*—Does not the user at or immediately after registration throw a light on the meaning of the word as originally registered?] There is no objection to using a mark descriptively of the goods of the owner. In considering whether "*Tabloid*" was a fancy word in 1884, it is difficult to put aside the familiarity with it since gained, but this should be done; moreover, the long user by the Respondents to denote their goods should be considered as in the "*Vaseline*" case.* What could "*Tabloid*" mean in 1884? There is no English word formed by adding "oid" to an English word. The Respondents registered also "*Valloid*"—what does that mean? It was suggested that "*Solio*" had a meaning, but the House of Lords asked—What does it mean? The use of "*Tablet*" for the article helps the Respondents, anyone can go on using it; but "*Tabloid*" was, I submit, a fancy word, and has no meaning in itself. The registration hurts no one, and the word was in fact invented by Mr. *Wellcome*. [The judgment of *Lindley, L.J.*, in *Re Trade Mark Bovril* (13 R.P.C. 382) was referred to.] If the "fancy" is to be got from the application, it must be obviously non-descriptive; but a distinction is made between ordinary words and new words. "*Somatose*" is now registered. The termination "ose" of "*Somatose*" is as common as "oid." Neither word had any meaning in itself. In 1884 "oid," although it had been used scientifically, was not a common suffix; in English words it is part of a root, as in "avoid" and "devoid." But, even if "oid" is a common suffix meaning like, then like what? Does "*Tabloid*" mean "like a tablet" or "like a table"? The only thing common is flatness, which the Respondents' compressed drugs do not have; they are bi-convex. *In the Matter of the Registered Trade Marks of Bass, Ratcliff, and Gretton, Ltd.* (19 R.P.C. 529), shows that where a mark has been long on the Register every reasonable intendment ought to be made in favour of the owners. [COZENS-HARDY, *L.J.*, referred to the "*Vaseline*" case on the same point.] The evidence is that "*Tabloid*" meant the Respondents' goods to doctors and chemists; as to the public, different views were taken by the Appellants'

* *Cheesebrough Manufacturing Company's Trade Mark*, 19 R.P.C. 342; L.B. (1902) 2 Ch. 1.

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witnesses. The Respondents' witnesses, with a few exceptions, said it had no meaning apart from the Respondents' goods. As to "Tabloids of," &c., if the word was a fancy word, that use subsequently, even if improper, does not affect the registration; but it was not improper. "Tabloid of chlorate of potash" means *Burroughs, Wellcome & Co.'s* manufacture of chlorate of potash. After the "Solio" case it cannot be said that the earlier decisions were favourably looked on in the House of Lords; the question in each case is one of fact. The onus is on the Appellants after this lapse of time.

- Walter in reply.—The reference to *Bass' Trade Marks* and the "Vaseline" case is merely *ad misericordiam*. However long a mark has been on the Register, it ought to be taken off if it was not a good Trade Mark. [VAUGHAN WILLIAMS, *L.J.*, read from the judgments in the "Vaseline" case.] That rule is only applicable to the facts there; the question was whether the mark had been used as a name for patented goods. [VAUGHAN WILLIAMS, *L.J.*—The longer the mark has been on the Register the more strong is the onus in favour of the registered owner and against the person seeking to remove it.] The line of reasoning does not apply here, because the validity of the registration of "Tabloid" depends whether the word was within the definition, and time has made no alteration. The question is whether the word could be registered in 1884. The only answer of the Respondents to our arguments is that tabloid if it implies anything implies table—that is, flatness. Even so the comparison is with pills; a "tabloid" is a flat kind of disc as opposed to a pill. If the word is table plus "oid" it is not meaningless and not within the definition of the Act. The issue is whether the word was a distinctive fancy word not in common use as applied to the goods—*e.g.*, to tablets.

- VAUGHAN WILLIAMS, *L.J.*—This, in a sense, is rather a difficult case; not in the sense, however, that the law is difficult. I do not think there is much difficulty in point of law. It may be said generally of the law that it is now defined by *Van Duzer's* case as modified by the "Bovril" case, and I do not think that the law thus defined is very difficult to ascertain. But the case is a difficult one because it is really a question of fact which we have to decide here, and that question of fact is: What did the word "Tabloid" convey to those who heard it at the date of the registration in 1884? The difficulty of answering that question is, of course, very considerably increased by the lapse of time. We have had quoted to us dictionaries and literary productions which have been published during the whole period between 1884 and the present time. I do not think that sort of evidence has assisted us much. In fact I go a step further; I think that that sort of evidence has had a direct tendency to make our task more difficult, because it is difficult to eradicate altogether from one's mind the statements which have been made about the use of this word "Tabloid," and its meaning at the material date, which everybody agrees is the date of the registration. But this case is not the first in which the Courts have had to deal with that sort of difficulty. I think, as appears from the passages which were read yesterday from the judgments of Lord Justice *Stirling* and Lord Justice *Cozens-Hardy* in the *Chesebrough* case, that the Court when it has had to deal with a question of fact of this sort, long after the date of the registration, has laid down a rule that in such a case the presumption ought to be in favour of the persons who have had that registered Trade Mark for a length of time; and the onus of proof as to what was the user of the word, and what it was understood as conveying at the date of registration, ought to be thrown upon the persons who seek, after such a lapse of time, to say that the Trade Mark ought not to have been registered. But I should be very sorry if it was supposed from what I am saying that I in any way mean to suggest that this sort of presumption in favour of the Trade Mark, which has been registered for such a long period, ought to be allowed to overmaster the plain evidence showing that the Trade

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Mark, having regard to the state of things at the date of the registration, ought not to have been registered. I take it, if you had something registered as a Trade Mark, which the evidence showed clearly ought not to have been registered at the date when it was, that no presumption would justify us in keeping such a Trade Mark on the Register.

Now, I have to ask myself: What was the character of this Trade Mark in 1884? What did the word "Tabloid" convey at the moment when it was registered? In my judgment this word "Tabloid" was, at the time of the registration, a distinctive word suggesting the source or the origin of the goods which were covered, or intended to be covered, by it; and I think, further, that at that date the word "Tabloid" was not a descriptive word. As the word was understood at that time it really conveyed to the hearers no peculiar quality of the goods which were offered to the public. I think that the word "Tabloid" may properly be described at that time as being a fancy word. I do not myself think that, having regard to the judgments in the "Bovril" case, it could be said that a word is to be treated as a descriptive word because it might suggest some idea to the hearer. It seems to me that the Trade Mark which was under discussion in the "Bovril" case proves the contrary. It is perfectly impossible to say that the word "Bovril" used in respect of an extract of meat did not suggest beef, or an ox, as the materials from which the extract was made. But the mere fact that the word "Bovril" did contain such a suggestion, to my mind is inconsistent with the idea that the fancy word must be absolutely unsuggestive. It must not be descriptive, but it need not be absolutely unsuggestive. Speaking of this, I would like to add that it is not to the interest of any community that you should so deal with any subject-matter which is regulated by Statute law as to make the rule of law, that you deduce from the Statute, inconsistent with the practice of mankind. Nobody supposes that, when you sit down and choose a fancy name, you ask someone to make a selection at haphazard from a dictionary of a number of words, and you then put them into a bag, and dip your hand in, and leave it to chance what word it is that you select, and then use that word however foreign it may be to the subject-matter to which you propose to apply your Trade Mark. The real fact of the matter is that when a man sits down to choose a Trade Mark, his mind will naturally run on words that are more or less cognate to the articles with reference to which the Trade Mark is proposed to be registered. He sits down and does that, and having done that, his next care is that the cognate word that he so chooses shall not be such that it really describes the quality or the form of the article to which the Trade Mark is meant to apply. When one is dealing with the question whether a word is descriptive, I think one must always bear in mind that for a word to be really descriptive, it must describe something which is material to the composition of the article to which the Trade Mark is intended to apply. If it does not, I do not think that one ought easily to arrive at the conclusion that the word is descriptive, because it in some way or other might suggest, or even more than suggest might more or less describe, the particular style in which the person registering has been in the habit of making up his goods, although that is always a course which must be adopted with great care, because one must be careful never to violate that rule which has to be applied in respect to Trade Marks, namely, that you must not adopt as your Trade Mark any word whatsoever which would deprive the public of the full and free user of that word when it is a known word, and especially when it is a known word in a particular trade. But, subject to those observations, I say not only is this word distinctive, but, in my opinion, it is not a descriptive word.

I am not forgetting that which Mr. *Walter* and Mr. *Gray* pressed on us very much. They said that the present case was to be distinguished from

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- the "Bovril" case, because "oid" was a known termination of English words, and that "ril," which was the final syllable of "Bovril," was not; and they, as I understood, argued this, that the result was that in "Bovril" you had got a word which suggested "ox" or "beef" as the substance out of which
- 5 the soup was made, but that that did not matter as the word was, strictly speaking, a fancy word, not being a word in the English language at all. I want to say with reference to that, that according to my view, this word "Tabloid" was, in substance, an unknown word at the moment when Messrs. *Burroughs and Wellcome* adopted it. It is quite true that you could find a
- 10 good many words terminating with the suffix "oid," which were familiarly used by English speaking people; but in the main I think that those words will be found not to be words of English origin. They were words which did not at all set one's teeth on edge when one heard them, as "Tabloid" rather does mine. They were words like "trapezoid," "aneroid," and other words in which
- 15 the first or commencing syllable, as well as the suffix, was of Greek origin. But I doubt very much whether "oid" had then become, as it has become now, a recognised termination for English words. Therefore, be that as it may, I do not think that, if you took the average Englishman in 1884, the word "Tabloid" in respect to these medicines would have conveyed
- 20 anything to his mind at all. And even at the present moment there seems to be a great difficulty in saying what it is which the word "Tabloid" is supposed to convey. Certainly, if you take the meaning of the word "Table" or "Tablet" it does not suggest, to my mind, anything of the form of these tabloids which were produced and sold by Messrs. *Burroughs and Wellcome*; but I say, as a
- 25 jurymen, that this is my conclusion in fact, and I cannot express that conclusion in better words than it is expressed by Mr. Justice *Byrne*, when he said: "I think the case is near the line, but treating it as a matter of fact in the particular case, I come to the conclusion that in March 1884 the word was 'not really intelligibly describing the thing sold,' which is the way in which
- 30 'Lord *Lindley* at page 607 of the report of the 'Bovril' case puts the form of 'direction to the jury.' I should have preferred to express my judgment by saying, that I entirely agree with the judgment of Mr. Justice *Byrne*. I think that this word is a fancy word in that it was a coined word; I think that it did not describe anything intelligibly in 1884 to those who heard it.
- 35 I agree that you cannot say that the word is absolutely unsuggestive, but any suggestion which you derive from it is a very inaccurate suggestion as to shape, and an inaccurate suggestion as to a matter, which was in no sense essential, or of any practical materiality in the articles to which it was applied.
- 40 There is only one other matter upon which I propose to make any observation and that is on the part of the argument which was based upon the previous user of the word "Tablet." I think that the word "Tablet," although that of course was an accepted English word, did not really convey anything material about the article to which the Trade Mark was to be applied. Then can it be said
- 45 that because Messrs. *Burroughs and Wellcome* registered the word "Tabloid" two years afterwards that their previous user of the word "Tablet" converted that which but for that previous user would have been an invented word, a coined fancy word, into a word that by their previous user of the word "Tablet" had acquired a meaning. I do not think so. Of course, this is really only part
- 50 of what one has to consider as a matter of fact. I am, notwithstanding that previous user of the word "Tablet," of opinion that "Tabloid" when first adopted as a Trade Mark by Messrs. *Burroughs and Wellcome*, did not intelligibly describe anything.
- Under these circumstances I have only thought it right to mention what was
- 55 said about the word "Tablet," and the user of it as a Trade Mark, to show that

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in arriving at the conclusion of fact which I have arrived at I have not left that argument out of consideration.

In my judgment, the judgment of Mr. Justice *Byrne* is quite right.

STIRLING, *L.J.*—In this case the validity of the registration of the words "Tabloid" and "Tabloids" under the Trade Marks Act of 1883, as applied to substances used in medicine and pharmacy, is called into question. The registration is justified upon the ground that at the date at which it took place, namely, 1884, the word "Tabloid" was a distinctive fancy word not in common use. I think there is no contest that the word was not in common use in the year 1884. It appears to have been a word coined at that date, and if it was not in common use at that time it might fairly be taken to be distinctive. Therefore I do not enter into any discussion as to the terms "distinctive" and "in common use." The real contest in this case is whether these words were in 1884 "a fancy word or words," or not. The meaning of "fancy word or words," as used in the Act of 1883, has been considered by the Court of Appeal in two cases, namely, in *Van Duzer's* case, and in the case of the Trade Mark "Bovril," and, of course, by those decisions we are bound. The first of these cases, *Van Duzer's* case—with which was heard another case called *Leaf's* case—related to the application, in the way of a Trade Mark, of the words "Melrose" and "Electric" (words which were not new at the time), and some principles were laid down with regard to the meaning to be attributed to the words "fancy word or words" which were supposed to extend to all cases; but that matter came to be re-considered in the "Bovril" case, which had to deal with a word which, like the word "Tabloid," was a new one at the date of its registration.

It appears to me, as I think it appeared also to Mr. Justice *Byrne*, that the proper course is to deal with the present case relating to the word "Tabloid" in the way in which the Court of Appeal dealt with the word "Bovril" in that case. What does Lord Justice *Lindley*, who gave the leading judgment in that case, say is the proper thing for him to do? He said, "It would be altogether wrong for us to take the Act of 1883 and substitute for the words 'fancy word' 'a non-descriptive word.' That is not the language of the legislature. But I agree that a word which describes the article to which it is applied will not do. Let us, therefore, ask ourselves whether 'Bovril' is a descriptive word." Then he said: "To my mind it is not descriptive, notwithstanding Mr. *Bower's* very ingenious argument. He tries to make it out to be a descriptive word, not by taking the word, but by taking a little bit of it, and he says that because 'Bov' may have some relation, and does have some relation to 'ox,' therefore 'Bovril' describes what? I do not see that it describes anything at all." Then later he said: "I think it is pre-eminently and purely a question of fact. Now I ask myself this? Supposing that a jury were asked to say whether on the 2nd November 1886 'Bovril' was a fancy word not in common use, and supposing they said, upon a direction from the judge, which I think it would be the duty of the judge to give, that if they were of opinion that it really intelligibly described the thing sold it would not do, could they, with that direction, reasonably say it was not a fancy word not in common use? I do not think they could." Now I think that that is the process which we ought to apply to the word "Tabloid" which we have to consider here. Mr. Justice *Byrne* has taken that course, and his answer to the question has been already read, therefore I do not repeat it. Speaking for myself, I can only say that I entertain greater doubt than he seems to have entertained, or than is felt by my brother, as to the result of the evidence in this case. Mr. Justice *Byrne* said that there was a suggestion or atmosphere of description about the word as used, but he came to the conclusion that it could not be said to have been other than a fancy word.

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I should now like to state the difficulty which occurs to me. The question which we have to consider is whether "Tabloid" was a fancy word when it was invented in the year 1884. In dealing with that question we must not treat it in an abstract manner, but see what were the circumstances which preceded the introduction of the word. I think we start with this: that before 1884 the word "Tablet" was well known in connection with medicines. I find in the Imperial Dictionary, published in the year 1874, that is ten years before, this meaning of "Tablet": "A medicine in a square form; tablets of arsenic were formerly worn as a preservative against the plague. A solid kind of electuary or confection made of a dry ingredient usually with sugar and formed into little flat squares; called also lozenge and troche. Also applied to anything made up in a flat, square shape, as a tablet of soap." Further, we know this, that for some years previous to 1884 this very firm of *Burroughs and Wellcome* had found that a convenient and useful mode of making up medicines was to make them up in the form of what they called tablets, which were, broadly speaking, small amounts of substance of globular shape, and they had sold medicines so made up under the name of "Tablets," and in fact they had registered the word "Tablets" as their Trade Mark in connection with these preparations. They appear to have been advised that "Tablets" was a word the registration of which could not be maintained, and they applied themselves to see whether they could not find another word which could be used apparently for the same purpose as the word "Tablet" had been used before. They fixed on the word "Tabloid." What does "Tabloid" suggest? It suggests a connection either with "Table" or "Tablet." It is registered as applied to preparations for use in medicine and pharmacy. We have not heard of the use of the word "Table" in connection with medicine or pharmacy, but, as I have already stated, we have heard of the use of "Tablet," and it seems to me that it might be inferred from the evidence which we have in this case, that the word "Tabloid" had a descriptive meaning. The termination "oid" is one which is not uncommon in words which are used in the English language, and it means of a shape or kind similar to that which is denoted by the early part of the word to which "oid" is affixed. I confess I feel a great deal of hesitation as to whether the true inference of fact is not that "Tabloid" did mean, as applied to medicine, a preparation made up, not precisely in the same form as that which had hitherto been designated under the name "Tablet," but of something of the same kind, and whether it is not descriptive in that sense. But Mr. Justice *Byrne* has taken a different view, and my brethren both take the same view as Mr. Justice *Byrne*; and I think in deciding this question that it has to be borne in mind that, as laid down in the "Vaseline" case, when a Trade Mark is impeached after so long a distance of time as occurs in this case, it is fair that if any doubt exists the person who has had his Trade Mark on the register for that long period, and has openly and largely made use of it, should have the benefit of the doubt.

For these reasons I am not prepared to differ from Mr. Justice *Byrne*, or my Brethren, and therefore think that the Appeal fails.

COZENS-HARDY, *L.J.*—I share to a large extent the difficulties which have pressed on Lord Justice STIRLING. If this case had fallen to be decided ten years ago I cannot doubt that the mark would have been taken off the register as not being "a distinctive fancy word not in common use." But the swing of the judicial pendulum has been very great, and the extreme point of that swing is to be found, I think, in the present case.

The real difficulty is, I think, in putting a meaning on the word "fancy." It certainly means something more than new or newly coined; and certainly means something more than "invented." The real difficulty is to say what more is involved in the use of the word "fancy."

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The present case is extremely near the line, but reading, as I have done very carefully, the decision of the Court of Appeal in the "Bovril" case, by which, in so far as it may qualify earlier cases, we are bound, I am driven to the conclusion, that, although this word is suggestive of description, it is not necessary that the word should be absolutely unsuggestive of it, and I cannot find in the present case anything sufficiently near to description to enable me to distinguish it from the "Bovril" case. As a jurymen, I am not able to say that "Tabloid" really intelligibly described a thing, to use the words of Lord Justice *Lindley*, or that it is otherwise than non-descriptive and meaningless as applied to the articles in question, to use the words of Lord Justice *Lopes*. 5 10

Under these circumstances I cannot say that Mr. Justice *Byrne* was wrong in declining to remove from the Register a mark which had been on for nearly 20 years, and I agree therefore, that the appeal must be dismissed.

Moulton, K.C.—The appeal will be dismissed with costs.

VAUGHAN WILLIAMS, *L.J.*—Yes. 15

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE KEKEWICH.

13th November, 1903.

SIDDALL AND HILTON, LD. v. WOOD.

Patent.—Action for infringement.—Invention.—Subject-matter.—Novelty.— Judgment for Defendant.—Certificate as to Particulars of Objections. 20

The Plaintiffs sued for infringement of a Patent for an invention for wire mattresses, which, according to the Plaintiffs' expert witness, consisted in the combination of several parts, with a practical continuity from side to side of the framework, over which the wire fabric was stretched; the device of gaining strength by overlapping being admitted to be an old idea. In dismissing the action on the ground that no invention was proved, the Court granted a Certificate as to the Particulars of Objections delivered by the Defendant with respect to (a) subject-matter, (b) vagueness, and (c) novelty. 25

Siddall and Hilton, Ltd. v. Wood.

In this action the Plaintiffs, *Siddall and Hilton, Limited*, carrying on business as mattress makers at Sowerby Bridge, Yorkshire, and elsewhere, sought an injunction to restrain the Defendant, *Thomas Wood*, carrying on a similar business at Heckmondwike, Yorkshire, from infringing their Patent No. 3625 of 1893, for wire mattresses.

In 1893 a Patent for wire mattresses was granted to *Edward Rowcliffe Billington*, the object of the invention being to prevent the "sagging" in wire mattresses, and the consequent rolling together of sleepers thereon. In 1900 the Plaintiffs purchased *Billington's* business, together with this and other Patents.

The Complete Specification of the Patent in question so far as material for this report was as follows:—"This invention relates to that class of wire mattresses in which the wire is worked into the form of springy material, such as in what are called woven wire mattresses, consisting of interlaced spiral wire coils, which material is supported in a frame and held therein under tension.

"According to this invention, a mattress bottom is composed of two or more strips or pieces of the wire material, the edges of which overlap each other. By this construction, I effect, amongst other things, a strengthening portion in the middle of or at parts within the outer edges of the mattress where the different strips of material overlap; I also provide a bed bottom or mattress in which the separate parts are unaffected one by the other when a weight comes upon any individual one, and at the same time obviate the opening of the bottom at the parts where the edges come, and so prevent the clothes being caught between the edges. To give further strength, the over-lapping parts of the mattress may be made stronger than the main portion by having an extra number of coils, or by employing coils of a stronger wire."

The Drawing annexed having been described, the Patentee claimed:—"The herein described improved wire mattress, that is to say, a mattress wherein the wire fabric in different parts of its width is in separate pieces or strips (*i.e.* non-continuous in its width), and the inner selvages or edges of which overlap or lie one upon another: for the purposes specified."

The Plaintiffs, by their Particulars of Breaches, alleged that at various dates in 1901, 1902, and 1903, the Defendant sold in open market three wire mattresses which he had made in accordance with their Patent.

The Defendant admitted that he had made the mattresses in question in a particular way, but denied that in so doing he had infringed the Plaintiffs' Patent, which, he further submitted, was bad for want of subject-matter and for lack of novelty. He delivered with his Defence the following Particulars of Objections:—"(1.) The alleged invention is not the proper subject-matter for Letters Patent. (2.) The Complete Specification of the alleged invention does not distinguish what parts of the alleged invention are claimed as new and what parts thereof are not new. (3.) The said Complete Specification is ambiguous and misleading in that it does not appear thereby whether or not the alleged invention includes the construction or arrangement of a mattress in two or more strips of fabric. (4.) If the alleged invention includes such construction or arrangement as last aforesaid, the alleged invention was not new at the date of the Letters Patent No. 3625 of 1893, having regard to the common and public knowledge at the date thereof. (5.) The alleged invention was not new at the date of the said Letters Patent, but had been published in this realm before the date thereof in and by the publications following, namely: (a) By the Complete Specification of Letters Patent No. 16,967 of 1889, granted to *William Parish Hoskins*; page 5, line 25 to line 31, and Figure 14. (b) By the Complete Specification of Letters Patent No. 17,942 of 1889, granted to *Thomas Edmund Wales* and *Alfred Edmund Wales*; page 1, line 6 to line 18; page 2, line 7 to line 17, Figure 1. (c) By the Complete

Siddall and Hilton, Ld. v. Wood.

"Specification" of Letters Patent No. 9597 of 1891, granted to *Thomas Edmund Wales* and *Alfred Edmund Wales*; page 2, lines 56-57, Figure 29."

The action came on for trial with witnesses before Mr. Justice KEKEWICH on the 13th of November 1903, when the Plaintiffs exhibited three models of wire mattresses which they alleged were covered by their Patent; No. 1 5 consisting of three strips of wire material, two wide pieces and one narrow piece, laid over the meeting edges of the others; No. 2, of two pieces stretched on a frame "in different parts of its width" so as "to overlap one another"; and No. 3, of three pieces stretched on the same principle. They admitted no novelty in the several parts, but they claimed that the combination was an 10 invention in that it gave a strengthening where the pieces overlapped and obviated the parting or opening of the mattress down its centre.

P. O. Lawrence, K.C., and *Walter* (instructed by *Ridsdale and Son*, agents for *J. H. Simpson* of Dewsbury) appeared for the Plaintiffs.

Warrington, K.C., and *Waggett* (instructed by *Van Sandau and Co.*, agents 15 for *Iveson and Macaulay* of Heckmondwike) appeared for the Defendant.

The only witness called by the Plaintiffs was a Patent agent, *Mr. Royston*, who said in examination in chief, that the main characteristic of the invention was the existence of a practical continuity from side to side of the mattress-frame together with an absolute separateness of the parts, and that he did not 20 find this in the prior Specifications referred to by the Defendant. But in cross-examination he admitted that the making of a mattress in two or more strips was an old idea when the Plaintiffs' Patent was taken out, and that the strengthening was only caused by the double thickness of one piece of fabric overlapping the other, which was a device familiar to mechanics; the 25 only novelty he could see was in the separableness of the pieces *plus* the continuity.

At the close of the above evidence:

KEKEWICH, *J.*—It seems to me that *Mr. Royston's* evidence puts the Plaintiffs out of Court altogether at present. Had you not better consider 30 whether it is worth while to go on?

Lawrence, K.C.—I will not trouble your Lordship with any further evidence.

Warrington, K.C.—I ask your Lordship for judgment for the Defendant.

KEKEWICH, *J.*—I do not think there is any invention, and I do not think the Defendant has infringed.

Warrington, K.C.—I ask your Lordship to hold that my Objections have 35 been substantiated.

Lawrence, K.C.—My friend has not put a single Specification.

Warrington, K.C.—I was relieved from the necessity of putting any of the Objections.

After some further discussion a Certificate was given as to Nos. 1, 2, 3 and 4 40 of the Particulars of Objections above set out.

*In the Matter of Hattersley and Jackson's Patent.**Before THE SOLICITOR-GENERAL.*

February 24th and 25th, 1904.

IN THE MATTER OF HATTERSLEY AND JACKSON'S PATENT.

Application for leave to amend Specification. Opposition thereto on the
 5 *ground that the amendment proposed would make the Specification, as*
amended, claim an invention substantially larger than or different from the
invention originally claimed. Amendment allowed by Chief Examiner, acting
on behalf of Comptroller. Patents, &c. Act, 1883, section 18 (8) and (9).

Held, on appeal, by the Law Officer, that the amendment would make the
 10 *Specification claim an invention substantially different from that originally*
claimed, there being no claim to the combination asked for on amendment, all
reference to one part of the combination having been omitted by an amendment
already made. The decision of the Chief Examiner was reversed and the
application was refused.

15 On the 29th of March 1897 a Patent (No. 8000 of 1897) was granted to
Richard Longden Hattersley and Simeon Jackson for "Improvements in
"dobby looms for weaving."

The Specification was amended by order of the Comptroller-General in 1901,
 and as amended was, so far as material for this report, as follows:—"This
 20 "invention relates to improvements in that class of weaving looms in which
 "the shedding of the warp is effected by what is commonly termed a dobbie."

"When the draw hooks of a double lift dobbie engage with one of the draw
 "knives and are 'drawn' or operated the ends of the balks to which the hooks
 "are attached describe a curve or move in a curved path and rise and fall, as
 25 "the case may be, according as to whether the lower or upper end of the balk
 "is operated, and consequently the hooks do not remain in line with the
 "direction of motion, which causes unnecessary friction and loss of power.

"To obviate this as much as possible we incline the upper and lower guides
 "in which the draw knives work towards each other sufficiently to raise the
 30 "lower knives and lower the upper ones as the hooks are operated and thus
 "keep the hooks practically horizontal or in line with the direction in which
 "they are moving.

~~"A further advantage in respect to ease of working and to keeping the~~
~~"draw hooks in line is attained by arranging the fulcrum of the jack levers~~
 35 ~~"or bell crank levers in the same plane as the centre of attachment of the~~
~~"hooks to the balk levers when the latter are not lifting, and by arranging~~
~~"the centre of attachment of the balk levers to the jack levers in such a posi-~~
~~"tion in relation to this plane that when operated they oscillate between two~~
~~"points located equidistant from each side of the plane.~~

40 "Fig. 1 represents an elevation looking towards the front of the loom of
 "such parts of a dobbie as are necessary to illustrate the application of our

In the Matter of Hattersley and Jackson's Patent.

"improvements. Fig. 2 is a separate view of one of the jack levers together with its balk lever and hooks.

"The upper guides A, A, in the side frames A² of the dobby in which the knives A³ work are inclined down towards the lower knife guides A⁴, A⁴, consequently as the hooks B, B move backward and forward their ends B², B² 5
"are kept more in line with their centres of attachment B⁴ to the balks B¹.

~~"The parts are so relatively arranged that when they are not operated by the knives the fulcrum B⁶ of the jack levers B⁷ is vertically beneath the centres of attachment B⁴ of the hooks B as shown by the broken line a, b, Fig. 2. And the centre of attachment B² of the balk B¹ to the jack lever B⁷ lies, before the jack lever is moved, such a distance from the line a, b, that when the said lever is fully operated it passes to a position equidistant from said line but on the opposite side."~~ 10

The first claim was as follows:—(1) A dobby in which the knife guides are inclined towards each other substantially as herein shown and described." The 15
"second claim struck out by amendment was, ignoring the erasure, as follows:—
"(2) A dobby which, when the jack levers are not 'lifting,' has the fulcrum of the bell crank levers in the same plane as the centres of connection of the hooks to the balk levers, and in which the centre of connection of the balk levers to the jack levers is in such a position that in the movements of the 20
"latter such centre passes equidistant on each side of said plane, substantially as herein shown and described." The second and third claims after the amendment were as follows:—(2) The combination of the rod C having "a notched end adapted to be supported by one of such notches and the rocking shaft D² having arms D, D³, and D⁴ substantially as herein shown 25
"and described and for the purpose specified. (3) The combination of the levers K and L arranged and operating substantially as herein shown and described and for the purpose specified."

In 1902 *George Hattersley & Sons, Ltd.*, as owners of the Patent, brought an action for infringement against *George Hodgson, Ltd.*, which was tried before 30
Mr. Justice *Kekewich* on the 15th and 16th of July 1903, with the result that the action was dismissed (*see* 20 R.P.C. 591).

Application for leave to amend the Specification was made at the Patent Office on the 16th of July 1903; the amendments applied for were as follows:— 35
(1) To restore the second paragraph of the description which had been cancelled by the previous amendment. (2) To insert in the preamble to the claims after the words "we declare that," the words "we make no claim to a dobby with inclined guides except when the centres B⁴, B⁶, and B⁸ are arranged in relation to one another and to the inclined guides as shown and described." (3) To insert in Claim 1, after the words "each other," the words "and having the 40
centres B⁴, B⁶, and B⁸ as shown in Fig. 2 arranged."

Notice of opposition to this application was given by *George Hodgson, Ltd.*, on the following grounds:—(1) That the amendment if allowed would make the Specification as amended larger than or substantially different from the invention claimed by the Specification as it stood before amendment. (2) That 45
the amendment if allowed would include and contain a combination not claimed in the Specification as originally filed and not claimed in the Specification as amended on the 28th day of October 1901. (3) That the proposed amendment is an attempt to reinstate in the Specification an invention which has been specifically disclaimed by previous amendment, and that this should not be 50
allowed.

The application came on for hearing before the Chief Examiner, acting for the Comptroller-General.

In the Matter of Hattersley and Jackson's Patent.

The CHIEF EXAMINER.—This is an application under section 18 of the Patents, &c. Act, 1883, to amend the Specification.

This case is one of considerable difficulty, and as a principle on which certain amendments have for many years been allowed by the Comptroller of Patents is questioned, and a decision upon the point will affect the practice of the Office in very many cases, I will deal with the case at some length, and consider—(1) Whether amendments of a certain kind as set out below are allowable; and (2) whether this case relates to an amendment of the kind, and whether in the special circumstances of this case the amendment should be allowed.

As to the first point—An inventor who has claimed *per se* a feature of construction in a machine shown in his Specification sometimes finds that the said feature has been used in some other machine, and he thereupon seeks to amend his Specification by disclaiming the feature when used in a machine other than the one he has particularly shown. This he does by amending his claim so that it is no longer a claim to the feature *per se* but only to the feature in combination with something else. If this combination was clearly contemplated by the inventor when he filed his Specification, and was set out in the original Specification, it is the practice to allow the amendment as by way of disclaimer (Patents Act, section 18, subsection 1), and as making the invention smaller than and not different (subsection 8) from that of the original claim.

The object of the Patentee in amending is generally to prepare for an action for infringement against a person who is taking the combination which is claimed in the Specification as amended, and of which the Patentee is, *ex hypothesi*, a meritorious inventor. If such amendments are to be refused, an inventor may be compelled to make more numerous claims, setting out separately all possible combinations of the parts of the machine he has invented, so that if it should subsequently appear that some of them have been used in other machines he may excise certain claims, and leave those he is ready to fight upon.

The aforesaid practice is based upon the decision of the Law Officer in *Cochrane's* case (Griffin's Patent Cases, page 304), and as, during the hearing of the present opposition, there was some discussion as to the meaning of the Law Officer as reported, I will state how I have hitherto understood this decision. *Cochrane* described in his original Specification a core for a slag mould which had a wedge-shaped front and the back of which might be of any one of various shapes. The Drawing showed a core with a rounded back, and the Specification stated, "Although I prefer to make the part *a* of a rounded shape yet it will be evident that it may be of other configuration, so long as the angular or wedge-shape of the part *a* be retained." The original claim was for "Constructing cores for slag moulds of an angular or wedge-shape whereby they are rendered of increased strength and are made to operate with a wedging action upon the slag and to effect the complete discharge thereof, substantially as herein described," and this was amended so as to read, "Constructing cores for slag moulds of an angular or wedge-shape on the one side and of rounded shape on the opposite side whereby they are rendered of increased strength and are made to operate with a wedging action upon the slag and to effect the complete discharge thereof, substantially as herein described," and thus became a claim to a particular front when used with a particular back, whereas no claim to a back was originally made. During the argument the Law Officer said: "It seems to me that if the original Specification claims all angular or wedge-shape slag boxes, and then words are put in which confine it to the angular or wedge-shaped boxes which have a rounded back, the invention is thereby confined to a particular class of slag box, which was included with a number of other slag boxes in the previous claim. If you have got a claim for A, B, C, D, E, and F, and you confine it to F, that is a narrower claim than the original, and it is not different because it is included in the old claim."

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The discussion which arose at the hearing of the present case was as to the meaning of the above-stated illustration given by the Law Officer. I have always considered the series of letters "A, B, C, D, E, and F" of the Law Officer to refer to a possible series of moulds with wedge-shaped fronts and with various shaped backs. Thus "A" is a core with a wedge-shaped front and one particular form of back. Thus "B" is a core with a wedge-shaped front and another particular form of back. Thus "C" is a core with a wedge-shaped front and a third particular form of back. Thus "D" is a core with a wedge-shaped front and a fourth particular form of back. Thus "E" is a core with a wedge-shaped front and a fifth particular form of back. Thus "F" is a core with a wedged-shaped front and a rounded back, to which the amended claim was confined.

It will be noted that in cases of this kind the claim of the Patentee to the particular combination shown is the same before as after the amendment, and under the original claims no other person than he could construct the combination. It appears to me that such amendments are clearly allowable.

As to the second point, the Specification now under consideration relates to the construction of dobby looms, and comprised originally, *inter alia*—(1) The use of inclined knife guides (original Claim 1); and (2) The use of a particular arrangement of the centres of certain levers (original Claim 2).

An amendment of the original Specification has already been allowed by which the claim to the arrangement of centres was excised, and also the corresponding parts of the description in the body of the Specification, but the Drawings which form part of the Specification were left unamended, and show clearly the arrangement of centres.

It is now desired to amend the Specification by adding to the first claim words of reference to the arrangement of centres shown on the Drawings, so that the claim may read:—"A dobby in which the knife guides are inclined " towards each other, and having the centres B⁴, B⁶, and B⁸ as shown in Fig. 2 " arranged substantially as herein shown and described."

It is also desired to restore part of the description in the body of the Specification relating to the arrangement of centres, and to insert in the preamble to the claims, after the words "we declare that," the following disclaimer, *viz.*:—"We make no claim to a dobby with inclined guides except when the centres " B⁴, B⁶, and B⁸, are arranged in relation to one another, and to the inclined " guides, as shown and described, but "

The effect of the amendment is to alter the claim from a claim for a dobby having the inclined guides and any arrangement of centres (since some arrangement of centres is necessary for a dobby of this class) to a claim for a dobby with the particular arrangement of centres shown in the Drawing. It appears to me that, following the decision of the Law Officer, such an amendment is allowable, provided the particular arrangement of centres is clearly shown.

The Specification under consideration has been construed by Mr. Justice Kekewich in the case of *Hattersley & Sons, Ltd. v. George Hodgson, Ltd.*

The learned Judge stated that "the evidence shows that what he (Mr. Jackson, " one of the grantees) has brought out and perfected is a practical machine, " possessing very great advantages. . . . It is a combination of " inclined knife guides together with a particular alteration of centres of the " balk lever and the jack lever. . . . The first claim is for a dobby " in which the knife guides are inclined towards each other substantially as " herein shown and described. . . . That inclination is not only " substantially, but with great particularity, shown and described in the letter- " press and in the Figures. . . . Now, there is in the Figures a " description showing the other element of combination. All the witnesses " agree that the Figures are accurate enough, and with those Figures before a " competent workman there will be no difficulty in completing the very " machine which the Plaintiffs claim as their own. It is on the Figures, but,"

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(as regards the amended Specification) "it is not in the description in the letter-
 "press. The result is this that the Plaintiffs have told the
 "public that a useful invention may be made in one or two ways, either with
 "or without the alteration of centres" the machine "is useful
 5 "if made according to the Figures as they intended it to be made."

The Patentees accordingly wish to make their bad Patent good by amendment. The merit being in the combination not previously specifically claimed they wish to limit the first claim to such combination. This is, I think, clearly allowable under the decision in *Cochrane's* case, and I think it would be very
 10 unfortunate if a Patentee were precluded from so amending. Further, as the arrangement of centres, though shown in the Drawing forming part of the Specification, is not described in the body of the Specification as it stands, they wish to restore part of the description of the original Specification which was excised on the previous request for amendment. This, in my view, may
 15 properly be allowed as by way of explanation of the drawing (*see*, for instance, *Morgan's* case in Griffin's smaller book, page 17) and as making clear the original intention of the Applicant (*see*, for instance, the cases of *Kelly v. Heathman*, 7 R.P.C. 343, and *Allen's* case, page 3, and *Beck and Justice's* case, page 10, of Griffin's smaller book). Or, in the alternative, this part of the
 20 amendment might be regarded as by way of correction, for there is strong evidence of mistake in the form of the previous amendment.

Mr. Terrell objected to the amendment on the three following grounds:—

(1) The Patent was originally for two inventions, viz., A (the inclined guides) and B (the arrangement of centres), and the Patentee now says, "My invention
 25 "instead of being an invention of A, and an invention of B, is going to be an "invention for combining A and B." I am unable to agree. The Patent was originally for a dobby having two special features A and B. The first claim was for a dobby having A; this dobby must necessarily have some arrangement of centres, and B was clearly the particular arrangement of centres contemplated
 30 by the Patentee. But the Patentee, probably fearing that his A might be taken for use with another arrangement of centres, did not limit its use to a use with B only. Now he wishes to do so. (2) Admitting that if you have a Patent for a combination of A, B, and C, and you seek to amend it by adding D to it, you are reducing the claim, this is different from the present amendment. I fail to
 35 see the alleged difference, and I cannot agree with Mr. Terrell in the distinction which he draws between adding D to the combination A, B, C, and adding D to A, since the use of the letters is purely arbitrary. Thus the arrangement of knife guides which has been referred to above as A is really a combination of parts, each of which might, for the purpose of argument, be designated by a
 40 separate letter of the alphabet. (3) Under *Moser v. Marsden* the Specification as amended must be treated as if it had been the original Specification, and the Patentee seeks to introduce into the first claim an integer not in the original Specification. It appears to me that the integer is already in the Specification since the Drawings form part of the Specification and it is clearly shown in the
 45 Drawings. In any case, as matter is often inserted on amendment explanatory of the Drawing, and as in this case there can be no doubt that the matter added (page 3, lines 46 to 52, restoring the original Specification) was contemplated by the Patentee when he filed his original Specification, I see no objection to allowing the integer to be introduced into the body of the
 50 Specification, and when this is done Mr. Terrell's objection under this head will be removed.

In this result, I allow the Specification to be amended in the manner set out in the copy accompanying the request for amendment.

The Opponents appealed from the decision of the Chief Examiner.

55 *Terrell*, K.C., and *J. O. Graham* appeared for the Appellants; *Bousfield*, K.C., and *W. Neill* appeared for the Respondents.

In the Matter of Hattersley and Jackson's Patent.

Sir E. CARSON, S.G.—In this case the Patentee seeks to amend his Specification under somewhat peculiar circumstances. In the Specification as originally lodged the Patentee made two claims:—“(1) A dobbie in which the knife guides are inclined towards each other, substantially as herein shown and described. (2) A dobbie which, when the jack levers are not ‘lifting,’ has the fulcrum of the bell crank levers in the same plane as the centres of connection of the hooks to the balk levers and in which the centre of connection of the balk levers to the jack levers is in such a position that, in the movements of the latter, such centre passes equidistant on each side of said plane, substantially as herein shown and described.”

With reference to the second claim at line 45 of the Specification, the following description of the arrangement is given:—“The parts are so relatively arranged that when they are not operated by the knives the fulcrum B⁴ of the jack levers B⁷ is vertically beneath the centres of attachment B⁴ of the hooks B as shown by the broken line *a—b*, Fig. 2. And the centre of attachment B⁸ of the balk B⁶ to the jack lever B⁷ lies, before the jack lever is moved such a distance from the line *a—b*, that when said lever is fully operated it passes to a position equidistant from said line but on the opposite side.”

The Opponents, who are the Appellants before me, were apparently advised that the Patent was invalid and proceeded to manufacture “dobbies” containing the improvements claimed and as set out in the Specification and the Drawings. The Patentee thereupon amended his Specification by striking out the second claim and the paragraph in the Specification to which I have already referred. Having amended his Specification he brought an action against the Appellants for infringement which was tried before Mr. Justice *Kekewich* on the 15th and 16th of July 1903. A report of the trial is to be found in Vol. XX. of the Reports of Patent Cases, page 591. Shortly stated, Mr. Justice *Kekewich* seems to have held that upon the Specification amended in the manner I have stated the Patentees could not succeed as the inclined knife guides, unless in combination with the centres of the balk and jack levers, were valueless, and constituted no improvement, and that such combination was not claimed by the Specification as amended, and he accordingly dismissed the action. It is under these circumstances that the Patentee comes before me and asks to restore the passage in the Specification which he had in his previous amendment struck out: to insert a disclaimer “to a dobbie with inclined guides except when the centres B⁴, B⁶, and B⁸ are arranged in relation to one another and to the inclined guides as shown and described,” and to amend Claim 1 so as to read as follows:—“A dobbie in which the knife guides are inclined towards each other and having the centres B⁴, B⁶, and B⁸ as shown in Fig. 2 arranged substantially as herein shown and described”; in other words, he seeks to make such an amendment in his Specification as will make it a claim for the combination to which Mr. Justice *Kekewich* referred.

It was argued before me by Mr. *Terrell* that as the claim in its present form is for a combination of all the parts of a dobbie with the inclined knives if I were by amendment to allow the Patentee to limit the combination to some of the parts only, such amendment would be “substantially larger than the invention” as it at present stands. If Mr. *Terrell* was right in his construction of the claim I think his contention would be sound. But I do not accept the construction he asks me to put upon the claim. In my view the claim is for a dobbie into which has been introduced knife guides inclined towards each other, and if you combine the knife guides with a particular alteration of centres of the balk lever and the jack levers and seek to introduce such a combination into a dobbie, you do not enlarge but, on the contrary, you limit the invention (*Cochrane's case*, Griffin's Patent Cases, page 304).

There remains, however, the question whether if I allow the amendment it “would make the Specification as amended claim an invention substantially

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"different from the invention claimed by the Specification as it stood before amendment." (Section 18, subsection 8, Patents Designs and Trade Marks Act, 1883.)

- Mr. Bousfield referred me to the case of *Kelly v. Heathman*, which is reported in 45 Chancery Division, page 256,* in which the Patentee was allowed to amend his Specification by striking out three claims and substituting for them a combination including the three claims previously made. Mr. Justice North held that there was no objection in that particular case to the amendment, but he so decided upon the ground that even before amendment there was a claim to a combination, though not happily expressed, and that the amendment amounted to nothing more than a correction or explanation, which is of course admissible. The case before me is, in my opinion, very different. The Specification before it was amended—purposely I think—claimed the inclined knife guides and the alteration of centres of jack levers, &c., separately, in the belief that each constituted a patentable invention. No doubt, if an application was made to amend the claim by claiming the two in combination, there would be a strong ground for contending that as each had been claimed separately the claim could be limited by claiming them in combination. The Patentee, however, upon finding that he could not sustain the second claim, instead of applying for an amendment by way of combination, preferred to abandon his second claim and to rely upon his first claim, which was a larger claim than in combination it would have been, and, in the form which the Specification assumed after the amendment, Claim 2, and all reference to it in the Specification, became eliminated. Moreover, the Patentee in the action before Mr. Justice Kekewich never applied for liberty to amend, or, rather, for liberty to make an application to amend.

- Under these circumstances I must deal with the Specification as it comes before me, and I find in it no reference to the suggested combination, except so far as the Drawings show it. As regards the Drawings, it is to be observed that they show equally a combination of the inclined knife guides and all the various parts of the dobby which are shown. I have already pointed out that if I were to treat the claim as a combination of all the parts shown, including the inclined knife guides and the alteration of centres, I should be compelled to yield to Mr. Terrell's argument that the proposed amendment would make the invention "substantially larger than the invention as claimed."

- I think the case is entirely different from *Kelly v. Heathman*, and, so far from finding upon the Specification any claim to the combination now asked for, I am aware that all reference to one part of it was omitted by the amendment already made. I am of opinion, therefore, that I should not be justified in allowing the amendment. I shall reverse the decision of the Chief Examiner, with 20 guineas costs to be paid by the Respondents to the Appellants.

* Reported also 7 R.P.C. 343.

Warwick Trading Company, Ltd. v. Urban.
In the Matter of the Trade Mark, No. 216,821,
and
In the Matter of the Patents, Designs and Trade Marks Acts, 1883 to 1888.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE JOYCE.

January 14th, 15th, 16th, 22nd, 25th, 26th, 1904.

WARWICK TRADING COMPANY, LD. v. URBAN.

IN THE MATTER OF TRADE MARK, NO. 216,821.

5

and

IN THE MATTER OF THE PATENTS, DESIGNS AND TRADE MARKS
 ACTS, 1883 TO 1888.

Trade Mark.—"Bioscope."—*Alleged infringement.*—*Passing-off.*—*Name of Patented Article.*—*Action dismissed.*—*Motion to expunge Trade Mark from the Register.*—*Mark struck off.*—*Invented word.*—*Patents, Designs and Trade Marks Act, 1883, section 64, sub-section 1 (d).*

The W. T. Company was incorporated in May 1898, and in August of that year registered as a Trade Mark the word "Bioscope" in connection with their business, which was that of sellers (not manufacturers) of 15 cinematographic apparatus. In September 1903, they commenced an Action against C. U., who had previously been in their service as managing director, in respect of similar apparatus bearing the name "Bioscope," and sold by him, and against a Company promoted by him. The Plaintiffs claimed relief on the grounds of infringement of their Trade Mark, and also of passing-off. At 20 the trial of the Action which came on with a Motion by the Defendants to rectify the Register, evidence was given of the use of the term "Bioscope," both with and without reference to cinematographic apparatus, for many years prior to the commencement of the Plaintiffs' business; and it further appeared that a machine bearing that name had previously been patented in 25 England.

Warwick Trading Company, Ltd. v. Urban.
In the Matter of the Trade Mark, No. 216,821,
and

In the Matter of the Patents, Designs and Trade Marks Acts, 1883 to 1888.

Held, on the Motion, that the word "Bioscope" was not an invented word within the meaning of sub-section 1 (d) of section 64 of the Patents &c. Acts, and that the Trade Mark must therefore be struck off the register with costs.

And held, in the Action: (1) That the Defendant Company had not
 5 represented its business to be the business of the Plaintiff Company; (2) that the Defendant's goods had not in fact deceived, and were not calculated to deceive the public into the belief that they were the goods sold by the Plaintiff Company, but that the Defendant's goods were sufficiently distinguished; and (3) that the word "Bioscope" did not denote the Plaintiff Company's goods
 10 exclusively, and that they had no monopoly in the word. The action was dismissed with costs.

The Warwick Trading Company, Ltd., were sellers and dealers (not manufacturers) of cinematographic apparatus and films, having been incorporated in May 1898, for the purpose of acquiring and carrying on the English branch
 15 of a business previously carried on by Maguire and Baucus, Ltd., in New York and England. Charles Urban had been employed in the American branch of the business of Maguire and Baucus, Ltd., and on the formation of Warwick Trading Company, he entered into its service. On the 2nd September, 1898, the Warwick Trading Company, applied by Charles Urban, then the manager
 20 of its business, for the registration as a Trade Mark of the word "Bioscope" in combination with a flourish or device, of which added matter there was a disclaimer when the Trade Mark was eventually registered under the No. 216,821, in Class 8, in respect of "cinematographic apparatus for projecting animated pictures on a screen." Upon the original application it was intended
 25 to make the words "C. Urban, N.Y." an essential particular of the Trade Mark, but the Comptroller refused to take the mark in that form. In the latter part of 1902, the Warwick Trading Company were desirous of opening a branch business in Paris, and for that purpose they sent Charles Urban to Paris where he started an agency, taking certain premises in his own name. It appeared that
 30 he gradually came to treat this business in Paris as his own, and in March 1903, he resigned his position as Managing Director of the Plaintiff Company, and proceeded to start a business of his own at 48 Rupert Street, Piccadilly, London, under the name of the Charles Urban Trading Company. At the trial of the action hereinafter-mentioned, evidence was given as to notepaper and a sign-
 35 board used by Charles Urban similar to those of the Warwick Trading Company, and that he had taken the word "Bioscope" as his London telegraphic address and the word "Cousinhood," which was the Company's telegraphic address, as his Paris telegraphic address.

In the month of April 1903, Charles Urban issued advertisements in the
 40 "Era" and other newspapers containing the Warwick Company's Trade Mark, the block for which he had obtained from an employé of the Plaintiff Company, and his Company put upon the market cinematographic machines bearing its name together with the plate containing the word "Bioscope." In July 1903, after bankruptcy proceedings had been instituted against him by the Warwick
 45 Trading Company in respect of moneys due from him in connection with the Paris business for funds advanced and goods supplied, he converted the Charles Urban Trading Company into a limited liability company.

In September 1903, the Warwick Trading Company commenced an Action against Charles Urban, and the Charles Urban Trading Company, Ltd., for

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(1) an injunction restraining them from infringing the Plaintiffs' Trade Mark "Bioscope," and (2) an injunction to restrain passing-off.

The Defendants did not deny infringement, but gave notice of a Motion to rectify the Register of Trade Marks by removing therefrom the Plaintiffs registered Trade Mark.

This Motion, together with a Motion by the Plaintiff Company for an interim injunction came before the Vacation Judge, when they were adjourned, and it was then, by consent, agreed that the two Motions should be heard together with witnesses, and be treated as the trial of the Action. They came on for hearing on the 15th of January 1904, before Mr. Justice JOYCE.

W. F. Hamilton, K.C., and *R. H. Hodge* (instructed by *W. R. Bennett & Co.*) appeared for the Plaintiffs; *A. J. Walter* and *G. White* (instructed by *Julius A. White*) appeared for the Defendants; *R. J. Parker* (instructed by the Solicitor to the Board of Trade) appeared for the Comptroller.

On the hearing of the Motion to rectify, the Defendants put in a number of books and documents, some of which were produced from a place open to the public, viz., the Patent Office Library. These included (a) a lantern-slide, prepared for exhibition in this country in March 1897, showing the boxing match between *Fitzsimmons* and *Corbett*, with the word "Bioscope" upon it; (b) "Dictionary of Photography," 7th edition, published in London in March 1897, with a reference to "Bioscope" under the term "Zoetrope"; (c) a copy, certified by the Foreign Office, of an entry in the French Register of Trade Marks, showing the registration of the word by one, *Demenev*, on 17th October 1895; (d) the "Revue Scientifique et Industrielle" (i. 184) for 16th September 1897, showing a picture of a "Bioscope"; (e) Woodbury's "Encyclopædic Dictionary of Photography," 1896, describing a "Bioscope"; (f) "Cosmos des Progres des Sciences," published in Paris in 1852, referring at p. 703 to a "Stereophantoscope or Bioscope"; (g) a work first published in 1812 called "The Bioscope, or Dial of Life."

Walter, for the Defendants.—The word "Bioscope" cannot be a good Trade Mark under Section 64 of the Patents, &c., Acts, 1883-1888, for it is not an invented word, and it has reference to the character or quality of the goods. The evidence that it was a known word as a name for goods of this description is clear and conclusive.

W. F. Hamilton, K.C., for the Plaintiffs.—The books relied on by the Defendants are either obscure or foreign, and many of them do not refer to any such machine as the present, [*JOYCE, J.*—They need not do so, if they contain the word. It seems to me it would be monstrous for you to have a monopoly of this word.] At any rate, the word was "invented" by us for this purpose; in Trade Mark law there is nothing like "true and first inventor"—*per Cozens-Hardy, L.J.*, in *Re Linotype Co.'s Trade Mark*, 17 R.P.C. 380; L.R. 1900, 2 Ch. 238. I have witnesses who will say that the word was not known in England before June 1897. [*JOYCE, J.*—Such evidence would not affect my mind in the face of the documents and books referred to by the Defendants, and I decline to admit the evidence you propose.]

R. J. Parker, for the Comptroller.—After the decision of the "Solio" case the kind of words which had been previously refused as descriptive were, under high advice, put on the register *de bene esse*, so as to leave the question open.

JOYCE, J.—This is an application to rectify the Register of Trade Marks by expunging therefrom the registration of a Trade Mark, No. 216,821, which is a sort of device with the word "Bioscope"; but the essential particular of the Trade Mark is the word "Bioscope," and there is a disclaimer of any right to the exclusive use of the added matter. The Company who registered that Trade Mark, in fact, claims to have a monopoly of the use of the word "Bioscope" in

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connection with cinematograph apparatus for projecting animated pictures on a screen. In order that they could be entitled to do that, their Trade Mark must come within one of the clauses of Sub-Section 1 of Section 64 of the Act of 1883 as amended by the Act of 1888. I need not trouble about Clauses (a), (b), and (c),
 5 because it is not suggested that it comes within any of those; but it is contended that the word "Bioscope" is an invented word, or that it is a word which has no reference to the character or quality of the goods. The date of the application for the registration—and, of course, the registration bears the date of the application—is the 2nd of September 1898. Upon the books and materials produced
 10 in Court before me by Mr. *Walter*, I am clearly of opinion that the word "Bioscope" was not an invented word within the meaning of the cases. It was in fact a known English word.

Then, was it a word which had no reference to the character or quality of the goods? It appears to me that the word had been used before this
 15 application in connection with apparatus, not precisely the same perhaps, but of a similar character to that in respect of which the Plaintiffs succeeded in getting it registered.

In my opinion the application to expunge this mark from the Register succeeds, with the usual consequences.

20 The hearing of the action so far as regards "passing-off" was then proceeded with, and evidence was adduced by the Defendants of other established users of the word "Bioscope," e.g., "Watson's Century Bioscope," "The Electric Bioscope"; it also appeared that at music-halls the electric switch for cinematographs was generally labelled "Bioscope"; and it was admitted at
 25 the bar by the Plaintiffs that the verb "to bioscope" was as common as the verb "to kodak."

Hamilton, K.C.—The Defendants have not sufficiently distinguished their goods from the Plaintiffs', and the conduct of the Defendant, *Charles Urban*, entitles the Plaintiffs to relief against him.

30 *Walter*, for the Defendants.—The decision as to the Trade Mark practically decides the "passing-off" case. The Plaintiffs have not proved that the word denotes only their goods. The word has been applied to *Demeny's*, a machine patented by *Gaumont* in England in 1894, in respect of which the Plaintiffs have paid royalties. The Plaintiffs only show that they alone sold the
 35 machines, to which in 1898 they gave a name which was not novel, while the cinematograph showmen use the name, whatever the machine. Nobody has been deceived, and the Defendants sufficiently distinguish their goods by adding the name of the Defendant company, while the Plaintiffs themselves now label their machine "Warwick Trading Company." The word "Bioscope" is
 40 descriptive and has no secondary meaning. *Cellular Clothing Company, Ltd., v. Maxton and Murray* (16 R.P.C. 397, L.R. 1899 App. Cas. 326); *Linoleum Manufacturing Company v. Nairn* (L.R. 7 C.D. 834); and *Wotherspoon and Co., v. Currie* (L.R. 5 H.L. 508), were referred to.

Hamilton, K.C. replied.

45 *JOYCE, J.*—The Plaintiff Company, was incorporated in the month of May 1898, and on the 22nd August in the same year they applied for and obtained registration of a Trade Mark, the particulars of which I need not describe. In order to see what it is, it is better to refer to the diagram in the Trade Marks Journal of the 26th April 1899, when this application was advertised, and from
 50 which it appears, and also from the application for the Trade Mark, that the Trade Mark was for cinematograph apparatus for projecting animated pictures on a screen, and that the essential particular of the Trade Mark was the word "Bioscope," there being the usual disclaimer of any added matter. Now

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from that time down to the time of the trial, the Plaintiff Company have used that Trade Mark "Bioscope" principally in connection with the sale—they have never manufactured—of a species, not always the same, but a species of machine, which machine (not that particular machine) is now, at all events, commonly known as a "Bioscope." In the beginning of September 1903, the Plaintiffs commenced an Action against the Defendants, the principal Defendant being the *Charles Urban Trading Company, Limited*, for relief—I am not sure whether in the circumstances under which this trial comes on, I ought to take the claim from the Writ or from the Notice of Motion, but practically there was a claim for relief in respect of alleged infringement of their Trade Mark by the Defendants in using this word "Bioscope," that this is to say, there was a claim for relief in respect of Trade Mark. There was also a claim in respect of the use, by some of the Defendants, of a telegraphic address which was objected to by the Plaintiffs. I think that has been disposed of in the course of the discussion. The Plaintiffs made out no case as regards that; and then there was a claim, in the Writ, at all events, for an account of profits. This action was met, as such actions often are met, by a motion on behalf of the *Charles Urban Trading Company, Limited*, the Defendant Company, to expunge this Trade Mark of "Bioscope" from the Register, and it was proved before me, by the production of various books and documents, as to the dates of which there is no dispute, among other things, that long before the *Warwick Trading Company* used the word in question—in fact, before that Company was incorporated and before it ever existed—the word "Bioscope" was known in France as the name given to a machine similar to that which I have mentioned as being sold by the *Warwick Trading Company*, or at all events containing its most essential feature, which appears to me to have been invented by one *Demeny*; and so early as the 17th October 1895, *Demeny* registered that name "Bioscope" in France. Previously to the registration, *Gaumont*, who appears to have been, I think, the assignee of *Demeny* of the invention, patented the invention himself in England. This was in 1893 or 1894, I am not quite sure which; and to him royalties had been paid in respect of the machines sold by the Plaintiff Company down to the present time. It is also shown to me, by American books produced here, that the word was known in America before the Plaintiff Company existed, as describing this or a similar machine, and the word is to be found in various English publications of an earlier date than the existence of the Company—publications connected with photography, which gave this word as practically the generic name of the machine. In particular, in the early half of the year, 1897, there was in London a "Bioscope Exhibition" of a fictitious representation of a well known pugilistic encounter between *Corbett* and *Fitzsimmons*. That was a "Bioscope Exhibition" beyond all doubt, and that was in London in the early part of the year 1897, and subsequently. It appears to me that the only possible justification for the registration of the word "Bioscope," as a Trade Mark—I mean by that, under Clause 64 of the Act, the only Clause under which it could possibly be registered—was as an invented word. Under the circumstances I have mentioned, I have held it not to be an invented word within the meaning of that Section, and I have therefore ordered it to be expunged from the Register.

That being so, the Plaintiffs, having failed to establish their monopoly of the use of the word "Bioscope" by virtue of the registration of it as a Trade Mark, have endeavoured to obtain the monopoly of that word by bringing a passing-off action, and by the contention that anyone, particularly the Defendants, by using the word "Bioscope" in connection with similar machines, or anything else, would be really passing off their own goods as and for the goods of the Plaintiffs. The claim has been somewhat differently formulated from time to

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time in the action. As last put, a declaration was claimed that the acts of the Defendants in impressing or affixing—and, practically, it comes to using—the word “Bioscope,” without clearly distinguishing what they sold from the machines and cameras sold by the Plaintiffs, were calculated to lead the public to believe that the goods sold by the Defendants were the goods of the Plaintiffs, and also to restrain the Defendants from issuing circulars and advertisements so expressed as to represent that the machines sold by them were the machines of the Plaintiff Company, and also from representing that the business carried on by the Defendant Company was, in fact, the business of the Plaintiff Company. Now it is practically admitted—at all events I at once decided—that there is no evidence to show that the Defendant Company has represented its business to be the business of the Plaintiffs. Therefore that was dropped. But there still remains the claim that by using the word “Bioscope” the Defendants were representing that the machines sold by them, or supplied by them, were in fact machines sold or supplied by the Plaintiffs. It is curious that as to “Bioscopes,” at all events, whatever it may be as to cameras, some time in July of 1903, the Plaintiff Company determined to mark their machines, and they directed the manufacturers of their machines that they should be marked, with the words “Warwick Bioscopes” and with their own name and address, and they did this, no doubt, to distinguish them from the machines sold by the Defendants. The Defendant Company marked their machines, “Urban Bioscopes,” with their own name and address; and if there were no evidence on the subject, judging by common sense, and in the light of nature, I should say that there was no danger whatever of one of those machines being mistaken for the other by anyone who knew anything about it, namely, by the people who buy these machines. No case of deception or mistake has been proved, or even alleged. No doubt with reference to passing-off cases, it is an established rule, that no one has a right to represent his goods as the goods of another person. Lord *Herschell's* statement of the principle will be found in the case of *Reddaway v. Banham* (13 R.P.C. 218; L.R. 1896 App. Cas. 199), which was mentioned in the course of the argument in the “Yorkshire Relish” Case, *Powell v. Birmingham Vinegar Brewery Co., Ltd.* (14 R.P.C. 720; L.R. 1897 App. Cas. 710), where the present Lord Chancellor says:—“The proposition of law is one which has been accepted by the highest judicial authority and acted upon for a great number of years. It is that of Lord Justice *Turner*, who says in *Burgess v. Burgess*: ‘No man can have any right to represent his goods as the goods of another person, but in applications of this kind it must be made out that the Defendant is selling his own goods as the goods of another.’” So far that is Lord Justice *Turner*, but the Lord Chancellor goes on, “That is the only question of law, which, as it appears to me, can arise in these cases. All the rest are questions of fact.”

The principal ground on which the Plaintiff Company alleges that the Defendant Company is passing off its goods as the goods of the Plaintiff Company is that, by reason of the use of the term “Bioscope” by the Plaintiff Company while they had this mark on the Register, they claim that the name has become so associated with their particular “Bioscopes” as to denote the “Bioscopes” sold by them, and no others. As pointed out by the Judgment of Lord *Davey* in *Cellular Clothing Company, Ltd., v. Maxton and Murray* (16 R.P.C. 397, L.R. 1899 App. Cas. 326) case, and in the earlier Judgment of Mr. Justice *Fry* in *Siebert v. Findlater* (L.R. 7 Ch. D. 801, at p. 813), under such circumstances as those of the present case, it is almost impossible to establish such a proposition as that for which the Plaintiffs contend. I have heard a great deal of evidence, and I must say, a great deal which appears to me to have very little relevance to the real question which I have to decide; but without going

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through all that evidence, it appears to me to be enough to say, that in my opinion the proposition asserted by the Plaintiff Company with reference to the restricted meaning that they contend for of the term "Bioscope," is not established, or anything like established, and, in my opinion it is contrary to the fact. In other words, I consider that the Plaintiff Company is not entitled to the sole use of the word "Bioscope," and has no monopoly of it. Further I consider—really there has been no evidence on the subject—that the "Bioscopes" sold by the Plaintiff Company and the Defendant Company respectively are at the present time sufficiently distinguished, if it be that the Defendants are bound to distinguish at all.

It is no part of my business to discuss the merits of the various disputes between the Plaintiff Company and the Defendant, *Charles Urban*. There are some matters in which the conduct of *Urban* is open to some observation. It may be that *Urban* has behaved very badly to the Company, and it may be that the Company has behaved very badly to *Urban*. I really do not know, and I do not intend to decide. Holding the view which I do, on what I consider to be the principal question in the case, it is not necessary for me to consider, what otherwise I think I should have to consider, the very awkward circumstances to my mind, at all events, of the purchases made by the Plaintiffs from the Defendants of goods marked in this very way, of which they complain; but the Plaintiffs having, in my opinion, failed altogether to make out a right to a monopoly in this word "Bioscope," I think that there is nothing in the advertisements or circulars to represent that any goods not obtained from the *Warwick Company* are the goods of that Company. In my opinion there is no probability of deception whatever, that is to say, the action so far as regards "passing-off" fails, and must fail with the usual consequences.

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IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, STIRLING, and
COZENS-HARDY.

February 1st, 2nd, 3rd, 4th, and 5th, 1904.

5 LAMBERT COMPANY v. INTERNATIONAL PHONOGRAPH INDESTRUCTIBLE
RECORD COMPANY, LD.

Patent.—Action for infringement.—Construction of Specification.—Infringement not found.—Judgment for Defendants.—Appeal by Plaintiffs dismissed.

The owners of Letters Patent for "Improvements in the process of and
10 "apparatus for reproducing phonographic records" brought an action for
infringement, in which the Defendants contended that they did not infringe, and,
alternatively, that, if the claims included what they did, then the Patent was
invalid. The first claim of the Specification was for "the process of producing
"copies of phonograph records by forcing a blank of suitable material, softening
15 "when heated, against the record surface of an indented matrix by heated
"fluid, as steam or the like, under pressure, until the blank is softened and an
"impression has been taken, and then continuing the pressure by means of a
"cooling fluid, as air, until the blank hardens and the impression is fixed, as
"herein described with reference to the drawings." The Plaintiffs alleged that
20 one of the chief features of the apparatus shown in the drawings was that it
allowed of the exit of air from between the matrix and the celluloid blank.
The Defendants' apparatus differed from that of the Plaintiffs in several
respects, including the escape of the air and the closing of the chamber from
inside instead of externally; they used in their process steam under pressure,
25 and subsequently air under pressure, but they cooled by insertion of the
apparatus into cold water. It was held at the trial (19 R.P.C. 705), that the
claims in the Plaintiffs' Specification were limited by the particular combination
therein described, and that the Defendants had not infringed. The action was
dismissed with costs. The Plaintiffs appealed.

30 The appeal was dismissed with costs.

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On the 24th of July 1900 Letters Patent (No. 13,344 of 1900) were granted to *Thomas Bennett Lambert* for an invention of "Improvements in the process of and apparatus for reproducing phonographic records."

The Complete Specification was as follows:—"The invention relates particularly to processes and apparatus by which the ordinary record now used in connection with phonographs and similar talking machines may be reproduced any number of times; and especially to the reproduction of indestructible records—all of which will more fully hereinafter appear. 5

"The principal object of the invention is to produce a simple, economical and efficient process of reproducing phonographic records. 10

"A further object of the invention is to produce a simple, economical and efficient apparatus for carrying on the process of reproducing records.

"A further object of the invention is to provide a simple, economical, efficient and comparatively indestructible record; and the invention consists in the process of, apparatus for, and the indestructible record hereinafter described and claimed. 15

"In the accompanying drawings, Fig. 1 represents a vertical sectional elevation of one style of apparatus in which the process may be carried on for reproducing the improved record; and Fig. 2 a vertical sectional elevation, taken through a longitudinal section of a record constructed in accordance with these improvements. 20

"In constructing a machine in accordance with these improvements and using the same, a matrix *a* of the desired size and strength is provided, which is preferably cylindrical in contour. The inside of the matrix, as is well known, has a spiral 'phonogram' thereon, formed electrolytically by depositing copper upon a wax cylinder upon which a record of the human voice has been made in an ordinary phonograph—all of which is well known and understood by those skilled in the art. Inside of this matrix is placed a blank record *b* preferably cylindrical in shape and which is formed of a composition of cellulose or celluloid with some other suitable material which may be formed of coarse and cheap ingredients, either a coarse kind of cellulose or celluloid, or other suitable material. This coarseness or cheapness of ingredients is indicated in the body by dotted lines, as shown particularly in Fig. 2. To give the cylinder a fine and homogeneous exterior surface adapted to receive the record impressions, it is provided with a coating, cover or veneer made of material of the requisite fineness, and which may be made of the same material as that forming the body of the cylinder, excepting that it must be of such fineness and delicacy as to meet the usual and ordinary requirements. It may, however, be made of pure celluloid or cellulose laid thereon and without any baser or coarser materials mixed therewith, and may be either integral with the body of the cylinder or in the shape of a separate envelope afterwards applied and secured thereto. In either case, however, due regard should be given to the relative co-efficiency of contraction and expansion so as to secure permanence of form and relation. 30 35 40

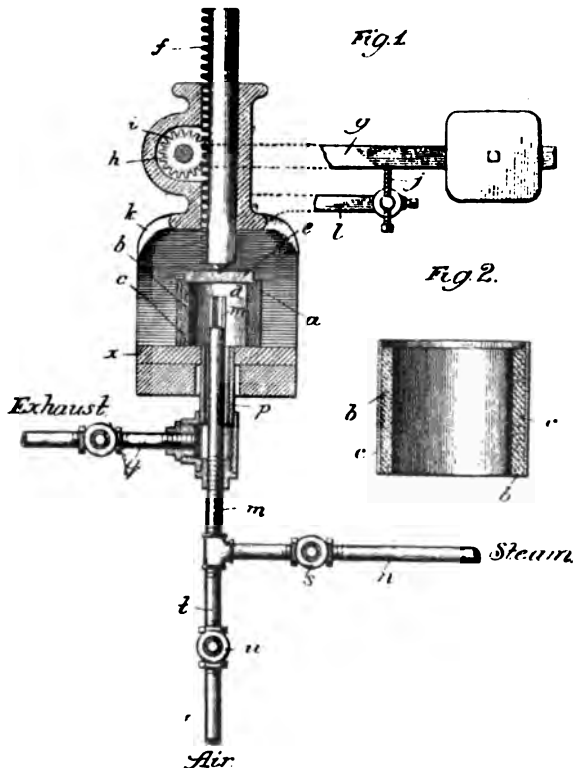
"The blank cylinder record so formed is next placed upon a base *x* of the machine, which acts as a closure for one end of the cylinder chamber formed within the record, which I will hereinafter term the 'record chamber' *d*. A head portion *e* is next provided and placed upon the blank record cylinder to complete the closure of the record chamber *d*, and a gear spindle *f* is allowed to drop thereon. A weighted lever *g* is provided and mounted on a shaft *h* that carries a pinion *i* meshing with the geared spindle above described, so that as the weighted lever operates the pinion, it, in turn, raises or lowers the spindle into or out of engagement with the head, and thus keeps the record chamber sealed for the purposes hereinafter described. A stop screw *j* is provided and secured to the main frame *k* of the machine by means of an arm *l* so as to limit the downward movement of the weighted lever, and 45 50 55

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“thereby determine the position and amount of pressure with which the geared spindle rests on the head.

- “It is now desirable to soften the cellulose record blank, so that it may be expanded out against the indented surface of the matrix. In order to accomplish this result, steam at about thirty pounds pressure to the square inch is forced into the record chamber through a pressure supply pipe *m*, which is connected by means of a branch pipe *n* with a suitable source of steam supply. The steam is confined in the record chamber at a uniform pressure, but—in order to prevent condensation—is also permitted to blow through and out of an exhaust pipe *p*, which surrounds the supply pipe, and through the branch pipe *q* thereof.

- “This steam, as above suggested, being kept at substantially uniform pressure within the record chamber, by means of its peculiar heating qualities and other actions, softens the record and forces it out against the inner indented surface of the matrix, filling every part and portion of the same and making a complete positive of it, or an exact duplicate of the original positive from which the matrix was made.



- “After this has been accomplished—and experience teaches the operator just how long it takes steam to accomplish this result—the supply of steam is shut off by means of a valve *s* and a supply of air under pressure is permitted to enter through the supply from a second branch pipe *t*, which carries a valve *u*

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"connected with a suitable source of air supply. The air under pressure is furnished* the record chamber at substantially the same pressure as that of the steam, though this may be varied to suit special circumstances and conditions, and blows out all of the steam through the exhaust pipe above described. It also acts to partially cool the record, and when this has been accomplished, the air as well as steam is shut off, the gear spindle raised, and the matrix with its reproduced record removed from the machine. The reproduced phonographic record cylinder cools very quickly and at the same time shrinks or contracts sufficiently, so that it may be readily removed from engagement with the matrix."

The Patentee claimed:—"1. The process of producing copies of phonograph records by forcing a blank of suitable material softening when heated, against the record surface of an indented matrix by heated fluid, as steam or the like, under pressure, until the blank is softened and an impression has been taken, and then continuing the pressure by means of a cooling fluid, as air, until the blank hardens and the impression is fixed, as herein described with reference to the drawings."

"2. In connection with the subject-matter of Claim 1, enclosing the cylindrical blank in an indented matrix upon a table closing one end of said blank, closing the other end hermetically by a suitable disk, and introducing steam or heated fluid under pressure through pipes *n, m*, exhausting it through pipes *p, q*, and finally introducing the cooling medium under pressure through pipes *t, m*, as herein described with reference to the drawings."

"3. In connection with the subject-matter of Claims 1 and 2, the exhaust pipe *p*, opening from the record chamber concentrically with and externally to the pipe *m* through which steam and air are introduced, as herein described with reference to the drawings."

"4. In connection with the subject-matter of Claims 1 and 2, geared spindle, pinion *i*, weighed lever *g*, and adjustable stop *j*, for operating and controlling the disk *e*, as herein described with reference to the drawings."

"5. A phonograph record having its body formed of coarse material, as celluloid, and its impression surface of similar material of finer and more homogeneous quality, in which the impression is taken from the matrix while said material is warm and plastic, as herein described with reference to the drawings."

On the 23rd of January 1903 the *Lambert Company* commenced an action against the *International Phonographic Indestructible Record Company, Ltd.*, for infringement of this and two other Patents, claiming the usual relief.

By their Statement of Claim, which was confined to the one Patent, the Plaintiffs alleged—(1) that they were the owners of the Patent; (2) that it was valid; and (3) that the Defendants had infringed.

The Particulars of Breaches alleged that the Defendants had at divers times prior to the commencement of this action, and subsequently thereto, infringed the Patent by manufacturing, selling, and using phonograph records constructed in accordance with the inventions described and claimed in the Specification of the Patent; that such phonograph records were infringements of all the claims of the said Specification; that the Defendants manufactured and in the month of January 1903 and prior to the commencement of the action sold to one *W. A. Johnson*, of Seccomb, Liverpool, a phonograph record constructed as aforesaid; that the Defendants on the 27th day of December 1902, at their registered office at 8, Cook Street, Liverpool, offered for sale to the *Edison Import House*, Karntnerstrasse 28, Vienna, Austria, phonograph records constructed as aforesaid; that the precise number, particulars, and dates of

* *Sic*, the word "to" being obviously omitted.

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the Defendants' infringements were not at present known to the Plaintiffs, but the Plaintiffs would claim to recover from the Defendants full compensation in respect of all such infringements.

The Defendants by their Defence—(1) denied infringement; and (2) alleged
5 that the Patent was invalid by reason of the matters in the Particulars of Objections appearing.

The Particulars of Objections alleged—(1) that the said *Thomas Bennett Lambert* was not the first and true inventor of the alleged invention; (2) that
10 the alleged invention was not useful; (3) that the alleged invention was not new; that the alleged invention had been published in this realm prior to the date of the Patent by the deposit in the Patent Office Library of the final Specifications of the following Letters Patent :—

Name.	No. and Date.	Parts relied on.	Claims against which alleged.
<i>Lake</i>	No. 431 of 1881 ...	The whole.	Claims 1 and 2.
<i>Howard</i>	No. 10,050 of 1888	" "	" "
15 <i>Bonne</i>	No. 15,868 of 1890	" "	" "
<i>Liorot</i>	No. 23,336 of 1893	" "	" "
<i>Young</i>	No. 1478 of 1894...	" "	" "
<i>Baux and Glaenzer</i>	No. 21,443 of 1894	" "	" "
<i>Thompson</i>	No. 6855 of 1895...	" "	" "
20 <i>Wolcott</i>	No. 15,057 of 1899	" "	" "
<i>Lambert</i>	No. 1560 of 1900...	" "	" "
<i>Lambert</i>	No. 1561 of 1900...	" "	" "

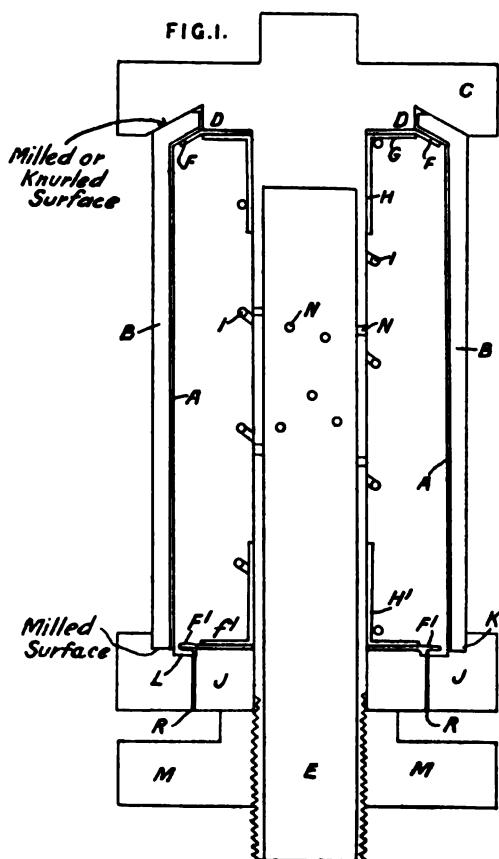
(4) that the alleged invention as claimed in the fifth claiming clause of the final Specification of the Patent formed the subject of a prior grant of Letters
25 Patent to one *Ademor Napoleon Petit* upon an application numbered 11,469 of the year 1900, by reason of which prior grant the grant of Letters Patent to the said *Thomas Bennett Lambert* was invalid and of no effect; the Defendants relied upon the whole of the Specification and claims of the said *Ademor Napoleon Petit*; (5) that the alleged invention as claimed in all the claiming
30 clauses of the final Specification of the Patent was not the subject-matter of valid Letters Patent; the Defendants would rely thereunder upon the Specifications thereinbefore referred to as part of the common general knowledge upon the subject, and would also rely upon the common general knowledge of the trade as regards the formation and removal from moulds and strengthening
35 of articles of celluloid and similar material.

The action was tried on the 23rd, 24th, 25th, and 27th July 1903, by *Buckley, J.*, who held that the claims in the Plaintiffs' Specification were limited by the particular combination therein described, and that the Defendants had not.

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infringed. The action was dismissed with costs (20 R.P.C. 709). The Plaintiffs appealed.

The alleged infringement will be found described in detail in the judgment of *Buckley, J.* (20 R.P.C. 715), but a representation is given below of a section of it, from a drawing which was prepared by the Plaintiffs for the purposes of the action. In that representation the letters indicate the following parts :—A represents the celluloid blank, B the matrix, C the head piece, D a projection on it forming the inner side of the recess, E a central tube upon which is the rubber washer F, G a brass washer having a sleeve H by which it is held at right angles to the tube E, I a spring attached to the brass washer 10 having at its other end similar fittings f^1 , H^1 ; F^1 being another rubber washer,



J a piece fitting the tube E closely and being recessed to take the square end of the matrix at K, having also a recess L for the inturned end of the blank A and a projection on J similar to D at the other end, M a piece screwed on to the end of the tube E, and N holes in the tube E. In the Defendants' apparatus several matrices charged as above were put on a branched cluster through which steam 15 was admitted at about 70 lbs., air being afterwards driven in at about 200 lbs. pressure; this was left for about half an hour, after which, without allowing the compressed air to escape, the cluster with the matrices was put into cold water.

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The points in which *Buckley, J.*, found Defendants' apparatus and process to differ from those of the Plaintiffs were as follows:—"The first point there-fore is this—that the Plaintiffs' joint is external, the Defendants' joint is internal; the operation of the Plaintiffs' process is to obtain their joint by
 5 "compression, in the first instance at any rate, whereas the Defendants get
 "theirs from first to last by tension. Then in the course of the operation the
 "Plaintiffs use an exhaust-pipe, and their process is one by which the steam is
 "perpetually circulating to a small extent, and the air to a substantial extent,
 "by being passed through the chamber. The Plaintiffs cool by driving air—
 10 "circulating air replaced from time by cooler air—through the chamber and
 "through the exhaust-pipe. The Defendants do nothing of the sort. The air
 "which they drive in under 200 lbs. pressure, of course, goes in as cold air, and
 "will cool, to a small extent, but to an extent quite immaterial for the purposes
 "which we have here to consider—they cool by the external application of cold
 15 "water after they have removed the cluster from the branch. They therefore
 "cool externally, whereas the Plaintiffs cool internally. Further, the Plaintiffs'
 "Patent will not, upon the evidence, commercially produce records made from
 "thin celluloid blanks. . . . The result is that the Plaintiffs'
 "apparatus will not make records of thin celluloid blanks; it will act with the
 20 "thick celluloid blanks in the way in which I have endeavoured to describe,
 "but it will not make the thin ones. The difference of the Defendants' appa-
 "ratus upon this point, as it seems to me, is this, that they use the milling and
 "the arrangements which I have described to ensure the exit of the air, and
 "thus arrive at a machine which, employing a thin record and having the in-
 25 "turned flange, will drive out the air by employing the milled exits which
 "they have provided for it. There is another point of difference which may be
 "material (I am not sure that it is not), and that is this. As I have said, the
 "operation of the pressure which the Plaintiffs apply has a tendency to drive
 "out, to bulge the ends of the blank, and thus to lock in the air. The Defen-
 30 "dants' apparatus is such as that that danger never arises at all, because they
 "never put their blank under pressure, they put it always in such a position
 "as that there is no tendency to drive it out at the ends. Theirs is a scheme
 "which provides for the self-sealing closing of the record chamber. They do it
 "by a double protection—by using the in-turned flange they get what would be
 35 "a self-seal without the rubber washer, and by the use of the rubber washer
 "they perfect that joint and prevent any possible accident."

T. Terrell, K.C., and *J. O. Graham* (instructed by *Riddell & Co.*) appeared for the Appellants; *Asbury, K.C.*, and *A. J. Walter* (instructed by *Sharp, Parker, Pritchards, Barham, and Lawford*, agents for *Payne, Frodsham, and*
 40 *Bewley*, of Liverpool) appeared for the Respondents.

Terrell, K.C., and *Graham*, for the Appellants, referred to the Plaintiffs' Specification, and described what the Defendants did, and continued:—"In a combination Patent all the elements may be old, or some element or elements may be new. In the Plaintiffs' invention, forming the steam chamber inde-
 45 "pendently of the matrix was new. The invention was a combination involving
 "five points—the matrix is without a joint in it; the record chamber forms a
 "complete closed receptacle by itself independently of the matrix, which gives a
 "means of exit for any air from between the matrix and the record; hot fluid
 "under pressure is used for softening the celluloid; the cooling is done under
 50 "pressure; and there is freedom to contract longitudinally. The combination was
 "new as a whole, and cannot be shown to be anticipated by picking out points
 "from several alleged anticipations. The anticipations are used to narrow the
 "invention. No celluloid record made before the date of the Patent by any
 "apparatus (except by engraving) was produced at the trial. The Plaintiffs' was
 55 "the first successful commercial method of making a celluloid record for this
 "purpose, and the Patent cannot be limited to the particular details. The

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Defendants have taken the essence of the Plaintiffs' combination. They have the closed chamber formed by the celluloid and the head and bottom pieces, they heat the celluloid under pressure, they cool it under pressure, and provide for the exit of the air at the top and bottom. The fact that the Defendants' apparatus is not precisely the same as the Plaintiffs' does not prevent it being an infringement; their apparatus and process are the same as those of the Plaintiffs in the essential points; for instance, both make the steam chamber complete without the aid of the matrix, by the celluloid and head and foot plates alone. The three essential parts of the Plaintiffs' apparatus are the head-plate, the foot-plate, and the celluloid placed in an open-ended matrix. The Defendants have all these. As regards the exit of air, the Defendants obtain the same result by substantially the same means. We admit that the advantage of providing for the exit of air is not referred to in the Specification, although the means of exit is shown in the figures; but it was not necessary for the Patentee to point it out; it was sufficient for him to show how to make and use the apparatus; and he does show how to get a good record. In the Defendants' apparatus the spring keeps the rubber rings in place, but not with so great force as to put the celluloid into tension. [The evidence was referred to, and the alleged anticipations discussed, and the judgment of *Buckley, J.*, was read. *Hill v. Evans* (4 D. F. & J. 288), was referred to on the question of anticipation.] *Asbury, K.C.*, and *Walter* for the Respondents.—As to the jointed mould, there was no invention in doing away with that. The knowledge of the state of the art at the date of the Patent was that celluloid was a suitable substance for a record; that it must be softened, and that steam or hot water could be used for that purpose; that, if steam were used, steam-tightness was, of course, essential; and that the celluloid must be cooled in such a way as not to deform it; and that it would be deformed unless it was kept under pressure during the cooling; also it was common knowledge that there might be an air film, and that to do engraving, as opposed to mere configuration, it must be expelled; and that if one got a seal at once at the top and bottom of the apparatus the air would not be expelled, but an air cushion would be formed. *Lake* had shown how to get rid of the air for his purpose, and it was obvious that for a phonograph record the exit must be put where it would not interfere with the record to be engraved. Given all this knowledge, the difference in the article makes no invention, unless some difference of principle was required in applying it to the article. It was said in the Court below that the invention was for a means of air escape and for means allowing of the contraction of the celluloid. The Specification has nothing as to the former, or as to the celluloid being longer or shorter than the matrix, or being tight or loose in it. Unless the Patentee is confined to his particular details the Patent is anticipated. There is a great difference between Claim 1 and Claim 2. Unless Claim 1 has a narrow construction given to it it is anticipated—for instance, by *Lake*. Claim 2 is a separate claim for what is now said to be the invention; for it is now said that the element of novelty was the steam chamber formed by the celluloid and the top and bottom pieces. Claim 1 must be limited to the process in the particular apparatus. It is contended that if anyone has not the alleged new part, but merely a mechanical equivalent for it, that is infringement. But where a Patent is for doing an old thing in an old way with new details, one cannot infringe unless the details are taken, which differentiate the invention from what has been done before. Here every separate feature of the invention was old. Unless details are vital, *Lake* had every feature of the invention. There are more differences between what the Plaintiffs and the Defendants do than between what the Defendants do and what *Lake* did. Where the Defendants differ from *Lake* they differ from the patented invention, and in those respects in which the patented invention differs from *Lake* there the Defendants differ from the Plaintiffs' invention. [The alleged anticipations, including in

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particular *Lake* and *Wolcott*, were referred to, and also the evidence.] The Patent is invalid by reason of prior grant, for Claim 5 is the same as *Petit*.

Terrell, K.C., replied.

- 5 VAUGHAN WILLIAMS, *L.J.*—I think that the judgment of Mr. Justice *Buckley* ought to be affirmed.

The real question which has to be decided in this case is whether the Defendants have infringed the Plaintiffs' Patent. In order to decide that question one must first ask oneself what the invention is, and what is the nature of it. Before I answer this question I prefer to point out what it is for which I am seeking when I ask it. What I am really seeking for is that I want to know whether the Plaintiffs' Patent is what I will call a simple combination Patent, a method consisting of a series of old steps well known, or whether the Plaintiffs' Patent is a Patent which really embodies such an over-riding feature producing such a result as that when one comes to deal with the question of whether there is a difference between what the Defendants do, and what is described in the Specification, one will not easily let oneself find a difference merely because the steps may not be identical. I say at once that, in my judgment, the Plaintiffs' Patent is in no sense a pioneer Patent, or a Patent in which there is a subordinate integer which could be claimed or properly referred to when dealing with the question of infringement as the pith and marrow of the invention. It is quite true that the evidence does not show that before the date of the Patent phonograph records were produced from celluloid softened by heat under pressure, cooled under pressure, carried out by making the record with the top and bottom into a closed cylinder free to move vertically, and arranged so as to provide for the expulsion of the air between the record and the matrix. Now in those words I have tried to put the description of the invention which was submitted to us by Mr. *Terrell*, and which, I think, he largely based upon the evidence of Mr. *Swinburne* at the beginning of his examination-in-chief, and I am saying that, as far as that process is concerned, I think the Plaintiffs are entitled to say that the evidence does not show that phonograph records upon celluloid were, before the date of their Patent, produced, at all events commercially. But, assuming that, it seems to me that the production of *Wolcott's* Specification of 1899, and the evidence of the experts called on either side, show that it was known, or, at all events, alleged, that you could use celluloid as the material for the reproduction of the record on the copper matrix by internal pressure of the external surface of the celluloid blank against the inner surface of the surrounding copper matrix having on its internal surface a negative copy taken by electrolysis from a wax cylinder.

I think it desirable to put this beyond a doubt, and for that purpose I will read two passages from *Wolcott's* Specification. The first of these passages says:—"This invention relates to an improvement in the manufacture of "phonogram, gramophone, or graphophone duplicates, and its object is to
45 "produce from the negative, a copy taken from a wax cylinder upon which the "record has first been produced, any number of duplicates capable of with-
"standing for a lengthened period; that it consists, mainly, in evenly pressing
"by means of a liquid or fluid medium, a cylinder" (there we have the internal pressure) "or tubing of plastic material, or of a material capable of being
50 "rendered plastic by the application of a gentle heat, embedded between said
"negative copy of the record and a circumferentially recessed metallic cylinder
"or piston, towards and against said negative copy, thus taking an exact
"impression therefrom, so that all projections on the inner surface of the latter
"forming the phonogram properly speaking, will be reproduced on the outer
55 "surface of the said plastic cylinder or tubing in reversed order, so as to form
"correspondingly shaped small impressions which are an exact duplicate of

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"the original record." That description is marvellously near the description of the process in the Plaintiffs' Specification, the effect of which, in a few words, was presented to us by Mr. Terrell, as I have pointed out at the beginning of my judgment. Now it is true that at that point in *Wolcott's* Specification there is no mention of the celluloid, but we get that if we come 5 to the third paragraph, for he says in line 34:—"The plastic cylinder or tubing 'A' preferably consisting of vulcanite, celluloid or the like is then placed in the electro." It is of great importance when one is dealing with this Specification of *Wolcott's* to see whether he deals with the question of the expulsion of air. Upon that not only is it plain, if you look at his Drawings, 10 that he does so, but the evidence of the experts—accepted by the experts, as I understand it, on both sides—is that in the process set forth in *Wolcott's* Specification the expulsion of air would take place in precisely the same way as in the Plaintiffs', although possibly it might be done rather better in *Wolcott's* Specification. I think that is to be found in Question and Answer 255, on 15 page 19 of the evidence. "(Q.) The Plaintiffs, as you said, did not mention the air expulsion, but the air expulsion would act in precisely the same way there as in the Plaintiffs'?" Now the particular answer I am taking (I prefer to take it) is Mr. *Swinburne's* answer. "(A.) Yes, it might act in even a better way, because there is no chance of bulging out under there." Under those 20 circumstances it seems to me that *Wolcott's* Specification, and the fact to which I have already called attention about its including this method of air expulsion, is sufficient to prevent the Plaintiffs from relying upon their method of air expulsion as a novelty overriding his invention.

I have now dealt with that which is one of the principal features 25 relied upon by Mr. Terrell as constituting such a novelty in the Patentee's invention as would prevent us dealing with the Patent as if it were what I have called a simple combination Patent. But this morning when Mr. Terrell was dealing with this matter he really put it in another way, although it is concerned intimately with the novelty of which I have already spoken. 30 He said that the overriding feature of the Patentee's invention is the keeping the celluloid away from the matrix during the first part of the operation; and he says that, although he is bound to admit (and it certainly is so) that you cannot find in the Patentee's Specification anything which would lead you to suppose that the inventor in framing his Specification recognised any such 35 feature as the central feature of his invention, or attempted to indicate such feature and its importance in a way which would attract the attention not only of the general public or the trade, but not even in such a way as to attract the attention of a skilled workman, or a man of science who had to try and carry out the intention as described by the Specification. But Mr. Terrell, 40 although he had to admit that, said that on the evidence it is plain that the expulsion of the air was a matter of very great importance; if you did not expel the air it would act as a cushion, which would prevent such contact between the celluloid and the matrix as is necessary to produce an accurate and useful impression, and he says that, under those circumstances, we ought not to 45 regard the fact that the Patentee has not called attention to this in his Specification, and Mr. Terrell said this is so for two reasons. First he said, "Never mind whether the Patentee recognised the importance of this himself or not; never mind whether he called attention to it in such a way as to give any information upon it to the public at all," if in fact when it is attempted 50 to apply the process described in his Specification—the actual process of manufacture for commercial purposes—it is found that the application of his invention does effect this result of expulsion of this cushion of air, that is quite sufficient, and Mr. Terrell says that on the evidence we ought to find that such fact has been proved. He goes a step further and says that, even if such fact is 55 not proved by the evidence of commercial manufacture, yet it is sufficiently

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proved by the demonstration before Mr. *Dugald Clerk*, and his admission that the Patentee's invention is efficient for the purpose of this expulsion of air, and that, in truth, the expulsion of air is produced by the fact that when you introduce the steam into the celluloid, constructed and held as described in the Specification, the pressure necessarily begins from the centre and goes towards the two ends, and then presses out the air at the two ends much in the same way as, if you had a flexible bottle, or a bladder partially full, and you put your two hands down somewhere on the middle of that flexible bottle partially filled, and pressed outwards towards the ends, you would drive, of course, the water towards the ends; in the same way it is suggested you drive the air towards the ends. Then it is said that in the earlier part of the portion of time following upon the introduction of the hot fluid into the celluloid the ends of the space between the celluloid and the matrix are left open, and continue open for a sufficient time for the expulsion of the cushion of air before the surface of the celluloid bulges and stops up the space which originally existed between the celluloid and the matrix at the time when the heated fluid under pressure was first introduced into the record chamber, as it has been called. Those are the two points that Mr. *Terrell* made. He wanted to show that a known desideratum has been arrived at, and he proposed to prove it by one of these two ways—either by the course of commercial manufacture showing that the invention did achieve this desideratum, or by showing that Mr. *Dugald Clerk*, after an experiment conducted in the course of this trial, admitted that this was the case.

With regard to the proof by the commercial manufacture and production for commercial purposes of these records, in my judgment it proves nothing of the sort. As I said to Mr. *Terrell* this morning, if he turned to the evidence of Mr. *Philpott* he would find that, although Mr. *Philpott* did say at the beginning of his examination, that thousands of records had been produced manufactured by a machine made in exact accordance with the Specification, yet when you read on a little further in his examination it is obvious that he contradicted his original assertion. According to my reading of his evidence he really did say that the production of these thousands of records was by a machine materially different from a machine made in accordance with the Plaintiffs' Specification, because he was asked this—“(Q.) You showed the apparatus to him in the factory?—(A.) Yes. (Q.) And that was turning out records in thousands, you said?—(A.) Yes.”—so that was the machine he was referring to. Then he went on—“May I make an explanation? At the time I showed it to Mr. *Cramer Roberts* we were using the thick material, but I was turning the flange on the record before printing at that time. (Q.) You were using the thick material but turning in the flanges?—(A.) Yes, with a perfectly plain top plate, with no vents in either the top plate or the bottom.” So that it is perfectly manifest that the commercial production referred to by Mr. *Philpott* was a commercial production by the use of a machine which differed, to my mind, in material points from the machine as it would have been if it had followed the Specification. That is confirmed by the evidence of Mr. *James Hough*, which if looked at really states exactly the same fact as to the date of the commercial production that the evidence of Mr. *Philpott* does, which, putting it shortly, is that the commercial production did not take place so long as the machine was in use which was in accord with the Specification. That disposes of one of the two grounds upon which Mr. *Terrell* relied as proving that experience showed that the Plaintiffs' machine, described in the Specification, in fact answered the desideratum when it was used for commercial purposes. It seems to me that that is no more proved by this evidence than it is in the case of *Wolcott*. For aught I know *Wolcott's* machine was one which if you made

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additions to it might have well been a commercial success. In neither of the two cases have we proof of any commercial success following upon the use of a machine made in accordance with that Specification.

With regard to the demonstration before Mr. *Dugald Clerk*, I am inclined to say that it is evident that Mr. *Dugald Clerk* supposed that the introduction of the heated fluid under pressure into the record chamber would really produce such results as would prevent the expulsion of the air, and I think that the reasonable view to take of that demonstration is that it showed, at all events in the case of the two thick celluloid cylinders which were then experimented upon, that that did not happen which Mr. *Dugald Clerk* anticipated would happen. It is clear that somehow or other the air was expelled, and somehow or other a satisfactory record with a clean impression was arrived at. I think that Mr. *Terrell* very properly relied upon that. Mr. Justice *Buckley* deals with this question in his judgment, and he points out (which I think some of the expert evidence rather hinted at) that the explanation of why that air was expelled was very difficult. He suggests three explanations. I do not think that one ought to say on this evidence that the proper conclusion is anything else than that in fact when this experiment was tried the air was expelled, and that it was expelled by reason of the space between the celluloid and the matrix, or, to use the words Mr. *Terrell* used this morning, expelled by keeping the celluloid away from the matrix during the first part of the operation. Let me assume that in favour of the Plaintiffs. Ought one to say that the proof of that entitles one to draw the conclusion that the Patentee's invention attains a desideratum which had not been arrived at before? So far as the mere theory is concerned of this expulsion of the air, that theory had already been indicated in *Wolcott's* Specification, and, I should say, in one or two others, but I do not propose to go into them. It is sufficient for me to refer to *Wolcott's* Specification which has been already indicated as a step in the manufacture of these phonographic records. That being so, what it is necessary for Mr. *Terrell* to do to succeed is to show that there is something in the fact of the successful experiment with these two records with the thick cylinders in the presence of Mr. *Dugald Clerk* which entitles him to say that the capacity of thus achieving the end has been demonstrated by that experiment in such a way as to entitle us to treat this feature in the Specification as a novel feature overriding the whole combination, in such a sense that although everything else in the Specification may be old, although all the steps may be old, and although the purpose at which those steps were aimed may be old, yet this one experiment, which resulted in the proof in a single instance of a feature in this process which would be efficient for the expulsion of the air, is sufficient to make us treat the Patent as really a pioneer Patent, notwithstanding the fact that the inventor does not say a single word from the beginning to the end of the letterpress of the Specification to indicate that he recognised the fact at all, or to communicate the fact to those who read the Specification. Under these circumstances the result is that, when I come to consider what this invention was, and what the nature of it was, I come to the conclusion that what I have called a simple combination Patent is not a Patent which could, in any sense, be called a pioneer Patent.

That being so, the only question is whether the Defendants' combination is the same? I do not propose to go in any detail through the differences. I think it is quite sufficient for me to say that having read Mr. Justice *Buckley's* judgment I am satisfied that the differences which he points out between the process adopted by the Defendants, and that described by the Patentee in his Specification, are not mere differences which are immaterial because they are the adoption of mechanical equivalents, or of something which does not substantially differ from the *modus operandi* of the Patentee as indicated in his

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Specification. I think that if I went through these differences I should not be able to state them as well as has been done by Mr. Justice *Buckley*. There is only one qualification which I add to it. I am not quite sure that I should say of each one of the differences, which have been relied upon by the Defendants'

- 5 Counsel in the course of the argument, that it is a sufficient difference to negative infringement; but if you take the whole of the differences it seems to me that the process adopted by the Defendants is substantially different from that which is described in the Specification. I was very much struck with one thing which Mr. *Astbury* said in the course of his argument, because I think
10 it is very material upon this point of differences. He said, speaking of *Lake's* Specification, "Where I differ from *Lake* I differ from the Plaintiffs, and in so "far as the Plaintiffs differ from *Lake* I differ from the Plaintiffs." He was then, of course, referring to the Specification. I think, therefore, that the process employed by the Defendants differs from that employed by the Plaintiffs.
15 The two combinations are substantially and materially different, and, therefore, there has been no infringement, and this appeal must be dismissed.

- STIRLING, *L.J.*—I am of the same opinion. I agree with what has been said by my Lord, and with what was said by Mr. Justice *Buckley* in the Court below. I propose to add very little, but I do wish to state that I particularly
20 agree with what Mr. Justice *Buckley* said with reference to the point which has been prominently brought before us in this Court, and urged as the reason why the decision of the learned Judge below ought to be reversed. It has been contended that this is a pioneer Patent, and it has been urged that, perhaps not the essential part, but at any rate an essential part of the invention
25 has been taken by the Defendants. Now the way in which that is made out is this. The Patent is one for the making, out of celluloid, phonographic records. The process is this. A record is taken by the phonograph on a cylinder of wax (I am stating it very shortly) and from that, by electrotype, a copper negative is taken, constituting a hollow cylinder of copper and which
30 has reproduced on the inside the record as it appears on the wax cylinder. Into that is introduced a hollow cylinder of celluloid which nearly, but, of course, not accurately, fits the copper cylinder. The Patentee's process, as he describes it consists, first, in closing the celluloid cylinder leaving the copper cylinder open; then introducing into the space, which is formed by the two closures
35 at each end of the cylinder and the celluloid cylinder itself, heated steam which softens the celluloid and drives it up against the copper matrix. I need not go further into that. The Patentee says that it is essential that the steps should be so performed that the celluloid cylinder bulges in the middle, and comes first in contact there with the matrix, and thus the air between the
40 matrix and the celluloid is gradually expelled, and no cushions of air are left which would interfere with the efficiency of the process by either preventing a portion of the record being produced at all, or, at any rate, rendering it less sharp. The mode of doing that is claimed to be an essential part of the Patentee's invention, and it is said that the Defendants have infringed, not because they
45 have taken exactly the same mode of dealing with the celluloid cylinder as the Patentee but that they have taken something which is really in the nature of an equivalent to what is done by the Patentee. To that the answer of Mr. Justice *Buckley* is, and it seems to me to be perfectly justified, that the Patentee has not described that as an essential part of his invention at all. I need not say that
50 the Patent Act imposes on the Patentee the duty, by means of his Complete Specification, of completely describing and ascertaining the nature of his invention, and when you look and examine his Complete Specification there is not a single word in the letterpress of the Specification which is directed to this essential feature at all. It is true that when you look at the Drawing which
55 accompanies it you do discover that in the apparatus which he uses the hollow celluloid cylinder is closed while the copper cylinder which surrounds it is left

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open, and by that means it is probable, upon the evidence, that the steam which is introduced inside the celluloid cylinder does act in the way that is suggested. That is not even completely made out on the evidence to my mind, but still the balance and probability of the evidence does appear to be in favour of that being the *modus operandi*. Then what has he done? He has indicated an arrangement which operates in a way that is said to be an essential feature of the invention. Still there remains this objection, that he does not seem to me to have described that as part of the invention which he claims. That is the conclusion which Mr. Justice *Buckley* arrived at, and with that I completely agree. I do not think it is necessary, after what my Lord and the learned Judge have said, to travel over the whole field which has been discussed in the argument before us. I agree that the appeal ought to be dismissed. 5 10

COZENS-HARDY, *L.J.*.—I am of the same opinion, and I so entirely agree with what was said by Mr. Justice *Buckley*, and with what has been said by my Lord and Lord Justice *STIRLING*, that I do not think I should be justified in taking up more than a few minutes of the time of the Court. Every Patentee regards his own invention as a master Patent, or a pioneer Patent, and seeks to induce the Court to approach the consideration of all questions of construction and of infringement on that footing. I shrink from applying that principle to the present case. Mr. *Walter* in his argument yesterday satisfied me that so far from this being a master Patent, or a pioneer Patent, it is really a very narrow Patent. It is neither more nor less than a combination Patent, and, that being so, for the reasons which have been elaborated by Mr. Justice *Buckley*, and by my Lord and Lord Justice *STIRLING*, I think it is reasonably clear that there has been no infringement of the Patent by that which has been done by the Defendants. It is not necessary, in the view which I take, to consider the point which was made with reference to the prior grant to *Petit*. I only desire to say that, as at present advised, I am not satisfied that this objection would prevail. 15 20 25

The appeal was dismissed with costs.

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In the Matter of the Trade Marks Nos. 15,920 and 238,790 of the Anglo-Swiss
Condensed Milk Company.*

IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, STIRLING, and COZENS-HARDY.

February 9th and 10th, 1904.

5 ANGLO-SWISS CONDENSED MILK COMPANY v. PEARKS, GUNSTON,
AND TEE, LD.

IN THE MATTER OF THE TRADE MARKS NOS. 15,920 AND 238,790 OF THE
ANGLO-SWISS CONDENSED MILK COMPANY.

10 *Action for infringement of Trade Marks and for passing off.—Motion to
rectify by exclusion of certain goods.—No intention to use Trade Mark for such
goods.—Mark common to the Trade.—Action dismissed.—Order for rectification
of Register.*

15 *In 1878 a Company registered a Trade Mark, consisting of a figure of a
milkmaid with the words "Milkmaid Brand," in Class 42, for substances
used as food or ingredients in food, with the exception of certain goods, not
including butter in such exceptions. In 1901 the same Company registered
another Trade Mark consisting of a slightly different figure of a milkmaid
with the same words for the whole of Class 42. The Company had also other
Trade Marks with the figure of a milkmaid in them, but not for butter. Their
principal trade was in condensed milk, and they never traded in butter in the
20 United Kingdom until May 1901, although they had formed the intention of so
trading in 1897, and had traded abroad in butter. In 1902 they commenced an
action against another Company for infringement of, in particular, the Trade
Marks of 1878 and 1901, and for passing off, and in it complained of the use by
the Defendants of coloured posters and handbills having thereon the figure of a
25 milkmaid with the Defendants' trade name prominently thereon and the words
"Milk Blended Butter"; these posters and handbills were first used in November
1901. The Plaintiffs alleged that they had a reputation in various articles of
dairy produce under the brand of a milkmaid, and that the posters were
calculated to lead persons to believe that the butter to which they referred was*

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the Plaintiffs' butter. The Plaintiffs had only a small retail trade in butter, and used only the 1901 Trade Mark, and not that of 1878, in connection with such trade. The Defendants had a very large retail trade in their milk blended butter. They denied infringement and passing off, and moved to exclude butter from the goods for which the Trade Marks were registered on the grounds that the Plaintiffs had never used or intended to use the 1878 Trade Mark for butter, and that in 1901 a milkmaid was common to the trade. The action and motion were heard together. Held, by Joyce, J., that the action failed as to passing off, and that the Register must be rectified so as to exclude butter from the goods for which the Trade Marks were registered, on the ground, as to the 1878 Trade Mark, that there had been no real intention to use it for butter, and, as to the 1901 Trade Mark, that at the date of its registration the device of a milkmaid was common to the butter trade. The action was dismissed, and an Order made for rectification in the manner mentioned. The Plaintiffs appealed.

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Held, by the Court of Appeal (affirming Joyce, J.), that the action failed as to passing off, and that the Register must be rectified so as to exclude butter from the class of goods for which the Trade Marks were registered, on the ground, as to the 1878 Trade Mark, that there had been no real intention to use it for butter, and, as to the 1901 Trade Mark, that at the date of its registration the device of a milkmaid was in common use in the trade as an ornamentation and indication of goods sold, and also as a Trade Mark for butter. The action was dismissed, and an Order made for consequential rectification of the Register.

On the 17th of December 1878 Charles Terry Sparks, manager in England of the Anglo-Swiss Condensed Milk Company (hereinafter referred to as the Swiss Company), applied on their behalf for the registration of a Trade Mark, which is shown below, in Class 42, for substances used as food or as ingredients

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in food, except condensed milks, coffee and milk, chocolate and milk, and essence of coffee. No user before the 13th of August 1875 was claimed. This mark was registered under No. 15,920. On the 12th of June 1901 the Swiss

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Company applied for the registration of another Trade Mark, which is shown below, in Class 42, for substances used as food or as ingredients in food. This mark was registered under No. 238,790. On the 16th of June 1902 the *Swiss*

MILKMAID
BRAND.



Company commenced an action against *Pearks, Gunston and Tee, Ltd.*, claiming
5 an injunction to restrain infringement of the above-mentioned Trade Marks
and of three others, or any of them, and from selling, offering for sale, or
passing off, or enabling others to sell or pass off, goods not of the Plaintiffs'
manufacture or merchandise as or for the Plaintiffs' goods by the use of the
representation of a milkmaid, or any device only colourably differing from the
10 Plaintiffs' said Trade Marks, or by the use of any device enabling the
Defendants' goods to be described or called "Milkmaid Brand," and for other
relief.

The short particulars of the three other Trade Marks mentioned in the writ,
but of which infringement was not alleged at the trial (not being registered for
15 butter) are as follows:—(1) No. 8831, registered on the 26th of August 1876 as
an old mark, consisting only of the representation of a milkmaid contained in
Trade Mark No. 15,920, and registered for condensed milks, coffee and milk,
chocolate and milk, and essence of coffee; (2) No. 189,720, registered on the
9th of September 1895 for the same goods as No. 8831, and being the same as
20 Trade Mark No. 238,790; (3) No. 189,891, registered on the 18th of September
1895, and being the same as, and for the same goods as, the last mentioned
mark, except that the words "Milkmaid Brand" were omitted.

The Plaintiffs, by their Statement of Claim, alleged (1) they were a
Company incorporated under the laws of Switzerland, and carried on an old
25 established business as manufacturers and vendors of condensed milk and
milk products, with factories in Switzerland, England, Bavaria, and Norway,
and offices at 10, Mark Lane, in the city of London, and also in Switzerland,
and that their business was believed to be the largest of the kind in the world;
and that for many years past an important branch of the Plaintiffs' business had
30 consisted in the manufacture and sale of butter; (2) that for 35 years past, or
thereabouts, the Plaintiffs had used as the distinguishing mark of their goods a
Trade Mark representing a figure of a milkmaid, the same being in many cases
accompanied by the words "Milkmaid," or "Milkmaid Brand," and they had
also frequently used the words "Milkmaid" or "Milkmaid Brand," without
35 the figure; that in the case of butter the said device was stamped upon the
butter itself, and was also used upon wrappers, show-cards, and in other ways;

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(3) that the Plaintiffs were the proprietors of the aforesaid five Trade Marks; (4) that during many years the Plaintiffs had expended very large sums of money in advertising their said goods under the name of "Milkmaid" or "Milkmaid Brand," and usually in connection with their said device, in the United Kingdom and in various foreign countries, and by reason of the distinctiveness of the Plaintiffs' said name and brand, and of the inherent merits of their goods and of such expenditure as aforesaid, the Plaintiffs' said goods were thoroughly well known in the United Kingdom and in most parts of the world under the name "Milkmaid" or "Milkmaid Brand," and in conjunction with the representation of a milkmaid; that the said name and device were exclusively applied to the Plaintiffs' goods, and were associated and identified with them, and that anyone who asked for or ordered any such goods under either of the names aforesaid, or under the device aforesaid, intended and expected to receive the Plaintiffs' goods and no other; (5) that the Defendants were a limited Company carrying on business at 6, Bayer Street, Golden Lane, in the city of London, and elsewhere, as dealers in goods similar to those manufactured and sold by the Plaintiffs; that the Defendants began, for the first time a few months ago, to use a representation of a milkmaid in advertisements relating to their butter, and they had very recently begun to use the said device in the shops in which their butter was sold and in connection with the sale of their butter, so as to represent that the same was "Milkmaid Butter," or in other words the Plaintiffs' butter; that the Defendants were, moreover, taking advantage of such device to supply their own butter in response to the orders for "Milkmaid Butter," or in other words for the Plaintiffs' butter; (6) that the Defendants were, in manner aforesaid, representing that their butter was "Milkmaid Butter," and they were causing the same to be bought and sold by the same name by which the Plaintiffs' butter and other milk products were bought and sold, and they had, by such means as aforesaid, been making profits which ought to belong to the Plaintiffs, and causing damage and injury to the Plaintiffs, and that unless they were restrained the public would be deceived and the Plaintiffs further injured.

The Defendants by their Defence alleged—(1) that they had not infringed the said Trade Marks or any of them; (2) that the Defendants had not passed off or attempted to pass off any butter of their manufacture or merchandise as the butter of the Plaintiffs; (3) that the Defendants, who sold butter of their manufacture and merchandise under the name "Milk Blended Butter," had for the purposes of advertisement and shop display used pictures in which there was a figure of a milkmaid with the words "*Pearks'* Milk Blended Butter," clearly printed thereon; that the use of pictures, statuettes, and drawings of or containing a milkmaid was common to the trade, and the use of the said advertisements and pictures did not, and had not, and could not, pass off any butter of the Defendants as and for the butter of the Plaintiffs, and did not lead, and had not led, to the description of the Defendants' butter as "Milkmaid Butter." As instances of such common general user of the figure and device of a milkmaid in the trade in connection with dairy produce, the Defendants would refer to figures, posters, and handbills in use by, amongst others, the proprietors of *Nestle's* Swiss Milk and their customers throughout the trade, the *Danish Dairy Company* at their branches throughout the realm, the *Dairy Supply Company* and their customers throughout the trade, *Coopman and Young*, of John Street, London, and their customers throughout the trade; (4) that the Plaintiffs had not as an important or any branch of their business in this realm any business as manufacturers or sellers of butter; that the Plaintiffs had no reputation in this realm for butter of their manufacture or merchandise under the title or description of "Milkmaid Butter," or at all, and that the title "Milkmaid Butter" was entirely unknown in this realm, and no butter

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was sold by the Plaintiffs upon which, or the wrappers of which, or the show-cards of which the mark of a milkmaid or the words "Milkmaid" or "Milkmaid Brand" were used; (5) that the Defendants had not supplied and did not supply in answer to orders for "Milkmaid Butter" butter of their manufacture or merchandise; if any orders were given for "Milkmaid Butter," which was not admitted, such orders did not mean and would not be understood to mean butter of the Plaintiffs' manufacture or merchandise; (6) that the Defendants admitted that the Plaintiffs had a large business in condensed milk mixed with coffee, cocoa, and chocolate, and that in respect of such goods the Plaintiffs had a reputation in connection with the words "Milkmaid" and "Milkmaid Brand"; save in respect of such goods, the Defendants denied that the Plaintiffs had any reputation in connection with the said word or words; (7) that if the Plaintiffs had any reputation in connection with the sale of butters of their manufacture or merchandise in connection with the device of a milkmaid or the words "Milkmaid" or "Milkmaid Brand," which was wholly denied, they were not entitled to restrain the Defendants from the acts therein-before admitted by reason that the Plaintiffs had for a long period been acquainted with the conduct of the Defendants now complained of and the common general use of the device of a milkmaid by the trade, and had acquiesced therein, and had by their laches lost their rights, if any, to restrain the Defendants from the continuance of the said acts; (8) save as therein admitted the Defendants denied each and every of the allegations in the Statement of Claim as if the same were specifically denied.

Pursuant to an Order of the Court of the 8th of December 1902 the Defendants gave further and better Particulars of paragraphs 3 and 7 of the Defence which alleged the use by *Henry Nestle* of a picture or drawing A of a milkmaid during the years 1891 to 1902 for condensed milk, by the *Danish Dairy Company* of pictures or drawings B, B¹ and B² of a milkmaid during the years 1900 to 1902 for butter, by *Coopman and Young* of a picture or drawing C of a milkmaid during the years 1893 to 1902 for margarine mixture, by the *Dairy Supply Company* of a picture and drawing D, D¹ shown in their catalogue of a milkmaid statuette for dairy produce shown in the 1900-1901 catalogue, but the Defendants had no knowledge how long the same had been in use, by the *Welsh Dairy*, Birmingham, of the picture E of a milkmaid for dairy produce displayed on a mirror forming the side of the passage entrance to the dairy shop, displayed during the year 1902, the Defendants having no knowledge for how long before it had been used, by the *Maypole Dairy Company* of pictures or posters of a milkmaid F for dairy produce used with trifling variations during the years 1891 to 1902. The Particulars further alleged as to figures, posters, and handbills, the use by *Henry Nestle* of posters G during the years 1891 to 1902, by the *Danish Dairy Company* of handbills B, B¹ and B² during the years 1900 to 1902, by the *Dairy Supply Company* of a figure D shown in the current catalogue for 1900 to 1902, by *Coopman and Young* of a figure C used from 1893 to the time of the Particulars. Particulars were also given as to acquiescence and laches. Further particulars of common use were subsequently delivered.

On the 3rd of February 1903 the Defendants gave notice of motion for an Order to rectify the Register of Trade Marks by removing therefrom the Trade Marks Nos. 15,920 and 238,790, or alternatively by inserting therein a disclaiming note limiting the claim in respect of such marks to substances other than butter. The following particulars of the grounds for rectification were delivered:—
 (1) Both the said marks are registered for substances used as food or as ingredients in food. Such substances include milk, butter, cream, and dairy produce generally. Both the said marks are common marks in general use in the dairy trade in connection with butter, cream, milk, and dairy produce

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"generally. The Applicants intend to allege particularly that figures, handbills, " and posters, in which there are pictures, statuettes, and drawings of a milkmaid, " are in use by the proprietors of—(a) *Nestle's Swiss Milk* and their customers ; " (b) the *Danish Dairy Company*. at their branches throughout the realm ; (c) " the *Dairy Supply Company* and their customers throughout the trade ; (d) 5 " *Coopman and Young*, of John Street, London, and their customers throughout " the trade. (2) The Applicants intend to allege further that the Respondents " have not used their said marks or either of the same upon butter, milk, cream, " or dairy produce generally, and to ask for an Order for the rectification of the " Register relating to both the said marks in accordance with the facts alleged 10 " in paragraphs 1 and 2 hereof." [The Particulars delivered in the action were also referred to.]

A representation of the Defendants' poster complained of by the Plaintiffs will be found on the opposite page. In the poster as used the ground was blue. The milkmaid's gown was pink. The stool and pail were coloured brown. The 15 words "Pearks" and "Butter" were in yellow and "Milk Blended" in white. It was stated that a well-known lady had given a sitting for the original picture, which was produced at the trial. The use made by the Defendants of the poster was to hang it framed in their shops above the butter on the counter ; below the poster and above the butter there was usually hung a notice 20 descriptive of the way in which the Defendants' butter was made. There was also a smaller poster or handbill similar to the one above described except in respect of size, but it was stated that the issue of these was in 1901 and that they had been used up. The Plaintiffs also put in evidence an advertisement by the Defendants in the "Brighton and Hove Times." 25

It appeared from the evidence that the Plaintiffs' reputation was principally in connection with condensed milk, and their "Milkmaid" Trade Marks and "Milkmaid Brand" were very extensively known in connection with that trade, but that, although they had traded abroad in butter, they first formed the intention of trading in butter in the United Kingdom about 1897, and they 30 actually commenced to trade in it in May 1901, on the completion of their factory at Kensal Road, but such trade was retail and principally in that locality and was of comparatively small amount ; the Plaintiffs had not used their Trade Mark No. 15,920 in connection with butter, but had so used their Trade Mark No. 238,790 on wrappers, bill-heads, and other documents, the 35 butter itself having the figure of the milkmaid stamped on it, but without the words "Milkmaid Brand." The Plaintiffs called evidence to show a close connection between the milk and butter trades. It was shown that the Defendants had 200 shops in this country, and their annual sale of butter was about 400,000*l.* a year ; their "Milk-Blended Butter" was butter im- 40 ported from the colonies in a refrigerated state and afterwards re-churned with milk.

The following witnesses gave evidence for the Plaintiffs at the trial :—*W. T. Bilson*, their manager ; *A. E. McKay*, of *Parkins and Gottle's*, who proved an order from the Plaintiffs for wrappers for butter on the 12th of June 1901, 45 and the dispatch of such wrappers on the 28th of that month to 222 Kensal Road, the Plaintiffs' butter factory ; *E. Dowsett*, buyer for the *Star Tea Company, Ltd.* ; *F. Hills*, manager of the Plaintiffs' factory at Kensal Road ; *E. Gadd*, grocer and provision dealer at Stoke Newington ; *H. J. Stokes*, grocer and provision dealer at Wandsworth ; *A. S. Kinder*, grocer and provision 50 merchant at Lewisham, and a director of *Trickett's, Ltd.* ; *William Dunlop*, a retired captain of the merchant service, who had purchased the Plaintiffs' butter packed in wrappers with a milkmaid on the wrapper, and spoke generally as to the reputation of the Plaintiffs' goods and marks ; *H. Evans*, manager of the *International Tea Company's Stores* ; *R. J. White*, grocer and provision 55

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dealer at Battersea, who stated that he had asked for "Milkmaid Butter" at one of the Defendants' shops and been given the Defendants' "Milk-Blended Butter," that the Defendants' poster was hanging over the butter, and, in cross-examination, that he saw one of their notices hanging up in the shop, and
5 that the butter had a wrapper on it with words as follows :—"Choicest butter



"blended with pure English full-cream milk, whereby the percentage of water
"in the butter is increased to about 24 per cent., but this limit of percentage is
"not guaranteed. Pearks' butter, milk blended," with a statement as to weight ;
C. Watson, assistant editor of the "Syren" newspaper ; J. A. Lovelock, a clerk
10 in the Plaintiffs' employ, who stated that he was served with the Defendants'

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butter at one of their shops in response to an order for "Milkmaid Butter"; *F. A. S. Gwatkin*, articled clerk to the Plaintiffs' solicitors, who asked for "Milkmaid Butter" at one of the Defendants' shops, and was asked by the shopman whether he wanted milk-blended butter, and he then pointed to the butter and said that he wanted that butter, and he received the Defendants' butter; that he afterwards went to another of the Defendants' shops and asked for "Milkmaid Butter" and received the Defendants'; in cross-examination he said that he knew that the Defendants generally had the notice R. J. W. 2, commencing, "all butter sold at this establishment is 'Pearks' Blended Butter,'" and describing the process, in their shops.

The following witnesses gave evidence on behalf of the Defendants:—
J. Causfield, managing director of the Defendant Company, who stated that the Defendants had a poster for tea which had been very successful, and they decided to have a companion one for butter, and they got the same people to submit a design, who were only told that it was to have some connection with butter, that the notice R. J. W. 1 was hanging in the window of all the Defendants' shops, and the notice R. J. W. 2 under the poster in every shop; *W. R. Young*, of *Coopman and Young*, provision merchants, who spoke as to the use of a dairymaid for about 26 years on margarine; *A. Lovell*, an assistant in the employ of *Lovell and Christmas, Ltd.*, wholesale provision merchants; *G. Raff*, manager of the *South Down Creameries*, Wimbledon, who said that a milkmaid, without or with a cow, had been a common form of ornamental advertisement in connection with dairies, and produced a specimen of a bag in which they had sold butter for 16 years, the bag having a milkmaid and a cow on it, and produced also a stamp having a milkmaid on it, which they had used for the same period; *R. M. F. Robertson*, director of *Dobson, Molle & Co., Ltd.*, general printers, *J. S. Latham*, manager of the dairy department of the *Dairy Supply Company*, who stated that they had sold stamps for butter with a dairymaid on them for 16 years; *G. Palmer*, manager of the *Belgravia Dairy Company, Ltd.*, who stated that they had sold pats of butter stamped with a milkmaid since 1888, and spoke of other uses of a milkmaid by his Company, in particular on a billhead used in connection with butter; *A. H. Branburn*, manager of the *Dairy Outfit Company, Ltd.*, who stated that since 1894 they had sold china figures of a milkmaid to dairy shops, the sale amounting to hundreds, and that since 1894 a milkmaid had been a common device on billheads and bags in connection with butters, eggs, and so forth, and that they sold stamps also with the figure of a milkmaid on them for eight years; *A. C. Mills*, of *Mills and Sparrow*, provision merchants, who stated that his firm had received butter from New Zealand in boxes marked "Milkmaid Brand" for 10 or 12 years. [*Hughes, K.C.*, stated that the people in New Zealand had given an undertaking to discontinue this, and subsequently put in a letter to this effect.] *R. Waterhouse*, secretary to the *Willows Refrigerating Company*, who ornamented, tiled, and fitted up dairies, and said that the figure of a milkmaid was a popular ornament; *C. A. Jung*, colour printers' agent, who ordered the preparation of the poster, receiving instructions about the end of June 1901; *A. W. Branson*, manager of one of the Defendants' shops, being the first one to which *F. A. S. Gwatkin* went; *A. Smart*, trade valuer and expert; *C. H. Edwards*, who was employed by the Defendants at the shop to which the witness *Lovelock* went, and who said that he stated it was "Milk-Blended Butter"; *A. Frost*, managing director of the *Dairy Outfit Company*.

Mr. Justice *Joyce* held that the action failed as to passing off, and that the Register must be rectified so as to exclude butter from the goods for which the Trade Marks were registered, on the ground, as to the 1878 Trade Mark, that there had been no real intention to use it for butter, and as to the 1901 Trade Mark, that at the date of its registration the device of a milkmaid was

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common to the butter trade. The action was dismissed, and an Order made for rectification in the manner mentioned.*

The appeal came on for hearing on the 9th of February.

Neville, K.C., Hughes, K.C., and L. B. Sebastian (instructed by *McKenna & Co.*) appeared for the Appellants; *Bousfield, K.C., A. J. Walter, and W. Frampton* (instructed by *W. B. Styer*) appeared for the Respondents; *R. J. Parker* (instructed by the *Solicitor to the Board of Trade*) appeared for the Comptroller-General.

Neville, K.C., and Sebastian for the Appellants.—The Appellants have a considerable reputation under the mark and name “Milkmaid.” At the date of the registration of the mark (1878) they had a trade in Switzerland in milk and butter. They immediately commenced to trade in milk in England, and subsequently commenced to trade here in butter. The Respondents do not dispute that the Appellants have a reputation under the name “Milkmaid,” but they say it does not extend to butter. *Joyce, J.*, on the authority of the cases cited to him, decided that the registration must be limited by the exclusion of butter. But the cases do not lay down any principle affecting the right of the Appellants to the use of their Trade Mark in connection with butter. *Edwards v. Dennis* (L.R. 30 C.D. 454) turned upon the totally different nature of the articles sold. If a man registers a mark for articles usually included in a particular trade—*e.g.*, a dairyman’s trade—he may subsequently extend the protection of his mark to an article of a nature coming within the trade if no one has in the meantime begun to use the mark for that article. In *Batt’s Trade Mark* (16 R.P.C. 411; L.R. 1898 2 Ch. 43; and 1899 App. Cas. 428) the registration was not *bonâ fide*, and there was no intention to use the mark for the purpose of trade. The question is whether in this case the original registration was *bonâ fide*. The articles here are generally dealt in by the same persons. The object of registering for a class is that, if the mark is registered in respect of a particular business, the owner shall be entitled to use it with regard to any article fairly coming within the four corners of his business. The Trade Mark Registration Acts are intended to benefit traders, and the more reasonable view is, as stated in the Act of 1875, that the registration should be in connection with the business, but that you may register in respect of a whole class. A *bonâ fide* registration in respect of a particular trade will protect articles which legitimately come within the scope of that trade. If this interpretation were not to be put on the Statutes traders would be embarrassed, for they would have to register a new mark for each article within the scope of the business not sold at the date of the original registration. [The evidence was referred to.] The milk and butter trades are kindred trades. The inference the Court is entitled to draw from the evidence is that the public, who have known for many years of the Appellants’ brand “Milkmaid” in connection with condensed milk, would connect butter sold under that brand with the Appellants’ goods (*Eastman Photographic Materials Company, Ltd. v. Griffiths’ Cycle Corporation, Ltd.*, 15 R.P.C. 105). The 1901 mark is identical with that registered in 1878. The regulations in regard to foreign registration made it necessary to have one registration for the whole class instead of two. In 1886 the Appellants took proceedings against one *Metcalf* in respect to the use of the word “Dairymaid” as a Trade Mark. In the result *Metcalf’s* user was limited (*Anglo-Swiss Condensed Milk Company v. Metcalf*, 3 R.P.C. 28; L.R. 31 C.D. 454). [COZENS-HARDY, L.J.—That case is very strongly against you.] *Metcalf’s* registration did not extend to butter. [VAUGHAN WILLIAMS, L.J.—But *Metcalf* was limited to “butterine and other

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"fatty substances." The Company's registration was in respect of dairy products, and butterine and fatty substances were not within it. In order to make the registration of 1901 irregular and improper, so as to cause it to be expunged on the Respondents' application, it must be shown that there was before registration a real user by someone else of the design of a milkmaid as a Trade Mark. 5 This has not been shown (*Verity's Trade Mark*, 19 R.P.C. 58). The Appellants are entitled to succeed.

Counsel for the Respondents were not called upon.

VAUGHAN WILLIAMS, *L.J.*—We think that the judgment of Mr. Justice *Joyce* ought to be affirmed. 10

I will first say one word as to the passing off action. I entirely agree with Mr. Justice *Joyce* that there is no shadow of foundation for it. I have nothing more to say about that.

With regard to the Trade Mark matter, the evidence that in 1878, the date of the registration, those registering had no intention whatever to 15 manufacture, or deal in butter, or anything else than condensed milk, coffee and milk, cocoa and milk, chocolate and milk, and essence of coffee in this country, is very strong indeed. At all events, they had no intention to deal in butter. I draw this conclusion from the fact that, for 23 years after the date of this registration, there is no evidence whatsoever that the 20 *Anglo-Swiss Condensed Milk Company* manufactured or dealt in butter in this country. But that is not the only ground upon which one can draw this inference, for the case which was cited of the *Anglo-Swiss Condensed Milk Company v. Metcalf* before Mr. Justice *Kay* in 1886, if carefully considered, 25 shows to my mind conclusively that at that date the *Anglo-Swiss Condensed Milk Company* so little intended to apply their Trade Mark to butter, that they were perfectly content that the Defendants in that case should use a dairy-maid Trade Mark in respect of butterine and other fatty substances used as food, a course which they really could not have adopted if they at that time had any notion of applying their Trade Mark to butter. 30

That being so, the only other thing that has to be dealt with is the Trade Mark which was registered on the 12th of June 1901. With regard to that, no doubt it is a registration which is of a date subsequent to the time when the *Anglo-Swiss Company* began to deal in butter, and manufacture butter, at Kensal Road. The question now is whether at that date they ought to have been 35 allowed to get that Trade Mark registered in respect of butter. I need not trouble myself as to the other substances within the class other than the milk products or the milk combinations. Mr. Justice *Joyce* has arrived at the conclusion that the mark of a dairymaid, or a milkmaid, was in common use in the trade at the date of this registration. I can have no doubt that the 40 evidence amply shows that; and in my judgment the evidence shows, not only that the milkmaid or dairymaid mark—I make no distinction between the two—was in use in the trade prior to June 1901, but it also shows that it was in use in two ways. It might be that in some cases you could say that the use was rather for ornamentation, or for indication of the nature of the goods dealt with 45 in the shop than as a Trade Mark; but, as I say, the evidence shows that there was a use in two ways. To my mind it conclusively shows also that it was used as a Trade Mark—I do not mean as a registered Trade Mark, but as a Trade Mark. Under these circumstances, in my judgment, the registration of "Milkmaid" as a Trade Mark ought not to be allowed. I need not go into the 50 cases which were cited by Mr. Justice *Joyce*; it is sufficient to say that I agree with his conclusion in fact and his conclusion in law upon that part of the case, and I think that the appeal ought to be dismissed.

STIRLING, *L.J.*—I am entirely of the same opinion, and I have nothing to add in substance to what has been said both by Mr. Justice *Joyce* and by my 55

Anglo-Swiss Condensed Milk Company v. Pearks, Gunston, and Tee, Ltd.
In the Matter of the Trade Marks Nos. 15,920 and 238,790 of the Anglo-Swiss
Condensed Milk Company.

- Lord. I should only like to make this remark with regard to the question which has been principally urged upon us in the course of the argument, namely, as to the validity of the registration in 1878 of this Trade Mark. The question which we have to consider is that which was stated by Lord Lindley, then Master of the Rolls, in *Re Batt's Trade Mark*, in this form: "Can a man properly register a Trade Mark for goods in which he does not deal, or intend to deal—meaning by 'intending to deal' having at the time of registration some definite and present intention to deal in certain goods, or descriptions of goods, and not a mere general intention of extending his business at some future time to anything which he may think desirable"? That question he answered in the negative, and that is the question which has to be answered in the present case with reference to the materials before us. Now we have it that as far back as 1876 the Plaintiff Company, being then manufacturers of condensed milk and also of butter in Switzerland—for they are a Swiss Company—registered in England a Trade Mark in Class 42 in respect of certain specified articles, namely, condensed milk, coffee and milk, cocoa and milk, chocolate and milk, and essence of coffee. That being the case, they proceeded in 1878 to register the same mark with a slight addition, namely, the words "Milkmaid Brand" in Class 42, except in respect of the substances for which the main portion of the Trade Mark had been already registered. Now Class 42 is an extremely wide class of "substances used as food, or ingredients in food," and there are a large number of examples which the learned Judge referred to. That being the state of things, what happened as regards butter, as to which the question arises? They did not make any use in England of the Trade Mark as regards butter until 1901. It seems to me that this is a very good example of the difference which is referred to by Lord Lindley, namely, a case of a mere general intention to extend the business at some future time to anything within Class 42 which the Company might think reasonable, and not what he calls a definite and present intention of dealing in butter. I entirely agree that the appeals ought to be dismissed.

COZENS-HARDY, *L.J.*—I am of the same opinion. I so entirely agree with what fell from Mr. Justice Joyce in his judgment, and what has been said by my Lord and Lord Justice STIRLING, that I think it would only be a waste of time to add anything.

- 35 VAUGHAN WILLIAMS, *L.J.*—I desire to say, because I am not quite sure I made it clear, that in the observations I made about the Trade Mark being in common use before 1901, of course I was speaking of butter, and not of milk.

Saccharin Corporation, Ltd. v. Hopkinson.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BYRNE.

February 20th, 1904.

SACCHARIN CORPORATION, LD. v. HOPKINSON.

Patent.—Action for infringement.—Infringement of several Patents alleged. 5
—Motion for Judgment in default of Defence.—Judgment for Plaintiffs.

On the 8th of September 1903, *The Saccharin Corporation, Ltd.*, commenced an action against *John Arthur Hopkinson* for infringement of the following Letters Patent, which, in the Particulars of Breaches, were divided into groups A and B, namely (A) No. 25,273 of 1894, granted to *H. Imray*; (B) No. 5135 10 of 1895, granted to *H. E. Newton*; (B) No. 1164 of 1897, granted to *W. Lloyd Wise*; (B) No. 3680 of 1898, granted to *Julius Hanff*; (A) No. 9962 of 1899, granted to *G. B. Ellis*; (B) No. 19,629 of 1899, granted to *H. H. Lake*; and (A) No. 4525 of 1900, granted to *Oliver Imray*. The Plaintiffs, by their Statement of Claim, as amended, alleged (1) That they were the proprietors of the 15 Patents; (2) That a certificate of validity was granted in respect of the Patent, No. 25,273 of 1894, by BUCKLEY, J., in an action of *Saccharin Corporation, Ltd. v. Anglo-Continental Chemical Works, Ltd.**; (3) That the Defendant had infringed the Patents in manner by the Particulars of Breaches therewith delivered appearing; (4) That on or about the 2nd of November 1900, the 20 Plaintiffs commenced an action against the Defendant, alleging *inter alia* that the Defendant had infringed the first five of the Patents; (5) That on or about the 15th of November 1900, the Defendant, in consideration of the Plaintiffs agreeing not to proceed further in the said action, undertook not directly or indirectly to infringe any or either of the said Patents, and admitted that the said 25 five Patents were valid and subsisting; and (6) That the Defendant, in breach of his said undertaking, had further infringed the Patents as set out in the Particulars of Breaches. The Plaintiffs claimed an injunction against infringing all or any of the Patents, and the usual other relief, with costs, and as regards the Patent, No. 25,273 of 1894, costs as between solicitor and client. 30

The Particulars of Breaches alleged as follows:—(1) That, prior to the issue of the writ, and subsequent to the date of the several Patents in the Statement of Claim referred to, the Defendant had infringed the Patents in the Statement of Claim set out by the importation, sale, offer for sale, and use of 35 *saccharin* in this realm; that the *saccharin* so imported, sold, dealt with, and used was manufactured from toluene sulpho-chloride according to the processes described in the Specifications of the four said Patents marked "B," and as

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claimed in all the claiming clauses of the said Specifications ; that the toluene sulpho-chloride from which the said substances were so manufactured as aforesaid was manufactured according to the Specifications of the three Patents marked "A" in the Statement of Claim, and as claimed in all the claiming clauses of the said Specifications ; (2) that in particular the Plaintiffs complained of the purchase from one, *Jackson*, of Blackley, Manchester, between the end of April and the middle of August, in the year 1903, of 43 lbs. of saccharin and the sale by the said Defendant to one, *George Enock Skidmore*, of 8 Scott Street, Wigan, during the same period, of between 70 to 80 tins of saccharin, the said saccharin so purchased and sold being manufactured as alleged ; and (3) reserved the right to claim in respect of all infringements. The Plaintiffs moved for judgment in default of Defence.

Sinclair (instructed by *J. H. and J. Y. Johnson*) appeared for the Plaintiffs ; the Defendant did not appear.

15 *Sinclair* referred to the Statement of Claim, and the Particulars of Breaches, and continued :—In the Notice of Motion, the Minutes of the Order, which I propose to ask for, are set out. Paragraph 1 asks for an injunction restraining infringement of all these Patents during the continuance of the Patents respectively ; paragraph 2 asks for an inquiry as to damages ; paragraph 3 asks that the costs of the inquiry be reserved ; paragraph 4 for delivery up, and paragraph 5 for costs, and, as regards the Patent in respect of which the Plaintiffs obtained a certificate, costs as between solicitor and client. [BYRNE, *J.*—How do you separate them ?] I do not know how the Taxing Masters do that. I suppose there will be a difference. [BYRNE, *J.*—I think you will have a good deal of difficulty over it. I do not know whether it is worth your while to ask for it.] Of course it may turn out on the inquiry as to damages that the major part of the infringement has been committed in respect of the Patent, as to which the Certificate was obtained. [BYRNE, *J.*—In the Particulars of Breaches you say that the Defendant has imported into England, and you give seven instances. Is this the proper form of Order ? I suppose you do not know which Patent is infringed, so that you put all the Patents together.] We know that certain groups are infringed, and it may very well be that they are all infringed by reason of this stuff being imported. [BYRNE, *J.*—Has judgment been given in this form where the Plaintiffs did not distinguish which Patents were infringed ?] Yes.

35 BYRNE, *J.*—It is alleged here that all the Patents are infringed, and that is not denied.

Sinclair—No.

BYRNE, *J.*—You may have it in this form ; it seems to be right.

40 *Sinclair*—Judgment will be in the terms of the proposed Minutes ?

BYRNE, *J.*—Yes.

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IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, STERLING, AND COZENS-HARDY.

March 2nd and 3rd, 1904.

DUNLOP PNEUMATIC TYRE COMPANY, LD., and PNEUMATIC TYRE COMPANY, LD. v. DAVID MOSELEY & SONS, LD., and INDIA-RUBBER AND TYRE REPAIRING COMPANY. 5

SAME v. DAVID MOSELEY & SONS, LD.

Patent.—Action for alleged infringement.—Right to manufacture and sell one element (not separately claimed) of a combination.—Alleged intent by several persons to sell separately the elements for the purpose of infringement.— 10
Action dismissed.

A Company, the owners of two Patents—(1) (Bartlett), for "Improvements in
"tyres or rims for cycles and other vehicles," and (2) (Welch), for "Improve-
"ments in rubber tyres and metal rims or felloes of wheels for cycles and
"other light vehicles," brought two actions against the Defendants for infringe- 15
ment. The Patents were for combinations. The Complete Specification of
Bartlett claimed:—" (1) The combination of a grooved rim or metal tyre, and
"an arched tyre of india-rubber or other flexible material held in the groove by
"the pressure of an inflated tube within the arch, which forces its edges against
"the sides of the groove, substantially as described. (2) Tyres or rims for 20
"cycles and other vehicles consisting of the parts a, b, c, combined and arranged
"substantially as described and shewn in the drawings." The Complete
Specification of Welch claimed by the fourth and ninth claims respectively:—
" (4) A rubber or elastic tyre having the form of a saddle or arch in section
"lined with canvas, in combination with two wires or sufficiently inelastic 25
"cores for securing the same to the rims or tyres, substantially as herein
"described. (9) A rubber or elastic tyre having the form of a saddle or arch
"in section, provided with endless wires or cores fitted or vulcanised within
"each side for the purpose of securing the same to the rims in combination with
"an inflatable inner tyre or tube, substantially as described and shewn with 30
"reference to Figs. 15 and 18 of the drawings." The Company alleged that the

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Defendants had infringed by selling tyres or parts thereof, and pleaded at the Bar and sought to prove that the Defendants had manufactured and sold the outer tyre or cover (one of the elements of the combinations) with the intent that it should be used by the purchaser (not being a licensee of the Company) for the purpose of making one or other of the combinations. The Defendants denied infringement, and claimed that they were lawfully entitled to sell the cover; that they had done so bona fide and in the ordinary course of trade, and they contended that intent was immaterial. At the trial it was held by SWINFEN EADY, J., that (the Patents having previously been held to be for combinations) the cover was not new, and was not separately claimed; that the Defendants respectively were lawfully entitled to make and sell or sell the cover; that consequently intent was immaterial; and that the Defendants had not infringed. The Plaintiffs appealed.

The Court of Appeal affirmed the decision of SWINFEN EADY, J., and dismissed the Appeal with costs.

These were consolidated actions by the *Dunlop Pneumatic Tyre Company, Ltd.*, and the *Pneumatic Tyre Company, Ltd.*, commenced on the 29th of January 1903, to restrain the infringement of Letters Patent (No. 16,783 of 1890) granted to *William Erskine Bartlett*, and Letters Patent (No. 14,563 of 1890) granted to *Charles Kingston Welch*.

The Complete Specification of *Bartlett* is set out at page 245 of 15 R.P.C., and that of *Welch* at page 533 of 16 R.P.C. The claims so far as at present material are set out in the head note above.

By their Statement of Claim the Plaintiffs stated that—(1) they were the proprietors of the Patents sued upon; (2) that *Welch's* Patent was good and valid, and had been so certified by *Kekewich, J.*, in an action of the *Pneumatic Tyre Company v. Casswell*; also that the Letters Patent of *Bartlett* had been so certified by *Rome, J.*, in an action of the *North British Rubber Company, Ltd. v. Mackintosh*, and that *Welch* and *Bartlett* respectively were the first and true inventors of the inventions described in the Patents respectively; (3) that the Defendants had infringed in the manner by the Particulars of Breaches appearing. They claimed an injunction to restrain infringement, an account of profits or damages, delivery up of all tyres and parts of tyres made in infringement of the Patents, and costs as between solicitor and client.

The Particulars of Breaches stated that—“(1) the Defendants had infringed, and by advertisements, circulars, and the continuous offer for sale threatened to infringe, the Letters Patent by making, selling, and offering for sale pneumatic tyres and parts thereof made in accordance with the inventions claimed in the Letters Patent. (2) The Plaintiffs complained of the manufacture, sale, and offer for sale of beaded-edge and other tyres by the Defendants, *David Moseley & Sons, Ltd.*; also of the sale and offer for sale of similar beaded-edge and other tyres by the Defendants, the *India-rubber and Tyre Repairing Company*, which tyres had been manufactured by the Defendants, *David Moseley & Sons, Ltd.*, and supplied by them to the *India-rubber &c. Company*. (3) They also complained of the manufacture by the Defendants, the *India-rubber &c. Company* of tyres infringing both the Letters Patent, and which were in the said Defendants' price-list described as 're-lined,' but which were in fact re-made tyres. They also complained against the said Defendants of the sale of infringing tyres described in the

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"wholesale price-list as second-hand covers with endless wires, all of which covers were re-made in infringement of the Letters Patent. (4) The said tyres were not of the Plaintiffs' manufacture, and were made in accordance with the inventions claimed in all the claiming clauses of the Letters Patent."

By their Defence *Moseley & Sons, Ltd.*, stated that—(1) they made no admission with regard to any of the allegations in paragraphs 1 and 2 of the Statement of Claim; (2) they denied that they had ever infringed or threatened to infringe either of the Letters Patent; (3) they made no admission with regard to any of the allegations in paragraphs 1, 2, and 3 of the Particulars of Breaches; and (4) they submitted that as against them the action ought to be dismissed.

The Defendants, the *India-rubber and Tyre Repairing Company*, traversed the allegations contained in the Statement of Claim.

The action came on for trial before SWINFEN EADY, J., who held that (the Patents having previously been held to be for combinations) the cover was not new and was not separately claimed; that the Defendants respectively were lawfully entitled to make and sell or sell the cover; that, consequently, intent was immaterial; and that the Defendants had not infringed.*

The Plaintiffs appealed.

The Appeal came on for hearing on the 2nd March, 1904.

Terrell, K.C., C. A. Russell, K.C., J. C. Graham and A. J. Walter (instructed by *J. B. & F. Purchase*), appeared for the Appellants; *Cripps, K.C., Eve, K.C.*, and *O. Leigh Clare* (instructed by *Rowcliffe, Rawle & Co.*, agents for *F. A. Woodcock* of Manchester), appeared for the Respondents *David Moseley & Sons, Ltd.*; *Macnaghten, K.C.*, and *Mark Romer* (instructed by *Emmett & Co.*, agents for *A. & G. W. Fox* of Manchester), appeared for the Respondents the *India-rubber and Tyre Repairing Company*.

Terrell, K.C., and *Russell, K.C.*, for the Appellants.—The case raises an important point of law as to infringement. If a plaintiff owns a Patent for a combination A, B & C, and the defendant makes A—a part of the combination, which can only be used for infringement of the Patent—and sells A with the intention that other persons should put together A, B & C, is he liable as an infringer? The Appellants own two Patents, *Welch's* and *Bartlett's*, which have been the subject of judicial construction, and are for combinations. *Welch*, in Claims 4 and 9, claims a combination of (a) an arched india-rubber or elastic outer tyre, with looped edges for the insertion of wires; (b) the wires, and (c) the rim or tyre in the manner described and illustrated. *Bartlett* claims a combination of, (a) an outer tyre of india-rubber or other elastic material; (b) a metal tyre or rim, and (c) an air-tight tubular chamber, in the manner described and illustrated. *Bartlett's* tyre is secured in the groove by the pressure of an inflated inner tube, and *Welch's* by means of wires in combination with an inflated inner tube. The wires, rims and inner tubes, are common articles of commerce. The outer cover is an article which requires a great deal of plant and machinery to manufacture, and consequently can only be made by persons who have substantial means. The covers are of use for no other purpose than to form part of one or other of the Appellants' combinations. The *India-rubber and Tyre Repairing Company* sell the covers, which they purchase from Messrs. *Moseley*. The intention in making and selling the covers, is that they should be used by others to make one or other of the combinations. *Swinfen Eady, J.*, held, that intention was immaterial. But a Patent is a franchise; infringement of Patent is a trespass; a trespass is a tort; and when several persons join together in accomplishing a tort, they are joint tortfeasors, and each is liable for the whole

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tort. Therefore, the Appellants contend that intention to take part in the tort is material. The part taken by the Defendants is the making and selling the covers. The Courts discourage pursuing users. It is better to pursue the manufacturer. What Messrs. *Moseley* have done is necessarily an act in part

5 performance of the tort, inasmuch as the covers can only be used to complete the infringement, and for no other purpose. [VAUGHAN WILLIAMS, L.J.—I do not think that intention, in the sense in which you use the word, has anything to do with the matter. You must show that these people took part in the infringement, and not that they were prepared to take

10 part. You have to prove such facts here as you would have to prove if the Statute had made infringement a criminal offence. Have you any evidence which you could have put to a jury that these people took part in an infringement?] Yes. They manufacture covers which cannot be used for any purpose other than to infringe; they sell them and persons buy large

15 numbers of them: they would not sell them if they were not being used in combination with the other parts for the purpose of infringement. The covers are described in a catalogue, which is in evidence, as being “ready for wires,” and if the wires are put into them they are infringements. [VAUGHAN WILLIAMS, L.J.—What is the tort?] The tort is committed by

20 the unknown persons who put the parts together. [VAUGHAN WILLIAMS, L.J.—Can you adduce any evidence to prove an actual infringement of your Patent, and that Messrs. *Moseley* were parties to it?] The inference to be drawn from the evidence is that these articles have been sold for years for the purpose of infringement, and therefore that infringements have been committed.

25 The articles have been sold in a way which can only induce the wrongful act. *United Telephone Company v. Dale* (L.R. 25 C.D. 778), per *Pearson, J.*, p. 782-3. A price list of *Warburton, Allen & Co.*, put in evidence at the trial, indicates how the cover sold to them by Messrs. *Moseley* is to be used, *i.e.*, “ready for wiring.” The tort is proved when circumstances

30 are brought before the Court, from which it may infer that the infringing article must have been made by a person unknown operating with the Respondents. Any of the tortfeasors may be sued. [VAUGHAN WILLIAMS, L.J.—If you could fix *Warburton, Allen & Co.* with selling all the component parts, and nothing was required but to put them together you would have some evidence in proof of infringement.] All the parts of the *Bartlett* are so sold

35 and offered for sale, and it remains only to connect *Warburton, Allen & Co.* with Messrs. *Moseley*. [COZENS-HARDY, L.J.—But *Warburton, Allen & Co.* seem to sell the *Bartlett* and *Welch* tyres.] If *Warburton, Allen & Co.* are infringing by selling covers not made by the Appellants, together with the

40 other parts, and the covers they sell are made by Messrs. *Moseley*, then inasmuch as such covers are of no commercial value except for that purpose, Messrs. *Moseley* are taking part in the tort that *Warburton, Allen & Co.* are committing. If I sell poison to a man intending that he should poison some one with it I am liable. Here part of the evidence shows that the Defendants

45 intended the covers to be used in infringement. Intention to do an act with the knowledge that it is for the purpose of committing a tort is material as distinguished from intention to infringe a Patent. The cases as to contribution between joint tortfeasors point to the distinction *Merryweather v. Nixon* (8. T.R. 186) and *Adamson v. Jarvis* (4 Bingham 66.) The Courts have

50 drawn a distinction between cases where an act was obviously illegally done, and cases where, although illegally done, the person joining in did not know of its illegality. [VAUGHAN WILLIAMS, L.J.—According to *Warburton, Allen & Co.*’s catalogue they seem to offer for sale all the articles necessary to make the combination; that might be evidence

55 against them of an act constituting infringement by them.] If it is evidence as

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against them of an infringement it is evidence that a tort has been committed. Then it must be shewn that Messrs. *Moseley* took part in it. A direct act of infringement by them cannot here be proved. The evidence proves an infringement of the fourth Claim of *Welch*. Messrs. *Moseley* have taken part in a series of acts constituting the infringement, and are therefore liable for it. 5
Clark v. Newsam and Edwards, 1 Exch. 31.

The following cases were also referred to :—*Adams v. Kelly*, Ryan and Moody, 157; *Lister v. Leather*, 8 E and B, 1004; *Harrison v. Anderston Foundry Company*, L.R. 1 App. Cas. 574; and *Dunlop Pneumatic Tyre Company v. Neal*, 16 R.P.C. 247; L.R., 1899, 1 Ch. 807. 10

The Respondents were not called upon, but *Cripps*, K.C. stated that what Messrs. *Moseley* had done they had done in the ordinary course of trade. They had sold the covers for many years. They had nothing to do with *Warburton, Allen & Co's* catalogue. They repudiated the whole basis of the Appellants' case. 15

VAUGHAN WILLIAMS, L.J.—We have heard this case at considerable length, and in my judgment it is really covered by authority, but even if it is not covered by authority, I have no doubt as to what our judgment ought to be, and that the decision of Mr. Justice *Swinfen Eady* ought to be affirmed. There can be no doubt, having regard really to the whole course of this action, both before 20
Mr. Justice *Swinfen Eady* and upon the hearing of this Appeal, that the real question which was intended to be raised by the Plaintiffs was this—whether the selling of an article intended to be used for the purpose of infringing a Patent is an infringement of the Patent. In my judgment it is not.

The best way of dealing with the case would be to take the very short 25
statement of the facts as it appears in the Judgment of Mr. Justice *Swinfen Eady*. He said: "Generally, there is no dispute as to the facts with regard to what the Defendants, Messrs. *Moseley*, are doing. They are making and selling what is known as the cover, that is the outer detachable cover, and they are selling it with a lining suitable for the insertion of wires, so that the 30
cover, as sold by them, is adapted for use in the manner described in *Welch's* Specification, but not necessarily for use solely in that manner. They are also making and selling a cover with beaded edges, but without pockets, for wires, which cover is capable of being used in the manner described in *Bartlett's* Specification, the beads or lugs of the cover engaging in the inturned 35
angle of the rim." There we have a short statement of the facts of this case. In my judgment our conclusion ought to be the same in this case, whether or not Mr. Justice *Swinfen Eady* is right when he said that these covers, of which complaint is made, are adapted for use in the manner described in these Specifications, but not necessarily solely for use in that manner, and he 40
repeated the same conclusion when he said, most of the "covers would probably ultimately be used in one or other of those methods" that is to say the *Welch* or the *Bartlett* method—"I am of opinion that those are not exhaustive of the purposes to which the covers may be put, and that they would be useful for 45
other purposes in connection with other tyres, as Mr. *Beaumont* pointed out."

It is quite plain that what the Plaintiffs allege here is that there has been an infringement by one or other of these Defendants, and that that infringement has been constituted by the sale of these covers which are constituent parts of one or other of the methods patented in the combination Patents known as the *Welch* Patent, and the *Bartlett* Patent. I am 50
of opinion that the sale of these covers cannot be said to amount to or be evidence proving an infringement of one or other of these Letters Patent. In truth, and in fact, veil it how you like, the Plaintiffs do not complain of any infringement of this Patent in which they say that the Defendants, one or other of them have taken part as actors. All that they complain of 55

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is the sale of these covers, which sale, it is said, must have been known to be a sale to a person intending to commit an infringement of one or other of these Patents.

In my judgment the authorities show conclusively that on those facts there would be no infringement by the Defendants of these Letters Patent. Our attention has been called to the Judgment of Sir *George Jessel* in the case of *Townsend v. Haworth*, the first report called to our attention is that in the 12th Chancery Division in the notes to a case of *Sykes v. Howarth*. The case of *Sykes v. Howarth* itself begins on page 826, and the report of the Judgment of Sir *George Jessel* in *Townsend v. Haworth*, to which I am going to refer appears in the notes to the report of *Sykes v. Howarth*. There Sir *George Jessel* says: "You cannot make out the proposition that any person selling any article, either organic or inorganic, either produced by nature or produced by art, which could in any way be used in the making of a patented article can be sued as an infringer, because he knows that the purchaser intends to make use of it for that purpose." That case of *Townsend v. Haworth* went to the Court of Appeal, and the Judgment of Sir *George Jessel* was affirmed in the Court of Appeal. The report of that is to be found in the report of *Sykes v. Howarth* in 48 Law Journal, Chancery, at page 770. I wish, before leaving the consideration of *Sykes v. Howarth*, to call attention to an observation at the end of the Judgment of Lord Justice *Fry*, then Mr. Justice *Fry*, in *Sykes v. Howarth*: this appears in the report of his Judgment both in the Law Reports and in the Law Journal. It is this: "In what I have said, I think there is nothing at variance with the conclusion expressed by the Court of Appeal, and by the Master of the Rolls in the case of *Townsend v. Haworth*, and I entirely agree, if I may say so, that selling articles to a person to be used for the purpose of infringing a Patent is not an infringement of the Patent." He went on to point out that the case of *Sykes v. Howarth* was an entirely different case.

Perhaps it is convenient, before I go to the report of the decision of the Court of Appeal, which appears at length in the Law Journal Report of *Sykes v. Howarth*, just to point out really what were the facts which had to be dealt with in that case. The marginal note in the Law Journal Report, page 769 is very concise and very accurate. It runs thus: "Improvements in 'card' covered rollers were the subject of a Patent. A, under a contract to 'clothe,' rollers for B, made cards, and in accordance with the Patent the cards were 'nailed' to the rollers by a person selected by B, and paid by A:—Held, that the 'nailer' was the agent of A, and that A had infringed the Patent." The whole ground therefore of that decision was that the nailer was the agent of A, and was paid by A, and it was on that ground that, as Mr. Justice *Fry* pointed out, the case was entirely different from the case of *Townsend v. Haworth*, which was before Sir *George Jessel*, and afterwards before the Court of Appeal. I now return to what is decided in the case of *Townsend v. Haworth*. I have really read the passage from the Judgment of Sir *George Jessel*. Now let me read what it is that is said by the Lords Justices on the hearing of the Appeal. Lord Justice *James* said: "It is clear there is no case for an injunction. Upon this Bill there is no allegation that the demurring Defendants are in any sense of the word infringers. It is true that they may be having a privity in the sale of the articles, and may indemnify the other Defendant, the infringer. But it is impossible, to my mind, to conceive a declaration at law which would meet the case and make them liable, and if they are not liable at law, they are not liable in equity." That is to say that Lord Justice *James* not only decided the question upon the demurrer to the Bill, but he took the facts set out in the Bill, and said that to his mind it would be impossible on those facts to conceive any

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declaration at law which would meet the case. Then Lord Justice *Mellish* said :
 " I am of the same opinion. I think it is quite clear that at law the Defendant
 " would be entitled to a verdict on a plea of not guilty. Selling materials for the
 " purpose of infringing a Patent to the man who is to infringe it, even although
 " the party who sells it knows that he is going to infringe it and indemnifies him, 5
 " does not by itself make the person who so sells an infringer. He must be a party
 " with the man who so infringes, and actually infringe." Now, I put that view
 to Mr. *Terrell* and to Mr. *Russell* in the course of the argument. I say that, in
 form, what they are complaining of here is an infringement; but when they
 come to the proof of that of which they are complaining, infringement, they do 10
 not prove that the Defendants are parties with anyone who has infringed,
 and they do not prove that the Defendants have actually infringed. Of
 course, if the Defendants were parties to an infringement, in such sense as that
 they would be principals, if infringement were an offence which would be
 indictable as a criminal offence, they would be equally responsible in this 15
 civil action, but how can it be contended for one moment upon these facts that
 if infringement were an indictable offence, as I have hypothetically suggested,
 there would be any case whatever to go to a jury upon these facts? The truth
 of the matter is, that not only is not it true in this case that the Defendants on
 these facts are parties with a person who has committed an infringement so as 20
 to make them what is called in criminal law principals in the first degree, but it
 is equally clear that they are not even what is called in criminal law principals
 in the second degree. It cannot be said on these facts that they have aided or
 abetted anyone in the commission of the act of infringement. The truth of the
 matter is that, taking the evidence in this case, and taking the findings of 25
 the learned Judge in this case, which I see no reason to disapprove of, it is
 impossible to find that there is any infringement either alleged or proved.
 In that state of circumstances it seems to me impossible to say that the
 Plaintiffs have proved a good cause of action, because they have proved the sale
 by the Defendants, or any of them, of articles which are adapted for use in one 30
 or other of the patented arrangements. I wish to say that, in my judgment,
 this case would fail even though the Plaintiffs were able to substantiate the
 proposition which the learned Judge finds against them, that these covers, as
 manufactured and sold by these Defendants, could not be used for any other
 purpose than fitting them into the Plaintiffs' tyres under one or other of the 35
 Patents.

I want to say one word about the *United Telephone Company v. Dale*, which
 was cited to us, and which is reported in the 25th Chancery Division. That was
 a case which was heard before Mr. Justice *Pearson*, in which he made an
 observation in the course of the argument. I only want to say that although 40
 we have not got to decide it in the present case, I see no reason for sug-
 gesting that Mr. Justice *Pearson's* observation was wrong. His observation
 was this, as it appears on page 782: " If there was a Patent for a knife of a
 " particular construction, and an Injunction was granted restraining a Defendant
 " from selling knives made according to the Patent, and he was to sell the com- 45
 " ponent parts, so that any school boy could put them together and construct the
 " knife, surely that sale would be a breach of the Injunction." I have not to
 determine whether that observation is right or not. I only wish to say that, as
 far as I am concerned, I see no reason for saying that it is wrong, and there is
 nothing in my judgment to-day which is intended to be inconsistent with it. If 50
 you are in substance selling the whole of the patented machine, I do not think
 that you save yourself from infringement because you sell it in parts which
 are so manufactured as to be adapted to be put together. But that is not this
 case. Here, what is complained of is merely the sale of some one or other of the
 parts of one or other of the patented tyres. 55

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I do not think that I need say any more in this case, but I should like to add that I cannot conceive that the practical result of our judgment will be to inflict any injury upon the Plaintiffs. If the parts manufactured and sold by Messrs. *Moseley* are eventually used for the purpose of making the patented
 5 tyres, and thus infringing the Patents of the Plaintiffs, the Plaintiffs will have full opportunity of suing those who thus infringe their Patents, and the fact that they were not able to sue the present Defendants for selling some article which might or must be intended for use in making such tyres would not, in my judgment, practically deprive them of their full rights to enforce any rights and
 10 privileges which they are entitled to as Patentees. I dare say in this particular case there may be some difficulty, partly because of the conduct of the Plaintiffs themselves as brought to our knowledge in this case and in the antecedent case, and partly by the fact of these tyres being tyres of world-wide user. The truth of the matter is that the Plaintiffs seem to have granted very large and
 15 extensive licenses within the United Kingdom. It is quite plain, therefore, that the sale of these tyres, even if they were sold entire, and the sale of these parts of tyres, the thing complained of here, to those licensees is no infringement of the Patents, although they are intended to be used, and are in fact used for the manufacture of tyres. It is also quite plain that the manufacture of these
 20 tyres for the purpose of selling to export merchants is a matter which may be very far from being an injury to the Patentees. Under these circumstances I think that the decision of Mr. Justice *Swinfen Eady* ought to be affirmed, and this Appeal dismissed with costs.

STIRLING, *L.J.*—I am of the same opinion. Both the learned Counsel who
 25 argued this case on behalf of the Appellants admitted, and, in my judgment, rightly admitted, that the mere manufacture and sale of the covers which are in question did not constitute an infringement of the Patent. The case of *Townsend v. Haworth*, before Sir *George Jessel*, when Master of the Rolls, and the Court of Appeal, decides that the sale of the covers does not become an
 30 infringement merely because the vendor knows that the purchaser intends to use the article when sold for the purpose of infringing the Patent. It is necessary for the purpose of constituting the vendor an infringer to show that he has made himself a party to the infringement.

In the present case there are two Defendants; one is the manufacturer of the
 35 covers; the other is the *India-rubber Company*, who sold the covers, and, it is said, with the addition of other portions of the combination which is patented. The learned Judge who saw the witnesses, decided that the *India-rubber Company* did not infringe, and we have really not been asked to over-rule his decision on that question of fact. But assuming that the *India-rubber Company*
 40 did infringe, still, in my judgment, there is no evidence that the manufacturers knew, still less that they made themselves parties to any infringement.

I agree with the Judgment of Mr. Justice *Swinfen Eady*, and in particular I desire to adopt this portion of it as my own: "Selling these covers to licensees
 "of the Plaintiffs is a lawful trade; selling them for export is a lawful trade,
 45 "but the purchasers, nevertheless, might not export them; and to make the
 "Defendants, Messrs. *Moseley*,"—those are the manufacturers—"responsible
 "for the ultimate use of the covers, so as to put upon them the burden of
 "ascertaining whether the purchasers intended to use, and to use them
 "lawfully, would be imposing upon them a burden, which, in my opinion, the
 50 "law does not impose."

I agree that the Appeal ought to be dismissed.

COZENS-HARDY, *L.J.*—I so entirely agree with what has fallen from my Lord, and from Lord Justice STIRLING, and also with the Judgment of Mr. Justice
 55 *Swinfen Eady*, that it would not be right for me to add more than a very few words.

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It seems to me to be almost beyond dispute that the mere manufacture and sale of these covers was a perfectly lawful business. We had before us the day before yesterday a case in which the same Plaintiffs were Appellants, from which it appeared that one of the licensees of these very patents sells more than 25,000 of them a year—considerably more than 25,000 a year we were told. 5 It is also in evidence here that there is a very large export trade in these covers. So far, therefore, as Messrs. *Moseley* export them, and so far as they supply them to licensees, it is plain that no complaint whatever can be made by the Plaintiffs, and having regard to what was said in argument, I think it right, speaking for myself, to say that there may be a third class of cases in 10 which, from any point of view the supply might be perfectly legal—I mean for the purposes of repair. I am quite aware that the word “repair” is a difficult word to construe, but I do not, myself, think that *Neal’s* case in Law Reports 1899, 1 Chancery, bears fully the construction which was attributed to it by the Appellants’ Counsel. I certainly doubt, I do not say any more than that, 15 whether the holder of a licensed tyre may not replace a worn-out cover without being guilty of an infringement of the Patent. It is not necessary to decide that here; but I only desire for myself to keep that matter open for another occasion. That being so, we have a trade which is certainly not necessarily unlawful, and, indeed, it seems to me to be plainly legal and lawful, and if that 20 be admitted, *Townsend v. Haworth* is a decision of the Court of Appeal, which is binding on us, that there is no infringement by the Defendants, even though they sell to persons with the intent that those persons should afterwards use them for infringing purposes, or even if they took an indemnity in case of any infringement being made. I think *Townsend v. Haworth* is binding 25 on us, and I entirely agree with what was said by Sir *George Jessel*, and by the Lords Justices in that case.

I think that this Appeal fails, and must be dismissed.

IN THE HIGH COURT OF JUSTICE.—KING’S BENCH DIVISION.

MANCHESTER WINTER ASSIZES.

30

Before MR. JUSTICE BIGHAM.

February 10th, 1904.

CROSSLEY v. COATES.

Patent.—Action for infringement.—Prior user.

This was an action for infringement of a Patent for improvements in anti- 35-vibration devices for use with incandescent gas fittings. The Defendant alleged the invalidity of the Patent on various grounds, including prior user.

Held, that the prior user alleged by the Defendant was proved. Judgment was given for the Defendant with costs.

Crossley v. Coates.

On the 19th of March 1903 Letters Patent (No. 18,796 of 1902) were granted to the Plaintiff *Bartholomew Crossley* for "Improvements in anti-vibration devices for use with incandescent gas fittings."

The Complete Specification, so far as material for this report, was as follows :—

5 "The invention relates to anti-vibration devices for use with incandescent gas fittings, and the first part has reference to means employed for that purpose in the suspension of incandescent gas lights, which is especially serviceable for mills and workshops, and public buildings, but may be also employed in private houses. The second part of my invention is designed to prevent
10 "oscillation of top part of light fittings, and to give to same greater firmness or stability.

"To accomplish the first part of my invention, I make two springs from copper covered steel, or other tempered wire, which are hung one from the other, and each of which are provided with two long hooked arms, so that the
15 "heat from the gas does not come in contact with the springs and cause them to lose their elasticity. One of such springs provided with hooked arms may be employed instead of two, but I prefer the use of two.

"To attain the object of the second part of my invention, the gas shade or reflector, is made to fit over the wire frame containing the light, and made
20 "to rest on the shoulders of a 'Jena' normal chimney, by having a central hole for the passage of top part of chimney. From the part resting on chimney shoulders, two slots are cut, one slot diametrically opposite the other, so as to fit the wire frame on each side, securely holding top part of wire frame and chimney, thus preventing oscillation, or chimney being knocked out of its
25 "place accidentally, whereby the life of both chimney and mantle is prolonged."

After describing the drawings (which included a particular gas shade or reflector), the Patentee claimed :—"1. As a suspending anti-vibration device for use with incandescent gas fittings, a spring constructed with two long hooked arms
30 "to get the spring portion clear of the heat evolved from the gas, substantially as described and set forth. 2. As a suspending anti-vibration device for use with incandescent gas fittings, the use of two springs, each having two long hooked arms, engaged one with the other, substantially as described and illustrated. 3. A lamp shade or reflector for use with incandescent gas fittings,
35 "constructed with a central hole J, and having slots K K, substantially as described and illustrated for the purpose specified."

On the 30th of June 1903 the Patentee commenced an action for infringement against *John George Coates*, claiming the usual relief.

By his Particulars of Breaches he alleged—(1) the manufacture and sale of
40 anti-vibration devices for use with incandescent gas fittings similar to those shown on the Drawings attached to the Complete Specification; and (2) that the manufacture and sale of anti-vibration devices was an infringement of the first, second, and third claims of the Patent.

The Defendant by his Defence denied—(1) that the Plaintiff was the owner
45 of the Patent; (2) that the Plaintiff was the first and true inventor; (3) infringement in the manner mentioned in the Particulars of Breaches or at all; and alleged (4) that the Patent was invalid for the reasons set out in the Particulars of Objections.

The Particulars of Objections were as follows :—" (1) The true and first
50 "inventor of the subject of the Letters Patent in question was *James Cross*, of 110 Leeds Road, Nelson, or one *Andrew Jackson*, who formerly worked for Plaintiff, whose present address is unknown to the Defendant. (2) The alleged invention is not the proper subject-matter of Letters Patent. (3) The alleged invention is not useful. (4) The alleged invention was not new at the date
55 "of the said Letters Patent, having regard to common and public knowledge at the date thereof. (5) The alleged invention was merely the application to incandescent gas fittings of that which has been familiar and matter of

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"common and public knowledge in the case of every implement or mechanism which required to be suspended free from vibration as far as possible. (6) The alleged invention was published within the realm prior to the date of the said Letters Patent by the filing at the Patent Office of the following Specifications:—*Edward Freund* (No. 16,734 of 1892) for 'Improvements in portable lamps'; *W. T. Sugg* (No. 2172 of 1899) for 'Improvements in supports for materials used for incandescent gas lights.' (7) The alleged invention was also published within the realm by the manufacture and user of the same or similar devices for incandescent gas fittings by the manufacture thereof by *James Cross*, of 110 Leeds Road, Nelson, in the year 1885 onwards down to the date of the Letters Patent, and particularly in the months of December 1901 and January 1902, and by the manufacture and sale thereof by *Joseph William Law*, of 13 Liverpool Street, Preston, prior to the date of the said Letters Patent," and by a large number of other persons and firms therein mentioned.

The action came on for trial on the 10th of February 1904 at the Manchester Winter Assizes before Mr. Justice BIGHAM, sitting without a jury.

Atkinson (instructed by *John Lord*, of Burnley) appeared for the Plaintiff; *Grant* (instructed by *Smith Lawson*, of Burnley) appeared for the Defendant.

The Plaintiff was called and deposed that he made a drawing, and from that his patented article was made for him by one *Andrew Jackson*, a wire worker whom he met in a tramcar and took into his employment.

John Cooke, a practical engineer, spoke to the novelty and utility of Plaintiff's invention.

For the Defence, *James Cross* deposed that he sold supports for incandescent lamps, and that the *Andrew Jackson* who had been employed by the Plaintiff to make his patented article had made a precisely similar article for witness in the winter of 1901–2, which witness had sold in large quantities.

Joseph William Law was also called, and produced a contrivance made and sold prior to the date of the Plaintiff's Patent similar to the Plaintiff's patented article.

BIGHAM, J.—This seems to me to be exactly the same in principle as the Plaintiff's. I do not know, Mr. *Atkinson*, whether you are going to ask me to disbelieve Mr. *Cross*. Unless you have some good reason for asking me to disbelieve what he tells me I shall accept his evidence.

Atkinson.—The only reason I have for suggesting that he must be mistaken about the year is this: he has never suggested anybody as the inventor till to-day, and he has permitted *Crossley* to advertise this as his. One would expect a protest from an ordinary business man, but he never let *Crossley* know. These are curious facts.

BIGHAM, J.—They do not in the least unsettle my conviction that these things were made when *Jackson* was in the employment of *Cross* in the year 1901 and in the beginning of 1902.

Atkinson.—I really cannot ask your Lordship to disbelieve *Cross*.

BIGHAM, J.—I may say this further, though it is not necessary to say it: I do not believe that I should have held that this was good subject-matter for a Patent at all, and I have a strong impression also—perhaps it is not necessary to express it, but I have a strong impression—that, if any merit is to be given to anybody, *Jackson* is the person entitled to the merit. However, I am not going to pronounce judgment upon that point. There will be judgment for the Defendant with costs.

Grant.—I ask for a Certificate as to the Particulars of Objections.

BIGHAM, J.—Yes, but as to the anticipations so far only as relates to *Law* and *Cross*.

Montomerie & Co., Ltd. v. Young Brothers.
Montomerie & Co., Ltd. v. Marshall.

IN THE COURT OF SESSION IN SCOTLAND (OUTER HOUSE).

Before LORD KYLLACHY.

March 6th and 18th, June 25th and 31st, July 1st, 3rd, and 17th, 1903.

Before THE SECOND DIVISION—LORDS JUSTICE CLERK, YOUNG & TRAYNER

5 August 13th, 1903, January 19th, 20th and 21st, 1904.

MONTGOMERIE & CO., LD. v. YOUNG BROTHERS.

MONTGOMERIE & CO., LD. v. MARSHALL.

10 *Trade Mark.—Trade name.—Action to restrain use of trade name and infringement of Trade Mark.—Action to restrain the passing off of bread as "Bermaline Bread."—Probability of deception.—Absence of deceit or fraud on the part of Defendant personally.—Liability for act of servant.—Interdict granted by the LORD ORDINARY, but refused by the Second Division of the Inner House.*

15 *M. & Co., bakers, &c., in Scotland (the Pursuers in the actions) began in 1886 to make a special bread containing extract of malt, and called this bread "Bermaline Bread," registering the word "Bermaline" as a Trade Mark, and calling the malt extract used in their bread "Bermaline Malt Extract." They advertised such names extensively and appointed agents throughout the kingdom, who were authorised to sell the Pursuers' bread*
 20 *and to make bread containing the Pursuers' extract of malt. In February 1902, being in a position to supply flour and meal to all their agents, they intimated to their agents that, unless they took their meal or flour for making "Bermaline Bread" made under the licence from the Pursuers, their agencies would be recalled. M. resigned his agency February 1902, took down*
 25 *"Bermaline Bread" from the window of his one shop in Bellshill and put up "Marshall's Malt Bread," under which name he directed his servants to sell his bread. He also instructed them never to give out his own bread as "Bermaline." Thereafter, on fourteen occasions between October 1902 and*

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January 1903 his servants sold to seven persons loaves as "*Bermaline Bread*" which were not "*Bermaline Bread*" having paper bands around them which were said to be colourable but innocent imitations of bands enclosing the Pursuers' loaves. Y., an agent, who had shops in Edinburgh, resigned his agency on the 5th of November 1902, and directed his servants to say they no longer kept "*Bermaline Bread*." Thereafter, on ten different occasions at five different shops, Y.'s servants, however, sold and described loaves as "*Bermaline Bread*" which were not "*Bermaline Bread*" to nine persons who were either customers or emissaries of M. & Co.

Held, by the LORD ORDINARY, that both Defenders through their servants had represented their goods as the goods of the Pursuers and infringed their Trade Mark, and that their personal innocence did not affect the Pursuers' right to damages for invasion of a proprietary right and commission of a legal wrong; and held, further, that as the number of sales suggested a practice which afforded reasonable ground for an apprehension of continuance of the wrong, interdict must be granted against both Defenders selling under the name of "*Bermaline*" bread not manufactured by the Pursuers, or which has not been manufactured or put on the market by the Pursuers or with their authority.

Contra held, by the Inner House (Second Division) on the ground that the evidence did not satisfy them that either Defender intended or committed wilful injury, or that wrong had actually been done. Observed (per LORDS YOUNG and TRAYNOR), that where the Court are of opinion that a master has adopted all reasonable means to prevent his servants committing a wrong, mere inadvertence or carelessness in a few unimportant instances, even if proved, may not warrant interdict being granted.

Interdict refused.

The Pursuers in these cases were maltsters, malt extract manufacturers, millers, bakers, and food specialists, who carried on business at Partick, Glasgow, and at the Bermaline Mills, Haddington. Since 1886 they and their predecessors had been manufacturing a special kind of bread containing an extract of malt manufactured solely by themselves. They were the owners of a Trade Mark registered on the 24th of August 1894 under the Patents, &c. Acts 1883 to 1888, numbered 181,861 and of No. 215,477, registered on the 7th of July 1898, for the use of the word "*Bermaline*" in Class 42, for substances used as food or ingredients in food. The Pursuers' malt extract, and it alone, was known as and called "*Bermaline Malt Extract*," and bread in the manufacture of which "*Bermaline Extract*" was used was called "*Bermaline Bread*," and was the only bread so called. The Pursuers stated (and it was not denied) that they had spent large sums in advertising and creating a demand for this bread.

Young Brothers, the Defenders first mentioned, were bakers in Edinburgh, and *Marshall*, the other Defender, was a baker in Bellshill, in Lanarkshire. Many bakers throughout the United Kingdom had been appointed agents by the Pursuers for the manufacture and sale of "*Bermaline Bread*" containing the Pursuers' "*Bermaline Malt Extract*." *Young Brothers* held such an agency from the 28th of June 1897, and *Marshall* from the beginning of May 1897.

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In February 1902 the Pursuers, having erected mills for the purpose of manufacturing meal, sent out a circular to the trade, in which they intimated that they were receiving complaints from the public all over the country about the quality of "Bermaline Bread," and that they were satisfied that those complaints were caused by the inferior quality of the meal used by their agents. They also intimated that the agency would be recalled unless the agent agreed to purchase the meal supplied by the Pursuers. The Defender *Marshall*, on receipt of the Pursuers' circular, refused to bind himself to buy the Pursuers' meal, and on the 25th of February resigned the agency, and thereafter returned to them the drums and other property used in connection with the "Bermaline Bread." On the 28th of March he wrote to the Pursuers asking them to remove the "Bermaline Bread" lettering from his window; this was shortly afterwards done, and the lettering "Marshall's Malt Bread" was substituted. The Defenders *Young Brothers* did not become purchasers of the Pursuers' meal, but were allowed to retain the agency for the manufacture and sale of "Bermaline Bread" made with the "Bermaline Malt Extract" till the 5th of November 1902, when, in consequence of a dispute with the Pursuers' traveller, they gave it up. On the 22nd of November 1902 they wrote to the Pursuers requesting them to remove from their shop windows all "Bermaline" advertisements. They also sent or gave orders to all their shops, of which they had several in different quarters of Edinburgh, that the sale of "Bermaline Bread" should be stopped, and that, if asked for, the customer should be told that it was no longer kept. The Defender *Marshall*, on giving up his agency, also intimated to his assistants that he no longer made "Bermaline Bread," and directed that his bread was to be sold as "Marshall's Malt Bread." He averred that his customers were also made aware that thereafter he only sold his own malt bread. At the end of October 1902 the Pursuers became suspicious that many bakers who had given up their agencies for the sale of "Bermaline Bread" were selling as "Bermaline Bread" bread not made with the "Bermaline" extract. They sent round emissaries to the shops of various bakers to test by actual purchase whether this was so. These persons went, amongst others, to the shop of *Marshall*. They gave evidence that they had there purchased as "Bermaline Bread" loaves which were produced and were admittedly not made with "Bermaline" extract. Such sales, they averred, were made to them on the 30th and 31st of October, on the 1st, 3rd, 7th, 10th, 11th, 12th, 15th, 27th, and 28th November, on the 12th and 26th of December 1902, and on the 9th of January 1903, being fourteen separate occasions. The shopgirls, on the other hand, gave evidence that they never sold bread as "Bermaline Bread" after the agency was given up; that they never sold "Marshall's Malt Bread" as "Bermaline Bread"; and, in particular, that they sold no bread as "Bermaline Bread" on the dates mentioned. Some of them could not remember the persons who were said to have bought the loaves in question. Some of them remembered selling bread to them, but not "Bermaline Bread."

After *Young Brothers* gave up their "Bermaline" agency on the 5th of November 1902, the emissaries of the Pursuers went to their shops also, and on the 8th, 11th, 14th and 21st of November, purchased in five shops of these Defenders loaves which they produced which were not made with "Bermaline Extract," but which, they deposed, were sold to them as "Bermaline" loaves. In this case also the shopgirls denied having made such sales either to these persons or to others.

In consequence of these inquiries made by the Pursuers, actions were raised against *Young Brothers* and against *Marshall*. The grounds and the conclusions of the two actions were substantially the same. In each case it was averred "that the Defenders have been in the habit of wilfully and fraudulently advertising for sale and selling as 'Bermaline Bread' bread not manufactured with 'Bermaline Malt Extract' and known by the Defenders not to be so

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"manufactured, on the false pretence made by the Defenders or their shopmen
 "and servants that such bread was 'Bermaline Bread' manufactured with the
 "'Bermaline Malt Extract' all in infringement of the Pursuers' Trade Mark
 "and in contravention of the Patents, Designs, and Trade Marks Act, 1883,
 "section 76." It was asked that the Defenders should be interdicted "from in 5
 "any way advertising or offering for sale or selling any substances used as food
 "or as ingredients in food, and particularly any loaves of bread stamped or
 "marked, or labelled or enclosed in wrappers or packages marked with the
 "word 'Bermaline,' or using the name 'Bermaline' either by itself or in com-
 "bination with other names to designate substances used as food or as 10
 "ingredients in food, and particularly loaves of bread manufactured by the
 "Defenders, and so stamped or marked or labelled or enclosed in wrappers or
 "packages so marked, or from advertising or representing themselves as bakers
 "or sellers of 'Bermaline Bread' or selling loaves of bread under said name, or
 "using said names in invoices, labels, bags, packages or stationery, or in any 15
 "way infringing the sole and exclusive right of the Pursuers to use the name
 "'Bermaline' in connection with or for the purpose of designating any sub-
 "stances used as food or as ingredients in food, and particularly any loaves of
 "bread." The Pursuers also concluded for 100% damages, but stated at the Bar
 "that they did not desire substantial damages, but would be satisfied with a 20
 "nominal sum.

The Pursuers pleaded:—"1. The Defenders having infringed the Pursuers'
 "Trade Mark, the Pursuers are entitled to interdict as concluded for. 2. The
 "Defenders having wilfully and fraudulently used the name by which the
 "Pursuers' goods are known in the market, and thereby illegally encroached on 25
 "and injured their trade, the Pursuers are entitled to interdict as concluded for.
 "3. The Pursuers having sustained loss and damage to the extent of the sum
 "sued for through the wrongful acts of the Defenders, they are entitled to
 "damages as concluded for."

The Defenders, *Young Brothers*, pleaded:—"1. The Pursuers' statements 30
 "are irrelevant and wanting in specification. 2. The Pursuers' averments, so
 "far as material, being unfounded in fact, the Defenders are entitled to
 "absolvitor, with expenses. 3. The Pursuers having sustained no loss or
 "damage through any acts of the Defenders, are not entitled to damages."

The pleas tendered for *Marshall* in the other case were similar. He also 35
 pleaded:—"2. The Defender, not having infringed the Pursuers' Trade Mark,
 "ought to be assoilzied."

In the case of *Young Brothers* the Record was closed on the 6th of March 1903,
 and a proof allowed, which was taken on the 25th of June and 3rd of July 1903;
 and in the case of *Marshall* the Record was closed on the 18th of March 1903, 40
 and proof before answer as to relevancy allowed, which was taken on the 31st of
 June and 1st of July 1903.

At the proofs the various points were brought out which have been referred
 to in the preceding narrative. It appeared that the Pursuers, before February 45
 1902, when they erected mills of their own, had been in the habit of supplying
 their agents with their malt extract and allowing them to buy their flour where
 they pleased. After they erected mills they insisted that their agents should
 use their (the Pursuers') flour, partly with a view of keeping the quality of the
 bread uniform all over the country, but partly also with a view to obtaining a
 large market for the flour. [Lord KYLLACHY.—I am quite satisfied that the 50
 Pursuers were entitled to prescribe the terms on which their trade name
 might be used. But there is no question here as to the flour. It is a complaint
 for selling "Bermaline Bread" made without "Bermaline Extract."] In
 regard to the sales, it was proved that in each case the Defenders had repeatedly
 warned the shopgirls not to sell their bread as "Bermaline Bread." There was 55
 no attempt on the part of the Pursuers to prove that the sales had been made

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with the Defenders' sanction in either case, or to substantiate the charge that the sales were "wilfully and fraudulently" made. Neither Defenders had ever advertised their bread as "Bermaline Bread," or used the word "Bermaline" on invoices, labels, bags, packages, or stationery, after the close of the agency.

5 *Marshall* offered to advertise that he did not sell "Bermaline Bread." The "Bermaline" lettering had in each case been allowed to remain for a short time on the window after the termination of the agency; in the case of *Young Brothers* from the 25th of February to the 28th of March; in the case of *Marshall* from the 5th of November to the 22nd of November. In *Marshall's*

10 cases the purchases founded on were made while the lettering remained on the window; in *Young's* case after its removal. In *Marshall's* case evidence was led regarding certain bands which were put round his loaves of bread, and which were stated to be a colourable imitation of those used by the Pursuers. Each loaf of this Defender's malt bread was encircled with a paper band,

15 marked in large letters "Marshall's Malt Bread." The Pursuer's bread when sold bears a paper band, on which are printed in conspicuous letters the words "Bermaline; Montgomerie's Patent." Both bands were printed by the same printer. They were both in two colours, red and blue. They were of the same size, twenty inches by two, and were of somewhat similar appearance. On the

20 bands used by *Marshall*, while he was agent for "Bermaline Bread," was printed a picture of a medal won by him with "Bermaline Bread"; this picture was also placed on the band of "Marshall's Malt Bread." The words "Sold as" "fancy bread in compliance with the Bread Act," appeared on both bands. For about two months after giving up the "Bermaline" agency, *Marshall* had

25 used a band entirely different from both of these bands. He averred that what resemblance there was in the bands was accidental, and that, in fact, the bands were clearly distinguishable. In *Young's* case the bread was sold without any band round it. In both cases the question for the Court (putting aside the dispute regarding the bands) practically narrowed itself to this—Whether the

30 Defenders' shopgirls had, against their express instructions, sold their bread as "Bermaline" in the circumstances detailed above, and if so whether this was a use of the trade name of the Pursuers sufficient to support the present action of interdict.

In the Outer House the Pursuers amended their Summons in each case so

35 that it should run (the words then inserted being those in italics):—"From in" "any way advertising, or offering for sale or selling, any substances used" "as food, or as ingredients in food, and particularly any loaves of bread" "stamped or marked or labelled or enclosed in wrappers or packages marked" "with the word 'Bermaline,' or using the word 'Bermaline' either by itself or

40 "in combination with other names, to designate substances used as food or as" "ingredients in food, *except the 'Bermaline Bread' manufactured by the*" "*Pursuers or their agents*, and particularly loaves of bread, *not being*" "*'Bermaline Bread'* manufactured by the Defender, and so stamped or

45 "marked or labelled or enclosed in wrappers or packages so marked; or from" "advertising or representing himself as a seller of 'Bermaline Bread,' or selling" "loaves of bread under the said name being bread or loaves not of the Pursuers'" "or their agents' manufacture, or not containing 'Bermaline' extract" "manufactured by them or any of them, or using said name on invoices,"

50 "labels, bags, packages, or stationery, or in any way infringing the sole" "and exclusive right of the Pursuers to use the name 'Bermaline' in" "connection with, or for the purpose of designating, any substances used as" "food, or as ingredients in food, or particularly any loaves of bread *not being*" "*Bermaline Bread.*"

This amendment was made verbally at the Bar, and was allowed by the

55 LORD ORDINARY in the interlocutor by which he disposed of the case, but was not written on the process copy of the closed record and

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initialled by Counsel till 20th July, three days after the pronouncement of that interlocutor.

In the Outer House, Counsel were heard in *Marshall's* case on June 31st, and in that of *Young Brothers* on July 3rd. On July 17th Lord KYLLACHY, Lord Ordinary, pronounced judgment in both cases as follows: "The Lord Ordinary 5
 "allows the Pursuers to amend the conclusions of the summons as proposed at
 "the Bar: Opens up the record for that purpose, and said amendment having
 "been made, recloses the record; and, having considered the whole cause,
 "interdicts, prohibits, and discharges the Defenders from selling loaves of bread
 "under the name of 'Bermaline Bread,' which have not been manufactured by 10
 "the Pursuers, or put on the market by the Pursuers or with their authority;
 "decerns against the Defenders for payment to the Pursuers of the sum of 5s. in
 "full of the conclusion for damages; finds no expenses due to or by either
 "party." For LORD KYLLACHY'S opinion, see 20 R.P.C., p. 781.

The Defenders in each case reclaimed to the First Division. The cause was 15
 subsequently transferred to the Second Division.

The Reclaiming Notes were boxed on August 13th 1903; and sent to the Roll on the first day of the winter Session thereafter, the question of the competency of the Reclaiming Notes being reserved for hearing at the same time as the 20
 merits.

Counsel were heard on the 19th and 20th of January 1904.

Counsel for the Reclaimers *Young Brothers, Salvesen, K.C., and Hunter* (instructed by *Hutton and Jack*, Solicitors); Counsel for the Reclaimer *Marshall, Shaw K.C., and Morison* (instructed by *R. S. Rutherford*, Solicitor); Counsel 25
 for the Respondents, *Clyde K.C., Constable and W. F. Trotter* (instructed by *T. S. Paterson, W.S.*).

Counsel for the Respondents objected to the competency of the Reclaiming Note on the ground that the amendment which had been made on the Summons in the Outer House had not been printed in the print appended to the Reclaiming Note. Counsel for the Reclaimers contended that the amendment had not been 30
 properly made, or at least that, at the date when the interlocutor reclaimed against was pronounced, no properly authenticated copy of it was in process, and that the process was to be printed as at the date of the interlocutor reclaimed against. The following cases and Statutes were cited in debate:—*Judicature Act, 1825*, sec. 18; *Act of Sederunt, 11th July 1828*, sec. 77; *Carter v. Johnston*, 35
 9 D. 598; *Muir v. Muir*, 2 R. 26; *McEvoy v. Brae's Trustees*, 18 R. 417; *Williamson v. Howard*, 1 F. 864; *Adams v. Adam's Trustees*, 5 F. 863.

The Court unanimously repelled the objection. The opinions of the Judges on this point of Scottish procedure will be found in the "Scots' Law Times," 40
 vol. XI., p. 601.

Counsel were then heard on the merits.

For the Reclaimers, it was argued that the only evidence brought to show that the sales complained of had been made was that of employes of the Respondents. It was contradicted in every case by the evidence of the shopgirls. The Respondents had not made out clearly that 45
 these sales ever occurred. The Reclaimers had instructed their servants not to sell bread as "Bermaline." [Lord YOUNG: A master is responsible for damage done by his servant, but it is a novel proposition to me that a master is to be interdicted against his servants' acting contrary to his instructions.] In any case the employes of the Respondents who bought the bread were not 50
 deceived. They knew they were not getting "Bermaline Bread"; that was their object. [The LORD JUSTICE CLERK: Each man knew that if the bread supplied to him was "Bermaline Bread" it should have had a "Bermaline" band round it. They made no inquiry as to this?] No. Besides, the infringement of the Respondents' rights, if any, was unimportant and innocent, and interdict 55
 should not be granted (*Bass, Ratcliff and Gretton, Ltd. v. Laidlaw*, 13 R. 898).

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Singer Machine Manufacturing Company v. Wilson (L.R., 3 App. Cas., 376) and *Montgomery v. Thompson* (L.R., 1891, App. Cas., 217; 8 R.P.C. 361) were to be distinguished. There the acts of infringement were undoubted and considerable. *Cellular Clothing Company v. Maxton* (16 R.P.C. 397; 25 R. 1098) and *Thomson & Co. v. Robertson* (15 R. 880) were founded on. *Davidson v. Campbell Renton* (41 Scottish Law Reporter 134) was cited to show that there might be ground for interdict against the servant, yet the Respondents might not be entitled to interdict against the master.

For the Respondents it was argued that the evidence showed there had been at least a legal infringement of their rights, and this was enough to entitle them to an interdict (*Singer, ubi supra*; *Cellular Clothing Co., ubi supra*); the master could be interdicted for the acts of his servant even though committed against his orders (*Betts v. De Vitre*, L.R. 3 Ch. App. 429 at p. 441; *Tonge v. Ward*, 21 L.T., 480; *Sykes v. Howarth*, L.R., 12 C.D. 826).

On the 21st January 1904, the Court unanimously recalled the interlocutor reclaimed against and assoilzied the Defenders with expenses.

CASE OF YOUNG BROTHERS.

LORD JUSTICE CLERK.—The LORD ORDINARY has felt compelled to grant interdict. After giving all consideration to the case, I do not think this was a case for interdict. The thing to be interdicted is the sale of what is not “Bermaline Bread” as “Bermaline Bread.” That would be a good ground for interdict if it had been done in such a way as to be an infringement of the rights of the Pursuers, even had it been done by the Defenders’ servants and without the Defenders’ knowledge and approval. But in such a case as this we must look with care to see that there really was such a sale and how it was gone about. The question turns on the sale of a few loaves of bread. When an article is of great value the sale of even a single article may be so important as to justify interdict. But here when the action is raised about the sale of a very small number of loaves, there must be very clear evidence of such sales having been made. On reading the evidence I am not satisfied that such sales were made; or if they were, they were by pure inadvertence. I think the evidence should be very clear that what was being asked for was “Bermaline Bread.” I am not satisfied that this was so. The evidence is conflicting, and it seems as if the matter had been gone about for the express purpose of entrapping the saleswomen. It is very extraordinary that the action should be raised about the sale of an article of which the value is so small, and in the sale of which the Defenders had so little interest. I agree with the Lord Ordinary that interdict should not be granted unless there is a reasonable apprehension of a repetition of the offence. Here there can be no such apprehension. The Defenders, it is true, were not willing to admit that they had committed an offence, but they are willing to undertake that such sales of supposedly “Bermaline Bread” will not continue. On the whole matter I am of opinion that there has been no such proof of the sale of bread as “Bermaline Bread,” which was not “Bermaline Bread,” as to entitle the Pursuers to interdict.

LORD YOUNG.—In this case the facts alleged by the Pursuers are clear, emphatic, and strong. They allege that the Defenders, who were at one time authorised by them to sell “Bermaline Bread” by that name, to which the Pursuers alone were entitled, renounced the right so to sell it on 22nd November 1902, but that notwithstanding that renunciation they sold “Bermaline Bread” under the trade name, not accidentally but wilfully, to the Pursuers’ great damage. The averments to that effect are very clear. The last occasion on which, as alleged, bread was sold as “Bermaline Bread” by the Defenders was 14th November 1902, that is, six weeks before this action was raised. It was

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not contended by the learned Counsel that there was any truth in that allegation. Both of the *Youngs*, the Defenders, stated that they had no intention of selling "Bermaline Bread" as such after they ceased to have the Pursuers' authority, and that they instructed their servants accordingly. There is evidence to that effect by the Defenders, and I ventured to put the question to Mr. *Constable* at the end of his speech, whether he disputed the truthfulness of the Defenders' statement they had no such intention and had given such instructions, and he said he could not dispute that. Now, when did the Pursuers become aware of the facts they allege as having come to their knowledge recently before the action was raised? I asked whether inquiry had been made as to whether any customer had got "Bermaline Bread" as such in the Defenders' shops after the renunciation by them of the Pursuers' Agency. The answer was that no such inquiry had been made or would be possible. Therefore it was something approaching to wilful false statement on the Record that such sales had been made. The Pursuers could not prove any such sales except to the detectives employed by themselves after November 1902, to see if they could not catch the Defenders' servants, and the evidence of these employés of their own was contradicted. I must say that, upon the facts so disclosed, the statements made on Record are not only not warranted by any evidence, but are shown by the evidence to be such as ought not to have been made. They were averments which it was discreditable to make. I venture to use that word. They were averments discreditable to be made without any inquiry having been made to ascertain the truth of them before they were made. Now upon that I should be very clearly of opinion on the evidence that there was no case for an interdict at all. I do not accept the evidence of detectives and employés of the description I have referred to, when contradicted by the evidence, which I accept as honest and truthful evidence, of the servants in the shops of the Defenders. I do not accept that evidence, and I therefore hold upon the proof here that there were no sales contrary to the instructions of the Defenders—the admitted instructions made by them and received by their employés. But I go further, and say that, if even I could hold it as proved that those persons, who were employed to be trapping witnesses, had succeeded in getting from the girls "Bermaline" loaves by the name of "Bermaline," I should hold that to be no ground for an interdict in the face of what I hold to be proved—that the instructions of the Defenders were distinct that there should be no such sales. I cannot agree to the proposition that if a servant disobeys the master's instructions in a matter of this kind, the interdicting of the master is the remedy. The cases show, and the good sense and reason of the thing—such good sense and reason as almost all our common law is founded upon—show that, if a trader carries on business in a manner which he is not entitled to do to the detriment of another, it will be no excuse to him, and nothing to prevent an interdict, that he has done it by others, not by his own hand, if he has not taken all the means in his power to prevent it. In the cases which have occurred, the employer against whom an interdict was asked and obtained was carrying on the business, and carrying it on in a manner which he maintained he was entitled to do, and which was not hurtful to his neighbour so as to entitle his neighbour to complain. When it was decided by the Court against that contention that it was, then it was quite proper to interdict him by himself or others continuing to carry on the business or to do the things either with his own hand or by the hands of others employed by him, which he had been maintaining his right to do and defending his conduct in doing. But the case which I have put, and which is presented here upon the assumption with which I am now dealing, is not of that kind at all, but simply of a servant in a shop violating accidentally or otherwise the instructions of her master. In a case of that kind to say that the remedy is to interdict the master and to punish him for breach of interdict, that is to say,

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for his contempt of the authority of the Court which has granted it, if his servant or any servant in any of his shops should ever violate his instructions again,—to maintain such a proposition is certainly not in my opinion to be accepted. The maintenance of such a proposition is not to be sustained. I do not need to enter into this case any further than I have done. Perhaps I have gone too much into detail already, but I must repeat that the averments of the Pursuers here, contrasted with the evidence as to their conduct and as to their truth and facts of the case, show as unmaintainable a case as I ever remember to have had occasion to deal with. I am therefore of opinion with your Lordship that the defences ought to be sustained, the grounds of action repelled, and the Defenders assoilzied with expenses.

Lord TRAYNER.—My Lord, this case presents some features that, I think, are not commonly met with in actions of this kind. The complaint is that the Defenders have violated a right of the Pursuers to their detriment, but it appears, and it is not disputed, that the Defenders disclaim any intention to do that which is complained of. They say that they have further instructed their servants to take care that all customers, regular or casual, who come to their premises for the purpose of purchasing “Bermaline Bread” are to be told that they do not sell it. And the motive that they might have had for interfering with the Pursuers’ right is absolutely removed by this fact, which I think is sufficiently established, that the sale of “Bermaline Bread,” at all events in the Defenders’ experience, has not been a commercial success but has been the contrary. They have therefore no motive for carrying on this trade, which the Pursuers’ say they are carrying on. They have distinctly announced that they do not intend to carry it on, and they have as distinctly instructed their servants to tell the public who come to the shops that they do not carry it on, and do not sell that particular kind of bread. Now, it would be difficult in these circumstances, taking nothing else, to hold that the Defenders should be interdicted from doing a thing which they not only deny they have ever done, but which they distinctly state their intention not to do again. They had carried on this trade legitimately enough for a certain time, but their instructions to their servants, following upon their own distinct resolution, was that they would carry it on no longer, and their servants were instructed to inform regular and casual customers that that was so. I do not think that that presents a case for interdict if there was nothing else. But then, my Lord, we come to the evidence, and I rather agree with some of the observations which have been made upon the value of evidence of persons who are professional or non-professional detectives sent to premises for the purpose of trying to get up a case. That class of evidence, I think, is always to be received *cum nota*, and unless it is corroborated by independent testimony is not to be proceeded upon with any confidence. Now, in this case of *Young’s* the witnesses who are brought to support the Pursuers’ case are persons who were sent, some of them from Glasgow, for the express purpose of trying to support the Pursuers’ case, for the purpose of getting people in the Defenders’ shops to sell them, on their request for “Bermaline Bread,” something that was not of the description asked for. I say again that that evidence unsupported would not impress me favourably; but all the less do I give any credence or weight to it, when it is opposed by evidence of a very independent character, and I must say remarkably well given. The servants in the Defenders’ shops were unanimous in stating not only that they had got the instructions from their masters, to which I have already referred, but that they were careful to keep these instructions in view and obey them, and they say they did. Now, it is quite possible to suppose that these witnesses examined for the Pursuers did go and ask for “Bermaline Bread,” and it is possible that they got something in reply to their demand which was not “Bermaline Bread” on one or two occasions. That is quite possible, but then it is rather a curious thing that the persons who come

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to make these demands for "Bermaline Bread" come at a time when the shops are full, when the shop girls are busy, doing their best to supply customers who don't want to be kept waiting, and in these circumstances it is not wonderful if the shopgirl, when the request was preferred did not hear or understand that it was "Bermaline Bread" that was being asked for. It is not quite the same word, 5 but it might quite well be misunderstood for brown bread, and brown bread they all got. But even if the Pursuers' witnesses had gone to the Defenders' shops on one or two occasions and asked distinctly for "Bermaline Bread," and had in return got something which was not "Bermaline Bread," I should not have regarded one or two instances, that might have arisen entirely from inadvertence, 10 a sufficient ground for granting the interdict which has been craved for. On the whole matter, in *Young's* case, I am quite satisfied that the Pursuers have entirely failed to make out a case for interdict, and that they have certainly proved no damage, and, therefore, I agree with your Lordships in thinking that the interlocutor should be recalled and the Defenders assolized. 15

CASE OF R. MARSHALL.

The LORD JUSTICE CLERK.—My Lords, the matters here are in a somewhat different position from *Young's* case, but the result is the same. In this case the conflict of evidence is very sharp indeed, and it is quite certain that the Pursuers' witnesses put a good deal of circumstance into their evidence, whether 20 true or otherwise, which does not occur in the case of the other action with which we have just dealt. But concurring, as I do, in the observations that have been made in regard to the class of witnesses that were brought, I have looked with some care into some of that evidence, and I am not at all satisfied with it, apart altogether from the evidence given for the Defender. There was 25 one thing which was very marked and pointed, and that is that one of the servants through a speaking tube asked whether there were any "Bermaline" loaves ready in the bakery, and got a reply that they would be ready in a few minutes, and one of the witnesses said he heard the reply; I think it is an extremely doubtful thing how he, standing in the shop, could hear a reply 30 through a speaking tube or a telephone. But the particular witness who speaks to it speaks very strongly, "Hullo, Jeanie, send round some 'Bermaline Bread' at once." One witness says he asked whether there were any "Bermaline" loaves ready, and he was informed there were, but the wife of *Kelly* who says that was said does not corroborate him at all, but on the contrary contradicts his 35 evidence in regard to that matter in a very distinct manner. Now, that is just one of those instances which rather tests whether witnesses are not just going a little—to use a current expression—beyond the score in what they say. It is quite possible that when he was there something was said through a speaking tube. I don't say that the man is committing absolute perjury in 40 saying that some such incident took place, but where I think the evidence fails is that it referred really to "Bermaline Bread." Both the Defender's witnesses distinctly say that nothing of the kind took place, that no such question was asked about "Bermaline Bread," and that no such answer was given, and I see no reason to attribute greater faith to the evidence of *Kelly* than to the 45 evidence of those two witnesses. And so with regard to a great deal of the evidence which has been led in the case of *Marshall*, it does not impress me favourably, particularly in a case where the purpose is to prove that the bread was being sold on the false pretence made by the Defender and his shop-people that such bread was made with the "Bermaline Malt Extract" made by the 50 Pursuers. In this case the striking and very remarkable fact occurs that was referred to by one of your Lordships in dealing with the other case, that there is proof positive by persons absolutely disinterested that the Defender's servants

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refused to sell to the ordinary customers of the shop bread as being "Bermaline Bread" after the date at which their agency had ceased. Now, I accept that evidence. I see no ground whatever to doubt it, but if the servants of the Defender were persistently refusing to sell bread as "Bermaline Bread" to the
5 ordinary customers of the Defender, it would be a very strange thing indeed if, when people came in that they knew nothing about, who happened to be employed practically as detectives by the Pursuers, they should then proceed to sell bread as "Bermaline Bread" to them. It is quite possible that some of the witnesses who come for the Pursuers did ask for "Bermaline Bread," but it is also
10 equally possible that that was not thoroughly understood by the servants. But this is quite certain that in every case in which they did supply the bread they supplied it with their statement in print upon it to the effect that it was "Marshall's Malt Bread." Now, if they did that it is perfectly plain that the Defender intended to act *bonâ fide* after giving up his agency, to sell such bread
15 that was "Bermaline Bread" in appearance as being "Marshall's Malt Bread." But, then, it was said that the label was a colourable imitation of the Pursuers' label. My Lords, I see no ground for saying that at all. I quite accept the explanation that is given of the form of the label by the Defenders. They got this from the printer, made up not from their design, but from his design,
20 and the only resemblance that I can see between the two is that both are printed partially in blue and partially in red characters, but it appears quite distinctly on the one that "Bermaline" is the leading word, and quite distinctly upon the other that "Bermaline" is not the leading word but "Marshall's Malt
25 Bread," and no person who paid the very slightest attention, indeed, without any attention at all, if they had looked at the label and saw the words on it, could doubt that it was not a label bearing to represent that that bread was "Bermaline
30 Bread." My Lords, I don't see very well what more the Defender could do. And in this case, as in *Young's* case, it is a little remarkable that no communication is made to the Defenders to get any explanation before an action
35 was raised, no pointing out that some of your servants are doing a thing which they ought not to do, which in the ordinary course of business between reasonable people would be a reasonable and sensible course to take to avoid litigation. There was no real attempt to injure the Pursuers, but immediately a very strong and offensive attack on the ground of fraud is made against the
40 Defender. My Lords, I am satisfied that the Pursuers have failed to prove any such case as they allege on Record, and that as in the other case the interdict should be refused.

Lord YOUNG.—I concur.

Lord TRAYNER.—I also concur.

40 LORD JUSTICE CLERK.—With expenses in both cases.

Monro v. Hunter.

IN THE HIGH COURT OF JUSTICE.—KING'S BENCH DIVISION.

Before MR. JUSTICE CHANNELL.

February 15th, 1904

MONRO v. HUNTER.

Trade Mark.—Use as a Trade Mark.—Mark used by salesman on baskets 5 containing goods consigned to him.—Conversion of baskets.—Defendant responsible for acts of his agent.—Judgment for Plaintiff for nominal damages and costs.

The name of a Covent Garden salesman was registered as an old mark, and was marked upon baskets belonging to him and used by growers of the vegetables 10 consigned to him for sale on commission for the purpose of packing and forwarding their goods to him. Some of the baskets sent by him to one of such growers for such purpose were made use of to send vegetables to other salesmen, and the vegetables were exposed for sale in the baskets by the other salesmen.

The business of the grower had been assigned to the Defendant as trustee for 15 the grower's creditors, and at the time of the wrongful use of the baskets the grower was carrying on the business as agent for the Defendant.

Held, that the Plaintiff was entitled to damages for infringement of Trade Mark and for conversion of the baskets against the Defendant, notwithstanding 20 that the wrongful acts had been committed contrary to his orders.

The Plaintiff charged the growers to whom he sent his baskets a sum, less than the value of the baskets, as security for their return and to enable him to keep an account. This was not held to constitute a sale of the baskets.

This was an action for infringement of Trade Marks and also for damages 25 for the conversion of certain baskets upon which the Trade Marks were stencilled or painted, and which were alleged to be the property of the Plaintiff.

The Plaintiff, George Monro was a salesman at Covent Garden Market, London. His business consisted of the sale upon commission of fruit, flowers and vegetables consigned to him by the growers. The practice in the market, which was followed by the Plaintiff, was for the salesman at the beginning of the 30 season, and from time to time, to deliver to the growers large numbers of baskets, marked with his name and Trade Marks, which are to be used by the growers to pack their goods, but only for consignment to the salesman. For purposes of account and as a security for the return of the baskets, a conventional sum, somewhat less than the value of the baskets, is charged against the grower in 35 the salesman's books, when baskets are sent to him, and is allowed for when the baskets are returned by the growers either full or empty.

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Before the month of February 1902, one *Boardman*, carried on business as a grower of cucumbers and other vegetables at Haslemere. He had been accustomed to consign his produce to the Plaintiff, and large numbers of baskets marked with the Plaintiff's name and Trade Marks had been sent to him for the purpose referred to above. On the 14th of February 1902, he executed an assignment of his business and property to the Defendant, *Robert Hunter*, as trustee for his creditors. The Defendant, who was an accountant in business in the City of London, carried on *Boardman's* nursery and business under *Boardman's* name down to the month of June 1902, when he sold it. He employed *Boardman* as his agent to conduct and carry on the nursery and business down to the time of the sale, and paid him wages out of the estate.

The Plaintiff was the registered proprietor of several Trade Marks specified in the Statement of Claim, each consisting substantially of his name, *George Monro*, printed in ordinary letters. They were claimed as old marks in use before 1875. None of them had been on the Register five years at the date of the action.

The action was commenced on the 13th of August 1902. The pleadings were as follows : the Plaintiff by his Statement of Claim stated :—(1) That he carried on business as a fruit, flower and vegetable salesman at Covent Garden, London, and was the proprietor of three several Trade Marks, consisting of or comprising his name, and registered respectively in Class 42 under Nos. 227,376 and 231,367, and in Class 50 under No. 232,935 ; (2) that the Plaintiff used the said Trade Marks by marking the same upon baskets and barrels containing produce which was his or had passed through his hands, and the said Trade Marks respectively were well known in the Market and to the trade and public as indicating that the baskets and barrels upon which they or any of them was marked and the contents thereof were his goods or had passed through his hands and that the said contents were of good quality and were properly and fairly packed ; (3) that the Defendant carried on or had recently carried on the business of a nurseryman at Haslemere in the County of Surrey, which was assigned to him by one *Samuel Boardman* on or about the 14th day of February 1902 and in the said business he wrongfully used baskets and barrels marked with the said Trade Marks or some of them for and in connection with the sale of produce which was not the Plaintiff's and which had never passed through the Plaintiff's hands ; (4) that the Defendant had wrongfully detained and still detained certain baskets of the value of £28 7s. 6d. which were the property of the Plaintiff, and although required before the commencement of this action to return the same he had refused and neglected to do so ; (5) alternatively the Defendant had wrongfully converted the baskets last mentioned to his own use. Particulars of the said baskets converted were delivered with the Statement of Claim.

The Defendant by his Defence stated :—(1) The Defendant admitted the first paragraph of the Statement of Claim, but would contend that the Trade Marks therein mentioned were not valid on the ground that the purposes or subject-matter for which the same purported to be used were not the proper subject of a Trade Mark or entitled to the protection thereof ; (2) the Defendant denied that the Plaintiff used his alleged Trade Marks by marking the same upon baskets or barrels containing produce which was his or had passed through his hands, or that the said Trade Marks respectively were well-known in the market or to the trade or public as indicating that the baskets or barrels upon which they or any of them were or was marked, or the contents thereof were his goods or had passed through his hands, or that the said contents were of good quality or were properly or fairly packed ; (3) the Defendant denied that he had wrongfully used baskets or barrels marked with any of the Plaintiff's alleged Trade Marks or had wrongfully detained or converted any of the Plaintiff's baskets or had ever refused or neglected to return any of the Plaintiff's baskets ; (4) that it was the Plaintiff's practice to sell his baskets

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and other receptacles to any persons desiring to use the same, who either paid or were debited in account with the price thereof, and there was no obligation on the part of the purchasers to return the same or to use the same only for the purpose of consigning goods to the Plaintiff; (5) that the Plaintiff's practice was to receive consignments of produce of all qualities, and to sell the same on commission in the ordinary course of business, and whether consigned in baskets or receptacles marked with his name or alleged Trade Mark or not, and there was no indication or representation to purchasers of goods in receptacles so marked that such goods were of good quality or were properly or fairly packed, but that the purchasers paid the prices for them according to the quality; (6) that the Plaintiff supplied his baskets and other receptacles to any persons, and that he sold, as before mentioned, any goods of any quality consigned by any producer in any kind of basket or receptacle; (7) that the baskets claimed by the Plaintiff in this action were sold by him to or charged by him in account with *Samuel Boardman*, named in the Statement of Claim, and the Defendant would contend that the Plaintiff had no right of Action against the Defendant in respect thereof.

On behalf of the Plaintiff evidence was given by the Plaintiff himself, as to the practice above-mentioned; that the baskets were not sold but remained the property of the Plaintiff; and to the effect of paragraph 2 of the Statement of Claim. It was also proved that a number of baskets belonging to the Plaintiff, in respect of which the sums debited as security amounted to £44, representing about 800 baskets, had been delivered to *Boardman* and had not been returned before the 14th of February 1902. About half of these were returned by the Defendant or by *Boardman* in June 1902. Evidence was given that in the month of April 1902, baskets marked with the Plaintiff's name and Trade Marks and filled with cucumbers were seen on the railway at Haselemere. They had printed labels bearing *Boardman's* name and his business address as consignor, and the Plaintiff's name and address as consignee. The Plaintiff's name had been struck out and they had been re-addressed to a salesman at Guildford, Surrey, at about the same time. Cucumbers in the Plaintiff's baskets, marked as stated, were seen exposed for sale at the sale-rooms in Guildford of the salesman referred to.

The Plaintiff was unable to prove what number of the Plaintiff's baskets were actually received or taken over from *Boardman* by the Defendant, or were actually used by him, and accordingly he asked for nominal damages only.

The Defendant was called as a witness on his own behalf, and stated that he inspected the nursery from time to time, but never saw any of the Plaintiff's baskets there, that he had given *Boardman* orders not to use the Plaintiff's baskets, and that *Boardman* had baskets of his own. He denied all knowledge of the wrongful use of the Plaintiff's baskets.

Dickens, K.C., and *D. M. Kerly* (instructed by *J. C. Button & Co.*) appeared for the Plaintiff; *Montague Lush*, K.C., and *Edward Ford* (instructed by *Harris, Chetham & Co.*) appeared for the Defendant.

Dickens, K.C., and *Kerly*, for the Plaintiff, argued that the marks were Trade Marks, and had been used as such, citing the judgment of *Bowen*, L.J., in *In re Powell's Trade Mark*, 10 R.P.C. 195; L.R. (1893) 2 Ch. 388; and that there had been an infringement; there was also conversion of the baskets.

Edward Ford, for the Defendant, argued that there was no proof of the use of the baskets or marks by the Defendant or by *Boardman*. That, in any case there was no infringement, because the marks were used as marks of ownership of the baskets only, and not as Trade Marks. The Defendant was not liable for what *Boardman* might have done in the matter.

CHANNELL, J.—I think there must certainly be nominal damages, because I think it has been proved—not by the very clearest evidence in the world, but by quite sufficient evidence—that notwithstanding any instructions the Defendant

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may have given—and by that I do not mean to say that I dispute his word or doubt his word when he says he did give them—but notwithstanding any instructions that he may have given to *Boardman* to use *Boardman's* own baskets and not to use *Monro's*—I am satisfied on the evidence, that in respect
5 of two or three baskets at any rate, *Boardman* at the time when he was carrying on this business for *Hunter* did use a few of these baskets. That was a wrongful act, and I think it involves nominal damages, and it involves the liability of the person who was in fact carrying on that business for the act of his servant in doing it, notwithstanding that act of his servant was in
10 contravention of his express orders, because it was an act done in the course of the master's business, and within the scope of his employment, and done for his master, to send his master's cucumbers—not done for his own purposes in any way. Consequently, according to all the principles on which a master or employer is liable, for those whom he employs, I think that the Defendant here
15 is liable in nominal damages for the misuse of those baskets.

I do not want to give any judgment one way or the other upon the Trade Mark question, but from the assumption which I make for the purposes of this case, that the Trade Mark is a good one, it follows that there is an infringement both of the right of property and of the right of Trade Mark ;
20 but it does not in any way add to the damages which are still nominal. I say “nominal,” although it is just possible that the baskets thus used may have been partially worn out, and may not have been so valuable ; but still there is no proof, for they may have been damaged or may not, and there is no reason therefore for giving more than the nominal damages of one shilling, which
25 I must give.

As to the costs, I should like to see if anyone can now point out to me on the correspondence before action, whether any question of right was set up by the Defendant. If the Defendant—otherwise than in these pleadings, which I understand are Pleader's pleadings—had previously contended, not
30 merely that he had not done it in fact, but that he had a right to do it, and did it, then I think he ought to pay the costs of this action. The probability is that there is no evidence to that effect. I think it is rather doubtful.

[After the correspondence between the parties before action had been referred to, the learned Judge added] : I think I must give the Plaintiff costs. Upon
35 that I have a little difficulty about the point of the Trade Mark, which I have not dealt with ; but while there was no admission that any articles had been in fact used by the Defendant, there was an assertion of a right to use them by the allegation that the course of dealing was to sell the baskets, to the person to whom they were sent and against whom they were debited, and, that the
40 property passed to him with a right to use them for any purpose that the so-called purchaser desired to use them for. After that certainly the Plaintiff could not avoid going on with his action and taking it to trial, and he has succeeded, although he has succeeded only to the extent of nominal damages. I think, therefore, that there must be a judgment with costs, and I will certify for
45 costs on the principle that it really was an action to try a right, namely, the right to use these baskets for the purposes of the grower's trade. That right is clearly negatived upon the evidence. The case is established on the part of the Plaintiff, and I give judgment for the one shilling and any necessary certificates to give the Plaintiff his costs.

50 *Ford* asked that the Plaintiff should be ordered to pay all the costs of an adjournment which he had applied for and obtained, and the learned Judge so ordered.

*British Vacuum Cleaner Company, Ltd. v. Suction Cleaners, Ltd.,
and Others.*

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE SWINFEN EADY.

February 26th, 1904.

BRITISH VACUUM CLEANER COMPANY, LD. v. SUCTION CLEANERS, LD.,
AND OTHERS.

5

Patent.—Action for infringement against several Defendants.—Motion to commit one Defendant for contempt by issuing circulars. — Motion for interlocutory injunction.—Motion to commit refused.

On the 15th of January 1904 the *British Vacuum Cleaner Company, Ltd.*, commenced an action against *Suction Cleaners, Ltd.*, and *Lacy, Hulbert & Co., Ltd.*, for infringement of Letters Patent (No. 17,433 of 1901) granted to *Hubert Cecil Booth*, claiming the usual relief. On the 10th of February 1904 *John Sugden* was added as a Defendant in the action. The Plaintiffs gave notice of motion for an interlocutory injunction against the Defendants, *Suction Cleaners, Ltd.*, and also notice of motion to *John Sugden* for an Order committing him to prison for contempt of Court in procuring to be printed and in publishing on divers occasions, since the date of the issue of the writ, a certain printed circular or advertisement headed "*Bluff v. Business*" alleging *inter alia* that the Plaintiffs knew that they were unable to uphold the validity of the Patent sued on, and in writing and causing to be sent to Messrs. *Rowntree & Sons* a letter, dated the 25th of January 1904, stating *inter alia* that the Defendants, *Suction Cleaners, Ltd.*, had in hand absolute proof that the said Patent was absolutely invalid on account of anticipation, and that the said Defendant might be restrained until the trial of the action, or until further Order during the continuance of the action, from publishing or being in any way instrumental in publishing, whether by letter, circular, advertisement or otherwise, any statement that the Patent was invalid or was known to be so by the Plaintiffs, and from publishing or being in any way instrumental in publishing the said circular or any similar circular, and from otherwise prejudicing and interfering with the trial of the action, and that he might be ordered to pay the costs as between solicitor and client of and incidental to that motion, and that such further or other Order might be made as to the Court should seem meet. The purport of the circular complained of will be found sufficiently stated in the judgment.

T. Terrell, K.C., and *H. A. Colefax* (instructed by *Hasties*) appeared for the Plaintiffs; *A. J. Walter* and *J. H. Gray* (instructed by *Stanley, Woodhouse & Co.*) appeared for the Defendants.

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Terrell, K.C., and Colefax for the Plaintiffs.—The circular issued by the Defendants is a contempt of Court. It was held in *Gaulard and Gibbs v. Lindsay* (4 R.P.C. 189) that a plaintiff may not say that he has commenced an action which is certain to succeed; but he may issue a fair warning saying
 5 that he is advised that what a defendant does is an infringement. Here the warning which the Plaintiffs have issued is a perfectly proper one; but the Defendants are saying in their circular that the Patent is bad and that the Plaintiffs know it. That is a statement that the Plaintiffs are acting dishonestly. [*Fenner v. Wilson & Co., Ltd.* (10 R.P.C. 283) and *Daw v. Eley* (L.R. 7 Eq. 49)
 10 were referred to.] Then there is a motion for an interlocutory injunction.

Walter.—The Defendants want to have an early trial of the action, and are prepared to give an undertaking until the trial. [It was arranged that the action should be set down at once, but not come into the paper for a fortnight.] Also the Defendants do not propose to send out the circular any
 15 more; it is not now applicable. But the Plaintiffs by their circulars appealed to the public, and they cannot properly complain of the Defendants having done the same thing (*Daw v. Eley*).

Terrell, K.C., in reply.—*Daw v. Eley* only shows that a fair reply is allowable, but the Defendants' circular is of an unjustifiable nature.

20 *SWINFEN EADY, J.*—In this case there are two motions before me—one to restrain the infringement of a Patent, the other to commit for contempt in issuing a circular, C.F.H. 2, headed "*Bluff v. Business.*" Now, happily, the motion for the injunction has been disposed of in what I cannot help thinking is the best manner possible: an early day has been fixed for the trial, and the
 25 parties, at the trial, will have their rights determined.

With regard to the motion to commit, I think it is sufficient to say that I certainly should not make any Order to commit the Defendant for issuing this circular. It appears that there is a contest between the parties as to whether *Booth's* Patent, on which the Plaintiffs are suing, is valid. The Plaintiffs have
 30 issued a postcard headed "Warning." "It has come to the knowledge of the "*British Vacuum Cleaner Company, Ltd.*, that circulars and other advertising "matter had been sent out by *Suction Cleaners, Ltd.*"—that is to say, the Defendants—"offering for sale a machine which the *British Vacuum Cleaner* "*Company, Ltd.*"—the Plaintiffs—"are advised is an infringement of their
 35 "Patent right," and then they gave notice that they will proceed, if their own action is successful, "against all persons vending, supplying or using such "machine." On the other hand, the Defendants have issued a circular stating that they are advised that *Booth's* Patent is invalid and cannot be sustained, and that they believe this is well known to the Plaintiffs, and they add if the
 40 Plaintiffs "believed in their Patent they would have applied for an interim "injunction before this, which, if granted, would effectively stop *Suction* "*Cleaners, Ltd.*, from selling their plants. But to get an interim injunction they "would have to prove their Patent good, and this they cannot do." Then they refer to a special matter: "*Suction Cleaners, Ltd.*, will send some convincing
 45 "information about *Booth's* Patent to anyone interested, and are willing to give "to their customers a guarantee against any claims by the *British Vacuum* "*Cleaner Company, Ltd.*, in respect of any '*Klenus*' plant purchased or used by "them." Now it appears after the Plaintiff Company was formed there was some litigation between them and the owner of a previous Patent, who brought an
 50 action against the present Plaintiffs, and in the result the present Plaintiffs bought up that previous Patent for a sum of 15,000*l.* Of course it is quite possible that both Patents may be valid, but apparently that is the ground which the Defendants have for their statement that they will send some convincing information. In my opinion the circular of the Defendants is
 55 certainly in bad taste, and it is a circular which, it is quite obvious, is not applicable to the present circumstances, and, as a motion has been made for an

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interim injunction, this circular could no longer continue to be issued. I regret the suggestion that the Plaintiffs are aware of the invalidity of their own Patent, but certainly under the circumstances of this present case I should not make any Order of committal or any Order upon the motion. As I have said, the matter will be rapidly tried. There will be no more circulars of this kind sent out 5 between now and the trial, and under those circumstances I do not make any Order on the motion. I simply refuse the motion.

Terrell, K.C.—Then, with regard to the Defence, as we are going to such a speedy trial I should like to add that both parties are to have liberty of inspection of each other's machines, and to take drawings and photographs as they 10 may be advised.

SWINFEN EADY, J.—Mutual inspection, and you can take photographs of each other's machines.

Waller.—I understand that the Defendants have not a machine at present, but they will supply photographs. The Plaintiffs cannot expect the Defendants 15 to make a machine up.

Terrell, K.C.—There is one which has been delivered to the *Patent Steam Carpet Beating Company* I am told.

Waller.—If they will let the Plaintiffs see it, we shall offer no objection.

SWINFEN EADY, J.—You will offer every facility in your power for letting 20 them see machines in existence, if any?

Waller.—Certainly.

Terrell, K.C.—The Defendants have drawings of the machines which they have sold, and I ask for copies of those drawings.

SWINFEN EADY, J.—You can see the machines. The Defendants will give 25 you the names of the persons to whom they sold them.

Terrell, K.C.—Supposing the Plaintiffs cannot see the machines, then they want to see the drawings and take copies of them.

Waller.—They can have photographs, and the Defendants will give them every facility. They will write to their customers and ask them to allow the 30 Plaintiffs to see the machines.

Terrell, K.C.—If the Plaintiffs see the machines that will do, but they might not be able to see them.

SWINFEN EADY, J.—The Defendants have undertaken to give every facility.

Terrell, K.C.—Supposing the customers do not let the Plaintiffs see them, 35 then can the Plaintiffs see the Defendants' working drawings?

Waller.—You can have photographs of our machines.

SWINFEN EADY, J.—There will be liberty to apply.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE FARWELL.

March 24th, 25th, 26th, 28th and 29th, 1904.

BRITISH VACUUM CLEANER COMPANY, LD. v. SUCTION CLEANERS, LD.,
5 AND OTHERS.

Patent.—Action for infringement.—Construction of Specification.—Patent held valid.—Infringement found.

A Patent was granted to B. for improvements relating to the extraction of dust from carpets, &c. The owners of the Patent brought an action for in-
10 *fringement against the S. Co., the L. Co., and J. S. who was the Secretary and manager of, and, as the Plaintiffs alleged, a shareholder in the S. Co. The Defendants denied infringement, and set up the invalidity of the Patent. In the course of the trial the action was dismissed against the L. Co. with costs.*

Held, that according to the true construction of the Specification the Patent
15 *was for an instrument to carry out a particular process, and was valid; and that the S. Co. had infringed, and an injunction was granted against them; but that no case had been made out against J. S., and the action was dismissed as against him with costs.*

On the 30th August 1901, Letters Patent were granted to *Hubert Cecil Booth*
20 *for "Improvements relating to the Extraction of Dust from Carpets and other Materials." The Complete Specification was as follows:—*

"This invention has reference to the extraction of dust and similar impurities from carpets, rugs, curtains, bedding, upholstered furniture, flour sacks, tapestry, and the like, and has for its chief object to effect such extraction
25 *by passing over the surface of the carpet or the like, suitably formed hollow implements whose interior is maintained at a pressure considerably lower than that of the atmosphere, by the action of a power-driven suction pump connected therewith by a pipe or conduit which also serves to conduct the extracted impurities along with the air to an appropriate contrivance or*
30 *contrivances for separating and collecting them from the air so that the latter reaches the pump in a cleanly condition so as not to interfere with the action of the pump.*

"According to my invention the suction pump is actuated by an oil, steam, electric, gas, or other motor, the motor and the pump being both mounted on
35 *a frame, carriage, or base which is adapted to stand outside or inside the building wherein the dust extracting operation is to be performed. The said*

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"pump is connected by flexible piping with the dust extracting implement or implements which are formed with an opening or openings at the part contiguous to the surface of the carpet or the like, for the dust and other impurities to enter the interior of the implement and pass away through the said flexible piping by the suction produced by the pump. At suitable intervals in the length of the piping I provide between the implements and the pump, the aforesaid contrivances for collecting the extracted impurities, such contrivances being preferably located at points outside the room wherein the dust extracting operation is taking place.

"The dust extracting implement has a hollow base portion provided with an opening in its surface which lies next the article to be cleaned, and the pipe or tube connecting the implement with the impurity collectors and the pump, may be provided with a cock or valve so arranged that it normally assumes a closed position and is capable of being readily and expeditiously opened when required.

"In some cases the hollow base of the implement is provided with a chamber to which the air pipe is connected, said chamber having a transverse or dome shaped partition composed of porous or other appropriate material serving as a separator of the dust or other impurities withdrawn from the carpet or other article. The said partition is provided with a stem extending to the exterior of the chamber for the purpose of enabling said partition to be shaken to remove therefrom dust or other impurities. The inlet from the base portion to the said chamber may be prolonged and furnished with a flap or clack valve.

"One of the impurity collectors may comprise a box or casing provided with a dome shaped porous partition. Beneath this partition is situated a deflecting cap upon which the impure air impinges, and a suitable outlet for the cleansed air is provided on the opposite side or above said partition. In the lower part of the collector there may be placed a series of inclined or other suitably arranged baffle plates for directing the heavier portions of the impurities toward the bottom of the box or casing.

"Another impurity collector comprises a casing containing water or other liquid through which the current of impure air passes. Perforated or reticulated partitions or screens are arranged near the bottom of the casing in such manner as to split up the impure air into fine streams or bubbles as it passes through the liquid. Above the level of the liquid I provide suitable baffle plates to cause the air to flow in a circuitous course and be thereby dried before leaving the collector.

"In order that my invention may be more clearly understood and readily carried into effect I will proceed to describe the same more fully in connection with the accompanying drawings in which :—

"Figure 1 is a plan of the apparatus. Figure 2 is a side elevation of an implement and its connections, partly in section. Figure 3 is an under side view of the implement shown in Figure 2. Figure 4 is a sectional side elevation of a modified form of implement. Figure 5 is an under side view of the implement shown in Figure 4. Figures 6 and 7 are a sectional side elevation and an under side view, respectively, of a further modification of the implement. Figure 8 is a sectional elevation of the implement provided with a dust collecting chamber. Figure 9 is an under side view of the implement shown in Figure 8. Figures 10, 11, and 12 are vertical sectional views of the contrivances for collecting the impurities. The same letters of reference indicate similar parts in the various figures.

"In Figure 1, 1 is the hollow implement provided with a handle 2 and connected by flexible piping to a preliminary dust or impurity collector 3. The dust collector 3 is connected to a second dust collector 4 which communicates with the suction pump 5 actuated by the motor 6 driven by

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"power from a generator or store 7; the dust collector 4, pump 5, motor 6, and generator 7 being carried by a suitable frame or base 8 mounted upon wheels.

5 "In Figures 2 and 3, the implement 1 is provided with a base 9 having an orifice 10 which communicates with the hollow interior of the implement. "The area of the orifice 10 can be adjusted by a plate 11 secured to the base 9 by screws 12 which pass through slots 13 in said plate. To adjust the area of the orifice 10, the screws 12 are loosened, the plate 11 then moved into the required position and the screws 12 tightened. The hollow interior of the implement 1 is connected to the dust collectors and the pump by flexible piping 14. 15 is a rotary valve which is rigidly connected to the handle 2 and is normally held closed by a spring rod 16 connected to the valve lever 17 by a pin and slot connection and retained in its closed position, as shown in the drawing, by a spring 18. To open the valve, the rod 16 is depressed

15 "against the resistance of the spring 18 by a hand lever 16^a. "Referring to Figures 4 and 5 the hollow implement 1 is provided with a curved base 19 an orifice 20 and a handle 21. Between the flexible pipe 14 and the implement, is situated a tube 22 provided with a rotary valve 23. The lever 24 of the valve 23 is connected by a link 25 to one end of a spring 26 the other end of which is fixed to a lug carried by the tube 22. The spring tends to hold the valve 23 closed as shown in the drawing. When the implement is in use the operator grasps the tube 22 and the spring 26, drawing the spring 26 toward the tube 22 into the position shown in dotted line in Figure 4 and thereby opening the valve 23 and putting the implement in communication with the dust collectors and suction pump.

25 "Figure 6 and 7 show an implement having a base 27, a handle 2, and a flexible pipe 14 similar to those shown in Figures 2 and 3. The base 27 is, however, provided with a non-adjustable orifice 28.

"The implement shown in Figures 8 and 9 comprises a hollow dome-shaped chamber 29 having a similar base to that shown in Figures 2 and 3. The orifice 30 of this implement is prolonged and extends some distance within the chamber 29 and is provided with a flap-valve 31. Above the valve 31 is situated a transverse or dome-shaped partition or diaphragm of flexible resilient porous material 32 to filter the air drawn through the orifice 30 and valve 31 so that cleansed air leaves the chamber 29 by the pipe 14. A rod or stem 33 extends through the top of the chamber 29. One end of the stem rests upon or is connected to the partition 32 and the other end of said rod is provided with a suitable push piece 34 situated outside the chamber 29. A spring 35 tends to hold the stem 33 in the position shown in the drawing. By pressing upon the push piece 34 and thereby depressing the stem 33, the partition 32 is also depressed. When the stem 33 is released, it is raised by the spring 35 and the partition 32 springs upwardly thereby shaking any dust or impurity collected on the under side of said partition, to the bottom of the chamber 29.

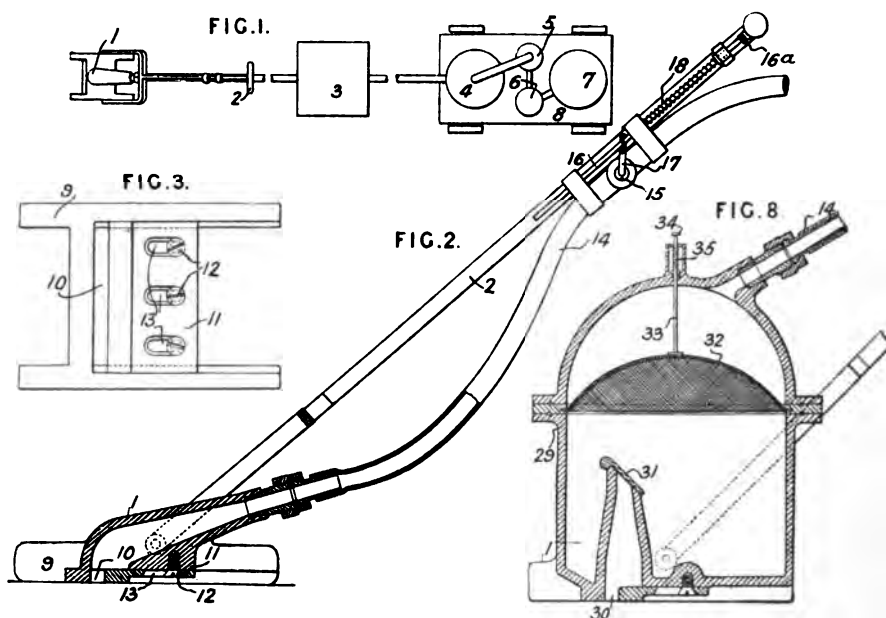
45 "Referring to Figure 10, which is a vertical sectional view of the impurity collector 3, the said collector comprises a box or casing having two parts 36 and 37 provided with flanges bolted together and having a packing ring 38 between them; the two parts 36, 37 being thus hermetically but detachably secured together. There is also situated between the parts 36, 37, a dome-shaped partition 39 of cotton-wool, linen, canvas or similar material made rigid by being faced with perforated or reticulated metal. The partition 39 is held in a groove 40 in the ring 38, so that the parts 36, 37 may be readily disconnected for removing the impurities from the part 37. The pipe 14 enters the part 37 and is prolonged upwardly to a point a short distance below the centre of the partition 39. 41 is a deflecting cap distributing the air drawn

50 "through the pipe 14, and preventing it striking directly against the partition

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" 39. In the lower portion of the part 37 are arranged a series of inclined baffle plates 42 which direct the heavier particles of impurities drawn in through the pipe 14 toward the bottom of the part 37, and prevent said particles from being unduly disturbed by air currents or when the casing is opened for removing the impurities collected therein. Air is drawn from the part 36 through a pipe 42 to the dust collector 4. 5

" Figure 11 is a modification of the impurity collector shown in Figure 10. A dome-shaped porous partition of calico 53 is supported by a coiled spring 54 within the casing 55. The pipe 14 enters the casing 55 below the partition 53, and is provided with a deflecting cap 41 as above described. The casing 55 is provided, below the partition 53, with a hinged door 56 forming an outlet for impurities. The apparatus is provided with pressure gauges 57, 58. Strings 59 10



" are connected to the top of the partition 53, whereby said partition may be drawn down against the resistance of the spring 54 when the door 56 is opened. Upon the release of said strings, the spring 54 will again raise the partition 53 thereby imparting to said partition a shock and shaking dust and impurities from it. Impure air enters the collector through the pipe 14, the impurities are collected by the partition 53, and the cleansed air leaves the casing by the pipe 42. The inlet and outlet pipes in this form of impurity collector are carried by a single casing so as to avoid disconnecting the apparatus from the engine when it is required to open the collector for the removal of impurities or for repairs, or to replace the filtering medium. 15 20

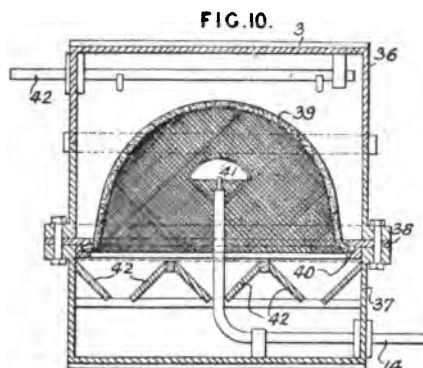
" The partition 39 in Figure 10 and also the partition 53 in Figure 11, is open at the bottom, so that the impurities tend to fall by gravity away from the filtering medium. 25

" Referring to Figure 12, which is a vertical sectional view of the dust collector 4, the pipe 42 enters the bottom of the collector which is partially

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“filled with water or cleansing liquid. 43 is a perforated baffle plate situated immediately above the mouth of the pipe 42, and 44 is a reticulated partition extending across the collector above the baffle plate 43. The baffle plate 43 and partition 44 split up the air drawn into the collector through the pipe 42, into fine bubbles or streams as it passes through the liquid, and so assist in removing impurities therefrom. 45 is a gauge for indicating the level of the liquid in the collector, 46 is the liquid inlet, and 47 is an outlet for liquid and impurities. Within the space above the liquid in the collector 4, are arranged baffle plates 48, 49 and 50, which cause the cleansed air to flow in a circuitous course, and be thereby dried before entering a pipe 51 through perforations 52 and being thence conducted to the pump 5.

“The dust extracting implements shown in Figures 2, 3, 6, 7, 8 and 9 are more particularly adapted for the treatment of carpets and the like, while the implement shown in Figures 4 and 5 is more particularly adapted for the treatment of upholstery.



“The operation of the apparatus is as follows :—The underside of the implement 1 is passed over the surface to be cleansed, the valve 15 or 23 controlling the pipe 14 being opened and the suction pump 5 at work, a current of air and impurities extracted thereby from the article being cleaned is drawn through the orifice of the implement and thence through the pipe 14, and the impurity collectors 3, 4 to the pump 5 from which practically pure air is discharged. If required the valve 15 or 23 may be omitted.

“I find that it is essential to practical success to drive the pump, as above stated, by power, and to maintain a vacuum of at least 5 lbs. per square inch in the filter on the side of the filtering medium where the air and dust enter, when the apparatus is at work, and therefore it is only to extractors working with a considerable vacuum that my claims relate.

“Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim in apparatus for extracting dust from carpets and other materials is :—
 1. The combination of an extracting implement connected with a power driven suction pump, and dust collecting means interposed between the said implement and pump, substantially as and for the purpose specified. 2. In apparatus of the type claimed in the first claim a valve controlling the communication between the extracting implement and the impurity collectors and suction pump, said valve being so arranged that it normally assumes a closed position, substantially as described and for the purpose specified. 3. In

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"apparatus such as is claimed in the first claim a hollow extracting implement
"having a transverse vibratory porous diaphragm, an inlet orifice closed by a
"valve on one side of said diaphragm, and an outlet suction pipe on the other
"side of said diaphragm, substantially as described, for the purpose specified.
"4. In apparatus such as is claimed in the first claim an impurity collector pro- 5
"vided with a dome shaped porous partition having beneath it a deflecting cap
"upon which impure air is discharged, and having an outlet for cleansed air
"above said partition, substantially as described for the purpose specified. 5. In
"apparatus such as is claimed in the first claim an impurity collector containing
"liquid, in which are arranged perforated reticulated partitions for distributing 10
"the impure air, and having baffle plates arranged above the level of said liquid
"to cause the air to flow in a circuitous course before leaving the collector, sub-
"stantially as described for the purpose specified. 6. An impurity extracting
"implement constructed, arranged and adapted to operate substantially as
"described with reference to Figures 2 and 3, or to Figures 4 and 5, or to 15
"Figures 6 and 7, or to Figures 8 and 9 of the accompanying drawings for the
"purpose specified. 7. An impurity collecting implement constructed, arranged
"and adapted to operate substantially as described with reference to Figure 10
"or to Figure 11 or to Figure 12 of the accompanying drawings for the purpose
"specified. 8. Apparatus having its members constructed and arranged to 20
"co-operate substantially as described with reference to the accompanying
"drawings for the purpose specified."

The Patent was assigned to the *British Vacuum Cleaner Company, Ltd.*,
who on the 15th January 1904, brought an action against *Suction Cleaners, Ltd.*,
Lacy Hulbert and Co., Ltd., and *John Sugden* for infringement and claimed 25
the usual relief.

The following Particulars of Breaches were delivered.—“(1) At divers times
"prior to the commencement of this action the Defendants *Lacy Hulbert*
"and *Co., Ltd.*, have infringed the Letters Patent in the Statement of Claim
"mentioned, by manufacturing and by selling and supplying to the Defendants 30
"and the Defendants *Suction Cleaners, Ltd.*, have at divers
"times prior to the commencement of this action infringed the said Letters
"Patent by selling, offering for sale, supplying and using apparatus, machinery
"and mechanism manufactured according to or in manner only colourably
"differing from the invention described in the Specification filed in pursuance 35
"of the said Letters Patent and claimed in the first, fourth, sixth, seventh
"and eighth claiming Clauses thereof. (2) In particular, the Defendants
"and the Defendants *Suction Cleaners, Ltd.*, have exposed for sale and have used at 39 Victoria
"Street, London, S.W., and have by circulars offered for sale and sold on
"divers occasions between their incorporation and the commencement of this 40
"action, apparatus, machines or mechanism manufactured as aforesaid. The
"Defendants *Lacy Hulbert and Co., Ltd.*, manufactured for and sold or
"supplied to the Defendants *Suction Cleaners, Ltd.*, the apparatus, machines
"or mechanism in this paragraph referred to. The Plaintiffs are unable
"until discovery to further particularise the infringements in this paragraph 45
"referred to. (3) The precise numbers, dates and amounts of the Defendants'
"infringements are not at present known to the Plaintiffs, but the Plaintiffs
"will claim to recover from the Defendants full compensation in respect of
"all such infringements. (4) The Defendant *John Sugden* was the promoter
"of and is the manager and secretary of the Defendant Company *Suction* 50
"and *Cleaners, Ltd.*, and as such conducts and controls the business of such
"Company, and has taken an active part in all the infringements on the part
"of the said Company complained of. The said Company's issued Capital, with
"the exception of seven shares held by the signatories of the Memorandum
"of Association, is held by the wife of the Defendant *Sugden* as his nominee 55
"and on his behalf."

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The Defendants *Suction Cleaners, Ltd.*, by their Defence, denied the title of the Plaintiffs to the Patent, and also denied infringement. They further alleged that the Letters Patent were invalid by reason of the matters set out in the following Particulars of Objections:—“(1) The said alleged invention

5 “was not new by reason of—(A) Prior publication of the invention; (B) Prior common general public knowledge of the invention as claimed in all the claiming clauses thereof. Particulars of A are as follows:—(A) The said alleged invention had been published in this realm prior to the date of the said Letters Patent by the deposit in the Patent Office Library of the

10 “Specifications of the following Letters Patent, the whole of each of which is relied upon as anticipating the claiming clauses of the Complete Specification of the said Letters Patent specified hereafter: (a) British—1. *Lake*, No. 676 of 1870, against claims 1, 6 and 8; 2. *Newton*, No. 14,050 of 1884, against claims 1, 6, 7 and 8; 3. *Behrns*, No. 2168 of 1886, against claims 4, 7 and 8;

15 “4. *Nagel, Kaemp and Linnenbrügge*, No. 4729 of 1886, against claims 4, 7 and 8; 5. *Harvey*, No. 546 of 1893, against claims 1, 6 and 8; 6. *Harvey*, No. 4545 of 1894, against claim 1; 7. *Howard and Taite*, No. 2577 of 1896, against claims 1, 4, 6, 7 and 8, and No. 10,271 of 1896, against claims 1, 2, 6 and 8; 8. *Gue and Bonner*, No. 5050 of 1898, against claims 5, 6, 7 and 8; 9. *Shore*, No. 13,298

20 “of 1898, against all claims; 10. *Beth*, No. 14,373 of 1898, against claims 4, 6, 7 and 8; 11. *Wilton*, No. 9350 of 1899, against all claims; 12. *Thurman*, No. 23,144 of 1900, against claims 2, 3, 4, 6, 7 and 8. (b) United States of America—1. *McGaffey*, No. 91,145, dated June 6th 1869, against claims 1, 6, 7 and 8; 2. *Harmon*, No. 260,194, dated June 27th 1882, against claims 1, 4,

25 “6, 7 and 8; 3. *Leaycraft*, No. 279,572, dated June 19th 1883, against claims 1, 5, 6, 7 and 8; 4. *Paine*, No. 328,057, dated October 1st 1885, against claims 1, 5, 6, 7 and 8; 5. *Ethridge*, No. 434,178, dated August 12th 1890, against claims 1, 5, 6, 7 and 8; 6. *Wolfe*, No. 448,900, dated March 24th 1891, against claim 1; 7. *Cummings*, No. 460,935, dated October 6th 1891, against all

30 “claims; 8. *Young and Douglass*, No. 566,554, dated August 25th 1896, against all claims; 9. *Burger*, No. 614,832, of the year 1898, against all claims; 10. *Robkin*, No. 618,908, dated February 7th 1899, against claims 6, 7 and 8; 11. *Westman*, No. 628,505, dated July 11th 1899, against claims 1, 6, 7 and 8.

35 “(2) The said alleged invention as to all the claiming clauses is not the proper subject-matter of Letters Patent. The Defendants will rely hereunder upon the matters set out in paragraph 1 hereof. And will further allege that the combination in claim 1 was a perfectly well-known combination in connection with all kinds of suction appliances in flour machinery, dust-separating machinery, and grain elevating machinery. (3) The said *Hubert Cecil Booth*

40 “was not the first and true inventor of the said alleged invention. (4) The said alleged invention is not useful; apparatus constructed in accordance with figures 8, 10 and 12 will not work. (5) The Complete Specification of the said Letters Patent describes and claims an invention different to and larger than the invention, the nature of which is described in the Provisional

45 “Specification.”

The Defendants *Lacy Hulbert and Co., Ltd.*, also denied infringement and pleaded in addition (1) That they had not manufactured or sold or supplied any apparatus, machinery or mechanism as alleged, or at all, and (2) that they had not manufactured, or sold, or supplied any combination of extracting

50 implements, power-driven suction pump, and dust collecting means, as claimed in the Specification of the Plaintiffs' Letters Patent, or at all.

The Defendant *Sugden*, after denying infringement, pleaded that he was not a shareholder in or director of the Defendant Company *Suction Cleaners, Ltd.*, but only the secretary, and had no other interest therein, or connection

55 therewith. He also denied that his wife held any shares in the Company as his nominee, or on his behalf, and submitted that he had been improperly

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joined. Lastly, he alleged the invalidity of the Plaintiffs' Patent, relying upon the Particulars of Objections delivered by *Suction Cleaners, Ltd.*, as above-stated.

Moulton, K.C., Terrell, K.C., Colefax, and H. F. Moulton (instructed by *Hasties*), appeared for the Plaintiffs; *Bousfield, K.C.*, and *Walter* (instructed by *Stanley, Woodhouse and Hedderwick*), for the Defendants *Suction Cleaners Ltd.*, and *Sugden, and Upjohn, K.C.*, and *Walter* (instructed by *Stanley, Woodhouse and Hedderwick*), for the Defendants *Lacy Hulbert and Co. Ltd.*

Moulton, K.C.—This is an invention which has already given rise to a new and important industry. The three elements of novelty are: (1) A tight joint on the carpet; (2) a small orifice to the cleaning instrument, and (3) a considerable vacuum. This last is not to be found in any of the anticipations, for they do not use instruments which would give it; in general they use nothing stronger than a fan, while we have a power-driven pump.

The evidence of *Dugald Clerk* showed that the invention described in the Plaintiffs' Specification consisted of three things—a dust extracting implement constructed to work efficiently with a high vacuum, a suitable filter, and a power-driven pump, and the main point of the invention was the combination of the three. The object of the invention was to remove dust from the inside of and from underneath carpets and furniture. He also stated that he had made models as suggested by several of the alleged anticipating Specifications, those of *Lake, Howard and Taite, Wilton, Cummings and Burger*, and had found that they would not do the same work as the Plaintiffs' invention. Thus *Wilton's* invention acted by stirring the dust from the surface of the carpet by means of a brush and then sucking it off by a fan, and *Burger's* would not work because the orifice was too great, so that it was not possible to move the implement on the carpet. *C. V. Boys* gave evidence of a similar kind. *C. F. Hitchins*, the managing director of the Plaintiffs, gave figures showing the financial success of the Company. *Walter Carr*, of the carriage department of the London and North Western Railway Company, stated that they had tried the *Taite-Howard* system for cleaning their carriages and abandoned it in favour of the Plaintiffs' system. *M. A. Adams* said he had seen the machine used by the Defendants *Suction Cleaners, Ltd.*, at the works of the *Patent Steam Carpet Beating Company, Ltd.*, and it bore the name of the Defendants *Lacy Hulbert and Company, Ltd.* *Lacy Hulbert* gave evidence as to the work done by the Defendants *Lacy Hulbert and Co., Ltd.*, for the Defendants *Suction Cleaners, Ltd.* The working of the Plaintiffs' implement was also demonstrated to the learned Judge by a practical experiment.

Terrell, K.C., summed up the Plaintiffs' case.—The first claim is limited to dust collection by means of the combination of: (1) A suction-pump driven by power; (2) a filter, which must be interposed between the extractor and the pump; and (3) a dust extracting implement. If the Defendants' instrument is effective it must work with a considerable vacuum and be the same as ours. The reason why none of the previous inventions will work is that they do not cause the air to rush through the carpet at high velocity, as ours does. The only ground on which the first claim can be attacked is on the ground that it is a wide claim for a narrow combination.

Bousfield, K.C., opened the case for the Defendants *Suction Cleaners*.—The Plaintiffs' case as now put is merely one of supporting a Patent on a question of degree, and this has never been done by the Courts. The case which went nearest to it was that of *Lyon v. Goddard* (10 R.P.C., 121, 334, 11 R.P.C., 113), and in that case there was a discovery of an important scientific principle, viz.—that by the use of super-heated steam articles could be disinfected without damaging them by burning or wetting. The idea of the considerable vacuum and of the power-driven pump are not to be found in the

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Provisional Specification. The only thing the inventor in this case has done is to use greater power to give greater vacuum, and that is not an invention, unless there was some new principle discovered. There might no doubt be some invention in the details, but we have not imitated any of the details described in the Plaintiffs' Specification. Thus we have no tight joint on the carpet in our implement, at least two-thirds of the air which in this comes over the surface of the carpet. The only distinction between the Plaintiffs' Specification and *Cummings'* is the tight joint.

For the Defendants Professor *J. D. Cormack*, of University College, London, said there was no invention described in the Plaintiffs' Specification. There was no novelty in the narrow orifices, which were to be found in *Howard and Taite's* and *Lake's* Specifications. *Cumming's* Specification showed that he understood the distinction between making dust rush through the carpet and collecting it from the surface, and *Burger's* implement was of the same type. Several of these inventions would work. The Defendants' implement, unlike that of the Plaintiffs', was not constructed to work with a considerable vacuum inside it; it operated like that of *Howard and Taite*, but probably with a somewhat greater scraping effect. The order of the three parts of the Defendants' combination was the natural one, and there was no invention in putting them in that order. A grain-lifting apparatus could easily be adapted to do such work as was done by the Plaintiffs' apparatus. The combination of an extracting implement, a filter and a pump was to be found in *Leaycraft's* Specification. *W. G. Walker* said that a considerable vacuum could be obtained with a rotary fan.

At the conclusion of the evidence for the Defendants it was agreed that there was no case against *Lacy Hulbert & Co.*, and the action was dismissed against them, with costs.

Waller summed up the Defendants' case.—There was nothing new in the use of suction to raise matter through a pipe, even by a power-pump. Power fans were known and used for the purpose of producing suction, which might be increased by a combination of fans. Nor was there anything new in the use of a suction device for removing dust from carpets, or in the combination of a suction device with an extracting instrument. These combinations, to the extent of their power, did remove dust by a current of air. The problem of removing more dust is solved by using more power. If the invention is said to lie in anything but the use of particular forms of appliance, then there is no invention. *Howard and Taite's* invention was worked, and is more like the Plaintiffs' implement than that which is used by the Defendants. *Cummings'* invention also removes dust, though not so much as the Plaintiffs' invention. If the Defendants' combination is within the first claim of the Plaintiffs, then the Patent is bad. He cited *Bradford Dyers' Association, Ltd. v. Bury* (18 R.P.C. 161, 19 R.P.C. 1).

Moulton, K.C., replied.—If *Howard and Taite* did the same thing as the Plaintiffs, they did it in a different way. This is plainly subject-matter for a Patent, for even a mere alteration of scale is sometimes good subject-matter, as is shown by *Lyon v. Goddard*. [FARWELL, J.—But the only thing patented in that case was the instrument.] The real issue in this case is whether there was any infringement. The rugosities on the Defendants' instrument are just the thing to make a tight joint. *Murray v. Clayton* (L.R. 7 Ch. 570) shows that invention sometimes begins when you make a thing cheaper. As regards *Sugden*, he acts for the Defendants *Suction Cleaners, Ltd.* [FARWELL, J.—There is no evidence against him before me. What has he done that constitutes infringement?]

FARWELL, J.—I have come to a conclusion, and I do not think it will serve any useful purpose for me to reserve judgment, because I have the case so fully in my mind after all these days that I think I can deal with it more satisfactorily now than if I waited until after the Vacation. The Plaintiffs' case depends,

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as usual, on the construction of the Specification, and I have come to the conclusion that he has invented a new and most useful process (which I think is the proper word to use), by which dust can be effectively extracted from carpets in a way which it never could before. I think there is great force in Mr. Moulton's observation that, although utility and novelty are two distinct things, 5 still the fact of utility, when it takes the shape of a sudden and great success for a newly produced article, is some evidence of the novelty of the means or process by which that so useful article was produced. If it had not required invention of a sort, it might be well said that the world would long before have discovered what it then found it wanted so much. Looked at from that point 10 of view, I think the Court ought to regard the Specification, when it does result in so useful a production, with as favourable an eye as is consistent with fairness.

Down to the date of this Patent, there had been many suggestions and many Patents for attempting the cleaning of carpets, and in some cases the extraction of dust from carpets by way of cleaning, but in no case had there been any 15 successful operation—successful, that is to say, in the real sense of success, in which the Plaintiffs have succeeded. The shortcoming, I think, was discovered by the Patentee, when he says: "You have not sufficient power to make a "sufficient vacuum, and the result is that you cannot make or maintain a vacuum "sufficient to clean your carpet." The process that he suggests, and which, to my 20 mind, he has fairly expressed in his Specification, is not a general statement of a combination of extractor, dust-collector, and pump at large, because in the first place that would not work for want of further directions, and in the second place it certainly would have been anticipated by other people who said the same. It is not enough to say that, unless you say something 25 more, and show how it is to be done. Reading the Specification fairly, I think that the Patentee does show how it is to be done. Reading his Drawings with his Specification, it is to be done by means of an implement which sits tightly upon the carpet so that there is a practical similarity of vacuum both at the instrument end and at the filter end. I think that is the 30 only explanation of lines 27 to 30 on page 6 of the Specification.* I think it shows there that the Patentee had in his mind the necessity of keeping his vacuum fairly at both ends. The whole point of it is, as is stated there, that it is essential to practical success to drive the pump by power and to maintain a vacuum of at least 5lb. per square inch at the filter. That appears to me to 35 be a perfectly good process and well and sufficiently stated, and I do not feel myself at liberty, with regard to an invention or process of this sort, to tie down the inventor to the particular Figures which are set forth in these Drawings. If he were tied to these Drawings, as to which I had some little hesitation at first, it is probable that the Defendants might be able to say 40 then with success that they did not infringe. But I confess I am not favourably impressed by the Defendants, because they appear to me to have tried to evade the Plaintiffs' Specification and Patent by making a worse instrument, rather taking the Plaintiff's implement and spoiling it so far as they could, so as to keep some success, and be able to say they did not 45 infringe. They have left out the runners, so that they have not any weight to assist them in maintaining their close fitting to the carpet. I am convinced on the result of the evidence that such success as the Defendants do attain is entirely due to their using the process which the Patentee has invented and expounded in his Specification. The evidence that Mr. Moulton referred to 50 just now shows that the Defendants in practice usually work their appliance with from 10 to 15 inches of mercury vacuum in the pipe. That is, in effect, what the Patentee has pointed out to be necessary to success. It has

* *Ante*, page 307, lines 23 to 27.

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been suggested that the experiment showed that there was not that vacuum kept up in the instrument. I do not think myself that the experiment showed that that would be satisfactory, because it would only show that the instrument in the way that it was then worked was not working as well as it could be made
 5 to work. If the instrument were held, having regard to its configuration, in a skilful manner, I have no doubt that it could be made to work so as to get the full benefits pointed out by the Plaintiffs' Specification. I do not think I do the Defendants injustice by holding that they are speaking the truth when they describe their system in the mode in which they have done in a document
 10 which has been put in evidence. They certainly do there claim the full benefit of all that the Patentee does, and, so far as I can see, avowedly say they take the benefit of the Plaintiffs' process.

The result is, in my opinion, that the Plaintiffs' Patent is perfectly good. I am rather glad to be able to see my way clear to hold that it is good—
 15 although I have had some little doubt about it—because I think it is a most useful invention. I think also that the Defendants have infringed. Consequently the usual relief will be granted, that is, there will be an injunction. Do the Plaintiffs ask for delivery up?

Moulton, K.C.—Yes, and for damages.

20 *FARWELL, J.*—Very well, an inquiry as to damages.

Walter.—There is only one instrument which has been made, and the Defendants cannot deliver it up, because it is not in their possession.

Moulton, K.C.—We will take judgment in the complete form; but if it is a trifling thing of that kind we shall not carry out the inquiry.

25 *FARWELL, J.*—Of course if you carry out the inquiry you do so at your own risk as to costs. I only order the thing which I have seen in Court to be delivered up—the thing that pushes backwards and forwards.

Moulton, K.C.—I ask for a certificate that the validity of the Patent came into the question, and that the Particulars of the Breaches are proved.

30 *FARWELL, J.*—Yes. Then as regards Mr. *Sugden*, I must dismiss the action with costs. There is no case against him, and I cannot see that there was any justification for joining him.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE FARWELL.

March 3rd and 7th, 1904.

S. T. MIDGLEY AND SONS, LD. v. MORRIS AND COWDERY.

Passing off.—Use by Plaintiffs and Defendants of same catch-phrase in 5
advertisements.—The Plaintiffs not the first users of the phrase as alleged.
—Action dismissed.

A firm of boot manufacturers alleged that they had invented and used as their Trade Mark the phrase, "Fair wear or a free pair," and they commenced an action against a firm of retailers of boots and shoes, complaining of the use by 10
the Defendants of the same phrase in connection with the sale of boots and shoes, and claiming an injunction against its use and against the Defendants representing their business to be connected with the Plaintiffs' business.

Held, that the evidence established user of the phrase prior to the Plaintiffs' user by other persons. The action was dismissed with costs. 15

A. W. Midgley (trading as S. T. Midgley & Sons) and S. T. Midgley & Sons, Ltd., commenced an action against Morris & Cowdery, claiming (1) an injunction to restrain the Defendants and their servants and agents from infringing the Plaintiffs' Trade Mark and from using the words "Fair wear or a free pair" in connection with the sale of any goods not being goods of the Plaintiffs' manu- 20
facture or of the manufacture of one of them, and from in any way passing off any goods not of the Plaintiffs' manufacture as being goods manufactured by the Plaintiffs or either of them, and from representing that the business carried on by them at Newport, in the Isle of Wight, was in any way connected with the Plaintiffs' business; (2) damages; and (3) costs. 25

The Plaintiffs, by their Statement of Claim, alleged (*inter alia*):—(1) That the first above-named Plaintiff's firm was an old-established firm of boot manufacturers, at the date of the writ carrying on business at Crown Works, Leeds, and they had, for a period of upwards of sixteen years prior to the 2nd day of December 1903, adopted and used as their Trade Mark the phrase: 30
"Fair wear or a free pair"; that their goods had been widely advertised by the said Plaintiff, and very extensively sold by large numbers of retail dealers in all parts of the realm under the said mark, and the phrase had so become widely known in trade and to the general public as indicating goods of the Plaintiffs' manufacture. [The paragraph then alleged the incorporation of 35
the Plaintiff Company, and that, in effect, it was the successor in business of S. T. Midgley & Sons.] (2) That the Defendants were retailers of boots and shoes at Newport, in the Isle of Wight, and had recently adopted upon their business cards and other documents, and in connection with their business,

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- and had exhibited prominently upon their shop-front the said mark—"Fair wear or a free pair," thereby inducing their customers and the public generally to suppose contrary to the fact that boots and shoes of the Plaintiffs' manufacture were offered for sale by the Defendants, and that there was a connection between the Defendants' business and the Plaintiffs', but that the Defendants had in fact refused to buy and sell the Plaintiffs' goods, and had sold the goods of other manufacturers as and for the goods of the Plaintiffs' manufacture by means of the said mark so used as aforesaid, and had thereby injured the Plaintiffs' trade, and unless restrained by Order they would continue to do so. (3) That the Defendants, in addition to using the Plaintiffs' Trade Mark as aforesaid, had, as thereafter particularly stated, copied the phraseology of the Plaintiffs' advertisements, thereby increasing the resemblance of the Defendants' advertisements to those of the Plaintiffs', and making it more difficult for the Plaintiffs' customers and the public generally to distinguish the Defendants' place of business from a place where goods of the Plaintiffs' manufacture were retailed, that is to say, the Defendants had caused to be conspicuously painted across the front of the house in which their business is carried on the words, "What the public want; fair wear or a free pair," and they caused to be inserted in the Isle of Wight County Press and South of England Reporter, of the 22nd March 1902, an advertisement, containing the following words: "What the public want; sound boots at cheap prices; fair wear or a free pair." That they also issued during the months of April, May and June 1902, business cards, containing an announcement of the commencement of their business, at the foot of which cards were printed the words, "What the public want; fair wear or a free pair"; that the phrase, "What the public want," was imitated from the Plaintiffs' advertisements, which had been extensively circulated during the early months of the year 1902, in the following form: "Just what the public want; fair wear or a free pair; Boots and Shoes."
- The Defendants by their Defence alleged (*inter alia*):—(1) That save and except that the first above-named Plaintiff's firm was and that the second above-named Plaintiffs' firm is a firm of boot manufacturers carrying on business at Leeds and that the Plaintiffs, *S. T. Midgley & Son, Ld.*, were a Company incorporated under the provisions of the Companies' Act with a registered office at Leeds as alleged, the Defendants denied each and every allegation in paragraph 1 of the re-amended Statement of Claim; that the phrase "fair wear or a free pair" was not a Trade Mark registered or certified under the Patents Act (46 & 47 Vict., c. 57 & 51, and 51 & 52 Vict., c. 50); that this said phrase was not a Trade Mark and was not the Trade Mark of the Plaintiffs or either of them; that if the Plaintiffs had used the said phrase as descriptive of their or his goods (which the Defendants denied) the said phrase had not acquired a secondary meaning denoting goods of the Plaintiffs' manufacture or of the manufacture of one of them, and the Defendants would contend that the Plaintiff *Arthur Walter Midgley* had not and that the Plaintiff Company had not the right to the exclusive use of the said phrase. (2) That the Defendants admitted that they were retailers of boots and shoes at Newport in the Isle of Wight; they denied that they had used or adopted or exhibited the said phrase as a mark as alleged in paragraph 2 of the re-amended Statement of Claim; that if and so far as the Defendants had used the said words either alone or in conjunction with other words (which the Defendants did not admit) they had used them in the ordinary course of their business as words purely descriptive and in common use to express to their customers the terms upon which their business was conducted and to make an offer with regard to the exchange in certain circumstances of goods purchased from them; that the Defendants had not used the said words as being; in any way their Trade Mark or as specially distinctive of goods sold by them; the said words, if and so far as they had been used by the Defendants,

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did not imply and could not be understood to imply that the goods sold by the Defendants were of the Plaintiffs' or of any particular manufacture; the Defendants denied that they had induced and would contend that the use of the said words was not calculated to induce their customers and the public to suppose that boots and shoes of the Plaintiffs' manufacture were offered for sale by the Defendants or that there was a connection between the Plaintiffs' business and that of the Defendants; they denied that they had sold the goods of other manufacturers as and for the Plaintiffs' goods as alleged; they denied that they had committed the acts or any of the acts complained of in the said paragraph or that the said acts or any of them were wrongful as alleged; and they denied the alleged injury to the Plaintiffs' trade. (3) The Defendants did not admit any of the allegations contained in paragraph 3 of the re-amended Statement of Claim; they denied that they had copied the phraseology of the Plaintiffs' advertisements as alleged; they denied that the Defendants' advertisements made or were calculated to make it difficult for the Plaintiffs' customers to distinguish the business as alleged in the said paragraph; the Defendants' advertisements were different from those of the Plaintiffs; the Defendants denied that they had imitated the phrase "what the public want" from the Plaintiffs' advertisement; the said phrase either alone or with the words "fair wear or a free pair" was not distinctive of the Plaintiffs' goods; (4) the Defendants denied the alleged or any damage; the Defendants would contend that the re-amended Statement of Claim disclosed no cause of action and that the Plaintiffs were not entitled to the relief prayed for. (5) Save as above expressly admitted the Defendants denied each and every allegation contained in the re-amended Statement of Claim and in the particulars delivered by the Plaintiffs."

The action was tried on the 3rd and 7th of March 1904.

Bousfield, K.C., and *J. W. Gordon* (instructed by *Hamlin, Grammer, and Hamlin*, agents for *H. R. Cousins*, of Leeds) appeared for the Plaintiffs. *S. Bevan* (instructed by *Sole, Turner, and Knight*, agents for *H. R. Hooper*, of Newport, Isle of Wight), appeared for the Defendants.

The Plaintiffs' case was opened by *Bousfield*, K.C., and after the Plaintiffs' evidence had been heard *Gordon* summed up the Plaintiffs' case, referring to *Chivers and Son v. Chivers and Co., Ltd.* (17 R.P.C. 420), *Montgomery v. Thompson* (8 R.P.C., 361), *Reddaway v. Banham* (13 R.P.C. 218), and *Cellular Clothing Company v. Maxton and Murray* (16 R.P.C. 897).

Bevan opened the Defendants' case and proceeded to call evidence on their behalf.

Before the Defendants' case was finally closed, *FARWELL, J.*, intimated that he had heard enough, and was satisfied that the evidence established user of the phrase by the Defendants before the date when the Plaintiffs claimed to have invented it. He dismissed the action with costs.

Parozone Company, Ltd. v. Johnston Gibson.

IN THE COURT OF SESSION IN SCOTLAND.

Before the LORD ORDINARY (LOW).

March 13th and 26th, and May 19th, 1903, February 5th and 26th, 1904.

PAROZONE COMPANY, LD. v. JOHNSTON GIBSON.

- 5 *Trade name.*—"Parozone."—*Name of bleaching fluid.*—*Admission by Respondent of Complainers' exclusive title.*—*Failure of Respondent to prove inadvertence in use.*—*Interdict granted.*—*Evidence.*—*Specification of instances of wrongful use of name.*—*Evidence not limited to such specification.*

- The P. Co. invented and applied the name "Parozone" to a bleaching fluid made by them, and it was admitted that they were entitled to the exclusive use of that name as indicating fluid manufactured by them only. G., a small trader, also made a bleaching fluid, but said that he never sold it as "Parozone," and when asked for "Parozone" explained that his fluid was not "Parozone." The P. Co. proved that on five occasions, to two persons, G. or his servants sold his fluid in answer to a request for "Parozone," and without explanation. They further proved that G. pointed out to two former shopgirls the jar where he kept his "Parozone," and that it was a matter of daily occurrence for G.'s fluid to be sold to customers who asked for "Parozone," without explanation. G. proved that on some occasions he had explained that his bleach was not "Parozone."*
- 15 *Held, by the LORD ORDINARY that the P. Co. were entitled to interdict.*

- In the Record the P. Co. specified two individuals to whom G. had sold his bleach as "Parozone." G., in defence, stated that while he might by inadvertence have failed in one or two instances, yet his "invariable answer" to persons asking for "Parozone" was that "he had a bleaching fluid of his own manufacture which he was able to supply to them." Held, by the LORD ORDINARY, that while the P. Co. must prove their specific instances, they were entitled, without specification, to prove other instances as an answer to this defence.*
- 25

- The Complainers in this case were the Parozone Co., Ltd., having their registered office at No. 11, Bothwell Street, Glasgow, and the Respondent was Johnston Gibson, carrying on business at Gibson's Townhead Emporium, 116, Taylor Street, Glasgow.*
- 30

- The action was one of suspension and interdict brought to restrain Gibson from selling as "Parazone" any bleaching fluid not manufactured by the Complainers. The Complainers are manufacturers and sellers of a bleaching fluid to which they gave the name of "Parozone." Before the formation of the said limited company the fluid, or a similar fluid, was manufactured and sold by*
- 35

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James Pattison & Company, Glasgow, who invented, selected, and used the name "Parozone" as a distinctive name for it. The Complainers, at the time of the formation of the Company, acquired the rights of *James Pattison & Company*. Since the introduction of this manufacture into the market, the Complainers averred that "Parozone" had become well known to the public, and had a considerable sale. The name "Parozone" was, they said, exclusively identified with the Complainers and their authors, and with their manufacture. Further, the bleaching fluid made and sold by the Complainers was marked with the name "Parozone," and they were registered proprietors of a Trade Mark No. 72,496, dated 4th May 1898, on which the name "Parozone" prominently figured. At the date of registration the word "Parozone" was used by the Complainers exclusively, and was a special and distinctive word. This bleaching fluid, however, manufactured by the Complainers was not a patented article, and there were numerous bleaching fluids manufactured and sold, some of which might happen to be of the same composition.

The Complainers averred that they had recently ascertained that for some time past the Respondent had been in the habit of selling at his shop, No. 116 Taylor Street, Glasgow, in response to orders by customers for "Parozone" or "Parozone bleach," a bleaching fluid or fluid not manufactured or supplied by the Complainers or their agents. In particular, on the 23rd of January 1903, the Respondent sold to Mrs. M'Coombe, in response to a request for "Parozone," a fluid not made or supplied by the Complainers or their agents. Further, the Respondent on the 20th and 30th of January 1903, sold to Mrs. Wood, 35 Harlaw Street Glasgow, in response to a request for "Parozone," a fluid not made or supplied by the Complainers or their agents. This fluid sold by the Respondent was of a quality inferior to "Parozone," containing much less chlorine, and the Complainers were prejudiced by its sale as "Parozone."

The Respondent denied this, and stated that he was in the habit of retailing a bleaching fluid of his own manufacture. He sold this at $\frac{1}{2}$ d. per gill, the retail price of "Parozone" being 1d. per gill. He did not keep "Parozone" bleach, and had no jars, carboys, or labelled bottles supplied by the Complainers or marked with the word "Parozone" in his premises. He disclaimed any intention of representing his bleaching fluid to be "Parozone" manufactured by the Complainers, and did not claim any right to the use of the word "Parozone" to describe the fluid manufactured by him. He also averred that the Respondent has never sold or been in the habit of selling bleaching fluid not manufactured or supplied by the Complainers to customers in response to orders for 'Parozone' or 'Parozone bleach.' Customers occasionally ask for 'Parozone' at the shop kept by the Respondent. His invariable answer to such customers is that he does not keep 'Parozone' or 'Parozone bleach,' but that he has a bleaching fluid of his own manufacture which he is able to supply to them. If his bleach was sold as 'Parozone' in the cases condescended on, it was done inadvertently."

The Complainers sought that the Respondent should be interdicted "from exposing or offering for sale, and from selling as 'Parozone' or 'Parozone bleach,' either by himself or through his assistants, any bleach or bleaching fluid not made or supplied by the Complainers or their agents, and from representing in any way that any bleach or bleaching fluid not manufactured by the Complainers is of the Complainers' manufacture, and from in any way infringing the sole and exclusive right of the Complainers to use the name of 'Parozone.'" They also asked for interim interdict. The Complainers pleaded.—(1) The word 'Parozone' being exclusively used by the public, including the Respondent's customers, to describe the bleaching fluid manufactured and supplied by the Complainers, and the Respondent having offered and sold as 'Parozone' a bleaching fluid not manufactured or supplied by the Complainers or their agents, the Complainers are entitled to interdict as craved. (2) The Complainers having the sole right to the use of the

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“name ‘Parozone,’ to designate the bleaching fluid manufactured by them, and
 “the Respondent having offered and sold as ‘Parozone’ a bleaching fluid not
 “manufactured or supplied by the Complainers or their agents, the
 “Complainers are entitled to interdict as craved. (3) The defences are
 5 “irrelevant.”

The Respondent pleaded.—“(1) The Complainers’ averments are irrelevant
 “and insufficient to support the prayer of the Note. (2) The Respondent not
 “having offered and sold as ‘Parozone’ a bleaching fluid not manufactured or
 “supplied by the Complainers or their agents, the Note should be refused, with
 10 “expenses. (3) The Complainers’ averments, so far as material, being
 “unfounded in fact, the Note should be refused.”

On the 13th of March 1903, Lord PEARSON Lord Ordinary on the Bills granted
 interim interdict; on the 26th of March he passed the Note from the Bill Chamber
 to the Court of Session, and on the 19th of May Lord LOW closed the Record.
 15 Proof was taken on the 5th of February 1904. In the Complainers’ proof the sales,
 condescended on in the Record were proved.

Clyde, K.C., and Moncrieff (instructed by *Elder and Aikman, W.S.*), for the
 Complainers, led evidence that there had been a long course of infringement of
 the Complainers’ rights prior to the acts specified in the Record.

20 *McLennan* (instructed by *J. Murray Lawson, S.S.C.*), for the Respondent,
 objected to this line of examination. Particulars of the acts of infringement to
 be proved should have been given on record. He had had no warning of this
 line of proof, and could not be prepared to meet it. He cited *Humphries v.*
Taylor Drug Co. (5 R.P.C. 687; L.R. 39 C.D. 693).

25 *Clyde, K.C.*, replied that he was not attempting to prove specific instances on
 which to found, but to prove the regular practice of the Respondent, so as to
 meet his Defence, that he never supplied his bleach as “Parozone,” and that, if
 so sold in the cases founded on, it was sold inadvertently.

The objection was repelled.

30 From the Respondent’s proof it appeared that, in some instances, when asked
 for “Parozone,” he said he did not keep it, but the Complainers proved, both by
 the evidence of customers and by that of his own shopwomen, that in others
 he had supplied his own bleach in answer to inquiry for “Parozone.” The
 facts brought out in proof are indicated in the LORD ORDINARY’S opinion (*infra*).

35 *Clyde, K.C., and Moncrieff*: This is a pure question of fact, viz., whether the
 Respondent had sold his bleach as “Parozone.” In the instances mentioned on
 record this was proved to have been done. It would be objected that it was
 proved by “detective” evidence, the evidence of employés of the Complainers’
 sent out to make test purchases. But this case was different from the cases
 40 where such evidence was held insufficient—*Bass, Ratcliff & Gretton, Ltd. v.*
Laidlaw (13 R. 898); *Thomson & Co. v. Robertson* (15 R. 880); *Thomson & Co.*
v. Dailly (24 R. 1173). In these cases there were only a few petty instances of
 the wrong use of a dealer’s name, while here there was a long-continued practice
 of wrongful use. This was proved by the evidence of the Respondent’s employés
 45 and customers. In most similar cases it had been set up in Defence that the
 Respondents had given instructions to their employés not to sell their goods as
 the Complainers’, and that these instructions had been disobeyed. Here this
 was certainly not done, at least during the long period prior to the end of 1902,
 during which the wrongful sales were taking place, nor were customers warned
 50 that they were not getting the Complainers’ “Parozone” prior to that date,
 though after the end of 1902, when it was known that this action was imminent,
 some were warned.

McLennan.—If sales had taken place they were simply due to inadvertence.
 The element of deceit was necessary in every case of this kind. Here there had
 55 been no intention to deceive, nor had customers been deceived. The name
 “Parozone” is a word in familiar use with a certain part of the public, and
 people ask for “Parozone” as a convenient term for bleaching fluid, without

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having in their mind that of any particular maker. This makes an inadvertent omission to warn them that they are not getting the Complainers' article occasionally probable. Such information might have been given to customers at the time their connection with the Respondent began and have faded from their memory. It would be sufficient to warn the customers when they first 5 asked for "Parozone" (*Thomson & Co. v. Robertson, ubi supra*). Warning was certainly given to some customers. The Respondent concedes the right of the Complainers to the exclusive use of the word "Parozone"; this disclaimer is sufficient. There was no attempt at defiance after notice had been given by the Complainers that they objected to the conduct of the Respondent. No 10 case is made here of Respondent having been an agent of the Complainers who had given up his agency; therefore warning to servants is unnecessary; that only requires to be given on giving up an agency (*Montgomerie v. Young Brothers* 20 R.P.C. 791). The specific instances libelled were cases of attempted detective evidence. The object of the witnesses in asking for 15 "Parozone" was not to conclude an ordinary trade transaction, but was to get as "Parozone" what was not "Parozone." Their evidence is therefore to be taken *cum notâ*. Certainly they were not deceived as to what they were getting. Nor is it proved that the public in general were deceived. But deceit must be proved—*Stuart & Co. v. Scottish Val de Travers Paving Co., Ltd.*, 20 (13 R. 1). See also the Judgment of the *Sheriff of Lanark* reported in a note to this case and the cases cited there, and *Singer v. Loog* (L.R. 8 App. Cas. 15). Here there had only been a few cases of sale by inadvertence, as in *Bass v. Laidlaw* and *Thomson & Co. v. Robertson, ubi supra*, where an interdict was refused. This case was similar to *Montgomerie v. Young Brothers (ubi supra)*, 25 where an interdict was refused by the Second Division. It was necessary for the Complainers to prove a habit of wrongful dealing. They had not succeeded in making this out.

His Lordship made *avizandum*; and on the 26th of February 1904 issued the following Opinion :—

Lord Low.—It is not disputed that the bleaching fluid made and sold by the Complainers is known as "Parozone," and that they have the sole right to use that name. The Respondent does not keep "Parozone," but he makes a bleaching fluid of his own, and he denies that he has ever sold that fluid as "Parozone." 30

It has been proved that the persons specified in the Record—Mrs. Wood and 35 Mrs. *M'Coombe*—went several times to the Respondent's shop, and in reply to a request for "Parozone" were supplied with bleach made by the Respondent without any explanation being given that it was not "Parozone." Mrs. Wood went to the shop four times, and upon two of these occasions she was served by the Respondent himself, upon the two other occasions she was served by a 40 girl, apparently the Respondent's daughter. Mrs. *M'Coombe* was once at the shop, and was served by the Respondent. I may say that, although neither Mrs. Wood nor Mrs. *M'Coombe* actually identified the Respondent as the person who served them, it is not suggested that any other man than the Respondent ever served customers in the shop. 45

The Respondent said in his evidence that he did not believe that he had ever sold his bleach in answer to a request by Mrs. Wood or Mrs. *M'Coombe*, or anyone else, for "Parozone," without explaining that it was not "Parozone," although he may possibly have done so inadvertently if other customers were waiting. He further said that the statement made in his answers to the effect 50 that it is his invariable custom, if anyone asks for "Parozone," to explain that he does not keep "Parozone" but has a bleach of his own manufacture, is true.

To meet that statement the Complainers adduced, in the first place, the evidence of Mrs. *Peacock* and Miss *Clark*, who had been in the Respondent's service as shopgirls. Mrs. *Peacock* says that when she entered the Respondent's 55 service he shewed her the jar in which his bleach was kept, and said that that was the "Parozone"; that it was a matter of daily occurrence for the

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Respondent's bleach to be sold to customers who asked for "Parozone"; that these sales were made sometimes by her and sometimes by the Respondent; and that she never gave, or heard any explanation given to the effect that the article sold was not in fact "Parozone." Miss *Clark* also says that, during the

- 5 eight months which she served the Respondent, it was a daily practice to sell the Respondent's bleach as "Parozone" without any explanation. Further, the Complainers brought several witnesses who had repeatedly, in answer to a request for "Parozone," been supplied by the Respondent with a bleaching fluid, which they understood to be "Parozone," without any explanation.
- 10 On the other hand the Respondent adduced two witnesses—Mrs. *Rogers* and Mrs. *Haggerty*—who said that they went to his shop and asked for "Parozone" and were told by him that he did not keep "Parozone," but made a bleach of his own. Further, the witness *Phillips* says that he was frequently in the Respondent's shop and heard him upon several occasions explain to
- 15 customers, who asked for "Parozone," that he did not keep it. It was pointed out that these witnesses speak to a period subsequent to a date when the Complainers' traveller, *Maloney*, cautioned the Respondent not to sell his own bleach as "Parozone." I think that the more natural explanation is that the Respondent could only remember cases which occurred recently, and, therefore,
- 20 I think that I must regard it as being proved that the Respondent did sometimes tell customers that he did not keep "Parozone." I have further, no reason to doubt that the witnesses whom he was able to find did not represent all the persons to whom he had made such an explanation. Still, looking to the evidence led by the Complainers, and especially that of Mrs. *Peacock* and Miss
- 25 *Clark*, I cannot come to any other conclusion than that the Respondent's practice was to sell his own bleach in answer to a request for "Parozone," without any explanation, and that to give an explanation was an exception to the general rule.

- The question is whether in these circumstances the Complainers are entitled to interdict. It was argued for the Respondent that the only evidence upon
- 30 which the Complainers could found, or which it was competent for them to lead, was that of Mrs. *Wood* and Mrs. *McCoombe*, because the occasions upon which bleach was said to have been sold to them were the only instances of which notice was given on Record, and that as these witnesses admittedly went
- 35 to the shop in a detective capacity their evidence was not of a reliable character. I agree that it was necessary for the Complainers to prove that the Respondent sold his bleach to Mrs. *Wood* and Mrs. *McCoombe* as "Parozone," and that he did so in such circumstances as to justify the inference that it was his practice to do so, but I also think that the other evidence led by the Complainers was competent
- 40 for the purpose of meeting the Respondent's averment that his "invariable answer" to customers asking for "Parozone," was "that he had a bleaching fluid of his own manufacture which he was able to supply to them." In the first place I have no doubt of the honesty and accuracy of the evidence of Mrs. *Wood* and Mrs. *McCoombe*, and of the corroborative evidence of *Johnston*
- 45 and *Binks*, and in the second place, the Respondent's bleach having been supplied to Mrs. *Wood* as "Parozone" on four separate occasions, and to Mrs. *McCoombe* on one other occasion, I think that the Complainers were entitled to assume that it was the Respondent's practice to sell his own bleach as "Parozone." Further, as I have already said, I think that the other evidence
- 50 in the case shews that it was not the Respondent's invariable, or even general practice to explain that the bleach which he kept was not "Parozone" but that his general practice was the other way, although he sometimes explained that he did not keep "Parozone." It was further argued for the Respondent that the fact that he occasionally sold a pennyworth or a halfpenny worth of his own
- 55 bleach as "Parozone" did not justify the severe remedy of an interdict, especially considering that his total sales did not amount to more than a shilling in the week. No doubt from that point of view the case is a trivial one, but I do

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not suppose that the importance of the question to the Complainers is to be measured by the money value of the sales made by the Respondent. The article in which the Complainers deal, and which has acquired a reputation under the name of "Parozone," is one which appears to be generally sold by the gill, for which a penny is charged, and accordingly if it was the practice among small tradesmen to sell as "Parozone" bleach which was not made by the Complainers the loss to their business might be very serious, although the amount of the sales of any individual tradesman might be small. 5

Further, the Respondent has all along maintained that he has never sold his bleach as "Parozone." That has been proved to be untrue, and the evidence establishes, in my judgment, not only that he has sold his own bleach as "Parozone," but that he has done so to an extent which cannot be accounted for by mere inadvertence or forgetfulness. If the Respondent had admitted that he had sometimes sold his bleach in answer to a request for "Parozone," but had undertaken not to do so in the future, I should not have been disposed to grant interdict, but as matters stand I think that the Complainers are entitled to the protection which an interdict will give them. 10 15

The *Interlocutor* was as follows: "Edinburgh, 26th February 1904. The LORD "ORDINARY having considered the cause, sustains the reasons of suspension, "suspends the proceedings complained of, and interdicts, prohibits and "discharges the Respondent in terms of the prayer of the Note, and decerns : 20 "Finds the Complainers entitled to expenses, allows an account thereof to be "given in and remits the same when lodged to the Auditor to tax and report."

IN THE SUPREME COURT OF JUDICATURE.

COURT OF APPEAL.

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Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, and STIRLING.

December 16th and 17th, 1903, and February 22nd, 1904.

GAMMONS v. BATTERSBY.

Patent.—*Action for infringement.*—*Construction of Specification.*—*Novelty.*—*Subject-matter.*—*Utility.*—*Infringement.* 30

The Patentees of an invention of "Improvements in attaching bindings to "the brims of hats" stated in their Specification that the invention consisted "in "fitting a hat having a stiff, curled, or rolled brim, with a binding having its "inner edge connected to the inner side of the brim by stitches extending through "the same and being turned over the edge of the brim so as to cover said edge 35

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"and also cover and protect the connecting stitches; the said binding having its ends connected together subsequent to its connection to the brim and prior to its being turned or snapped over the edge of the same, for a purpose herein-after pointed out"; that the invention also consisted of a machine, and the

5 Specification proceeded to describe the machine and the method of attaching the binding to the hat by means of the machine. The Patentees claimed, first, "The herein described method of attaching to a hat having a stiff, curled or rolled brim, a binding having," &c. (as above) "substantially as specified," and the other claims were for sewing machines comprising elements therein respectively

10 specified. The Defendants denied infringement, and alleged want of novelty and want of subject-matter as to all the claims, and contended in particular that the first claim included attaching the binding by hand in the manner described in that claim. For the Plaintiffs, whilst it was alleged that in any case the method was new, it was contended that Claim 1 only included attaching

15 the binding by the machine. The Defendants also alleged that the only thing new in the machine was making a concavity in the underside of the work-supporting arm for the purpose of clearance in working, that all the other elements were old, and that there was no invention.

Held (affirming Buckley, J.), that Claim 1 was for the method of attaching

20 the binding by means of the machine; that novelty and utility in respect of all the claims was established; and that the Defendants had infringed.

On the 23rd of June 1897 Letters Patent (No. 15,048* of 1897) was granted to *Welcome Pennson Gammons, jun., and George Stephen Bracher* for "Improvements in attaching bindings to the brims of hats."

25 The Complete Specification, as amended in accordance with a decision of the Comptroller-General of the 3rd day of April 1901, was as follows:—"Our invention relates to the art of attaching bindings to the brims of hats, and it consists in fitting a hat having a stiff, curled, or rolled brim, and with a binding with having its inner edge connected to the inner side of the brim

30 "by stitches extending through the same and being turned over the edge of the brim so as to cover said edge and also cover and protect the connecting stitches; the said binding having its ends ~~snapped~~ or connected together subsequent to its connection to the brim and prior to its being turned or snapped over the edge of the same, for a purpose hereinafter pointed out.

35 "The invention also consists in a sewing machine which although designed more especially for connecting one edge of bindings to stiff, curled, or rolled hat brims, may be used to advantage in connecting one edge of bindings to soft hat brims.

"Other objects and advantages of the invention will be fully understood

40 "from the following description and claims when taken in connection with the annexed drawings, in which: Fig. 1, is a perspective view of our improved sewing machine. Fig. 2, is a vertical longitudinal section of the same with parts in elevation. Fig. 3, is a detail longitudinal section on an enlarged scale of the work supporting arm. Fig. 4, is a detail section taken in the

45 "plane indicated by the line *x, x*, of Fig. 3. Fig's 5 and 6, are detail views of the shuttle removed from the race, and: Fig's 7 and 8, are views of a hat with the binding applied in accordance with our invention. In the said drawings, similar letters designate corresponding parts in all of the views, referring to which: A, indicates the base of the machine, and B, indicates

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"the overhanging arm having the head C, at its forward end, in which are
 "arranged the needle bar D, the presser bar E, having the foot *a*, at its lower
 "end and the feed bar F. The said needle bar, presser bar, and feed bar may
 "be similar in construction to those embodied in sewing machines at present
 "in use, and the bars D and F, may be operated by the drive shaft G, through 5
 "the medium of mechanism contained in the head C; the needle bar D, being
 "reciprocated vertically while the feed bar F, is given respectively an up and
 "down movement and a forward and backward horizontal movement in relation
 "to the work plate in order to feed the materials forwardly as will be hereinafter
 "more fully described. Extending forwardly from the forward end of the 10
 "base A, is the work supporting arm H, of our improved machine. This arm H,
 "has the rear portion of its underside concaved as indicated by I, to accommo-
 "date the crown of a stiff hat to which the binding is being connected, and this
 "concavity may be afforded by recessing the underside of the arm or by bending
 "the arm into a concavo-convex form as illustrated; the latter manner being 15
 "preferable for obvious reasons. At its forward end which rests beneath the
 "needle, feed, and presser bars, as shown, the arm H, is made straight, flat, and
 "comparatively thin for reasons which will presently appear, and it is provided
 "adjacent to its forward end with the vertically disposed needle receiving
 "aperture *b*, and preferably has the portion *c*, in which said aperture is formed 20
 "raised as illustrated so that its upper side will rest flush with the plate J, upon
 "which the guage K, presently described, is mounted.

"L, indicates the horizontal race for the loop taking device M, which may if
 "desired, be an oscillatory shuttle of the well known construction illustrated.
 "This race L, which communicates with the needle opening *b*, as better shown 25
 "in Fig. 3. is normally covered by the plate J; and the shuttle M, which it
 "contains is oscillated by the same shaft G, that operates the needle bar and
 "feed bar through the medium of the cam *f*, the lever *g*, the reciprocatory
 "rack *h*, the gear wheel *i*, and the pinion *j*, or any other suitable intermediate
 "mechanism; the pinion *j*, (when employed) being removably splined to the 30
 "shuttle as shown so as to permit of the latter being readily removed when the
 "plate J, is swung to one side on its pivot *e*, to open the race L.

"The corners of the upper side of the arm H, at the forward end of the same
 "are rounded or beveled as indicated by *p*, so that no sharp angles which would
 "tend to injure a hat brim are presented to the same as it is fed beneath the 35
 "needle.

"N, indicates the binding guide of the machine which is preferably formed
 "of sheet metal, although other material may be employed if found desirable.
 "This guide N, is shown as formed in one piece and attached to the side of
 "the arm H, and it has its free portion *r*, bent so as to rest in a vertical plane 40
 "parallel to and close against the forward end of the said arm and also has the
 "retaining loop *s*, which rests upon the upper side of the arm H, close to one
 "end of the portion *c*, thereof, and the retaining loop *t*, which rests slightly
 "below the arm as shown.

"K, indicates the guage against which the edge of the hat brim is pressed by 45
 "the operator, in order to have all the stitches take through the brim and binding
 "at a uniform distance from the edge of the former so as to make a neat and
 "finished job. This guage K, may be formed ~~and may be formed~~ and may
 "be adjusted and adjustably fixed in any suitable manner, but we prefer to
 "form it of sheet metal and provide it with the upturned lip *v*, at its forward 50
 "end and with the longitudinal slot *w*, and adjustably connect it with the
 "plate J, by a binding screw *x*, as by this construction it may be readily
 "adjusted and adjustably fixed so as to permit of taking the stitches through
 "the brim at various distances from the edge of the rim.

"In the practical operation of our improved machine, after the guage K, has 55
 "been properly adjusted, the binding I, is placed in the guide N, so that its
 "upper portion will overlap the forward thin and flat end of the work supporting

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“arm as illustrated by dotted lines in Fig. 1. The brim 2, of the hat 3, is then placed upon the end of the arm over the binding and its edge is pressed against the guage K, by the operator when the machine is started and the stitching of the binding to the brim is commenced and continued until the binding is connected throughout its length to the brim. We prefer in practice to start the stitching at the back of the hat and stitch entirely around the hat to the point of commencement. While the stitching of the binding to the front or back end portions of the hat brim is going on, the hat rests and is held with the crown depending but as the stitching progresses toward and along the side of the brim, the hat must be gradually turned until the crown rests in a horizontal or approximately horizontal position with the inside of the hat toward the operator and the crown in the concavity above mentioned, and as the stitching further progresses, the hat must be turned so that when it reaches the end of the brim opposite to the point of commencement, it will rest in the position first mentioned, *viz.*: with its crown depending. From this point, the operation is repeated to the point of commencement, that is to say the hat is slowly turned until when the stitching reaches the middle of the side of the hat brim, its crown rests in an approximately horizontal position beneath the arm H; and from this point to the point of commencement the hat is slowly turned until when it reaches the point of commencement its crown will rest in a depending position. The concavity of the arm H, permits of the hat being turned freely into the horizontal position stated, and it is absolutely necessary to get the hat into such position in order to sew the binding to the sides of the brim in a finished manner especially when the brim is provided with the fashionable deep rolls or curls, it will be appreciated that the concavity of the said arm H, forms an important feature of our invention.

“After the piece of binding has been attached along one edge and throughout its length to the inner side of the stiff hat brim by stitches 4, (see Fig. 8) its ends are ~~‘snapped’~~ or sewed together as indicated by 5, after which it is turned outwardly or ~~snapped~~ over the curled brim, when it will be snugly and tightly held thereon. This is due to the fact that the outer side of the brim is larger than the inner side and consequently when the ends of the binding are ~~‘snapped’~~ or connected together after one edge of said binding is connected to the brim, and before it is turned over the same, the free edge of the binding is strained and sprung over the brim under considerable tension, varying according to the thickness of the felt. This, as stated, renders the binding tight upon the brim, but in order to avoid any possibility of the binding coming off during use, its outer edge may if desired be stitched by hand to the brim or otherwise suitably secured.

“In virtue of the binding being connected to the brim and turned over the edge of the same in the manner described, it will be seen that said binding will snugly fit the brim and hold itself in position thereon without the employment of stitches or other fastening means; and it will also be seen that said binding will cover the connecting stitches, thus preventing the same from being rottened, faded or otherwise deteriorated, which is an important advantage.

“It is obvious when a piece of binding is to be attached to a hat brim, the distance of the line of stitches from the edge of the brim may be varied to suit various kinds of hats by suitably adjusting and adjustably fixing the guage K.

“During the operation of stitching the binding to the hat brim, the feed bar F, by its up and down and forward and backward horizontal movements serves to feed the hat and consequently the binding forwardly and at the same time holds the hat brim to the needle plate while it is being fed.

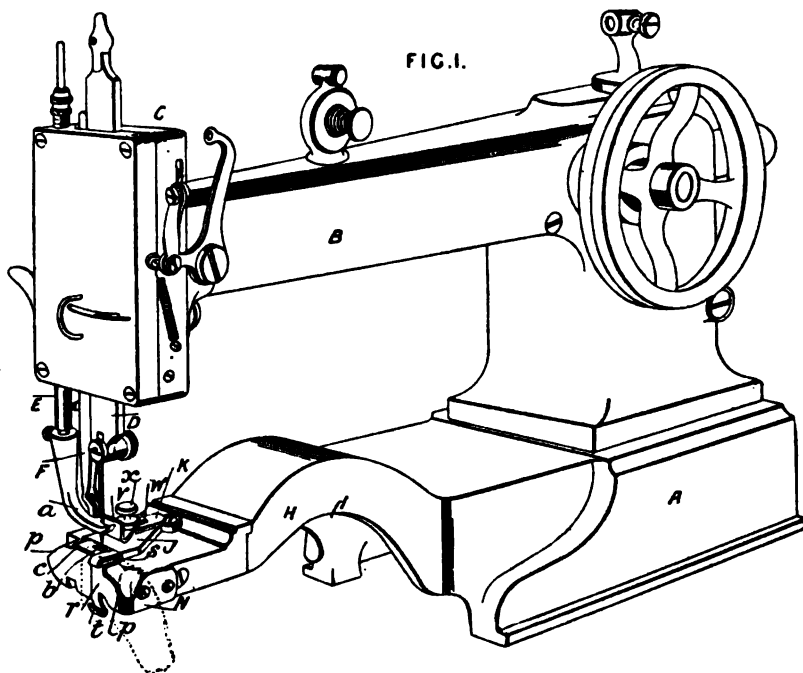
“It will be observed that our machine is very simple, and that its construction is such that the parts are not likely to get out of order, and it will also be

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"observed that the stitching of the binding to the brim may be accomplished
 "as easily when the brim is deeply curled or rolled, as when it is but slightly
 "curled or rolled, and this without in any way damaging the brim or changing
 "or destroying its shape.

"The shuttle M, cooperates with the needle in the usual manner, and it is
 "disposed horizontally as described so as to permit of the arm H, being made
 "thin in order to enable it to readily take between the brim and crown of the
 "hat as illustrated in Fig. 3. The shuttle M, alone forms no part of our
 "invention and any suitable loop taking device may be employed in lieu of
 "the same. 5 10

"The needle bar, feed bar, and presser bar with the mechanism for transmitting
 "motion to the same, when considered alone also do not form a part of the
 "invention and any suitable mechanism which embodies a practical feed device
 "may be employed in lieu of the same.



"While our improved machine is designed more especially for connecting
 "the edge of bindings to the inner sides of stiff, rolled, or curled hat brims, it
 "may be used to advantage for so connecting bindings to soft hat brims." 15

The Patentees claimed:—"1—A *The herein described method of attaching*
 "to a hat having a stiff, curled or rolled brim, and a binding having its inner
 "edge connected to the inner side of the brim by stitches extending through
 "the same and being turned over the edge of the brim so as to cover said edge
 "and also cover and protect the connecting stitches; the said binding having
 "its ends ~~snapped~~ or connected together subsequent to its connection to the
 "brim and prior to its being turned over the edge of the same, substantially as
 "specified. 20 25

"2—A sewing machine comprising a work supporting arm having the
 "comparatively thin and flat portion at its forward end adapted to take

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- "between the brim and crown of a stiff hat and the concavity I, in its under-
 "side in rear of said thin and flat portion adapted to receive the crown of a
 "hat; the said concavity I, extending above the lower side of the forward
 "flat and thin portion and being disposed at right angles to the length of the
 5 "arm, a loop taking device arranged in said arm adjacent to its forward end,
 "a hat gauge arranged upon and adjustably connected to the upper side of the
 "work supporting arm adjacent to the forward end thereof, the binding guide
 "arranged upon the forward end of the work supporting arm and having the
 "lower loop *t*, adapted to receive the lower edge of the binding and support
 10 "the same and the upper horizontally disposed loop *s*, arranged upon the
 "upper side of the work supporting arm, an overhanging arm carrying a needle
 "bar and a feeding device, and means for operating the needle bar, feeding
 "device and loop taker, substantially as specified.
 "3—A sewing machine comprising a work supporting arm having the
 15 "corners of its upper side beveled at its forward end as indicated by *p*, a hat
 "gauge arranged upon and adjustably connected to the upper side of the work
 "supporting arm adjacent to the forward end thereof, the binding guide
 "arranged upon the forward end of the work supporting arm and having the
 "lower loop *t*, adapted to receive the lower edge of the binding and support
 20 "the same and the upper horizontally disposed loop *s*, arranged upon the
 "upper side of the work supporting arm, a feeding device, and a suitable
 "organized stitch forming mechanism, substantially as specified.
 "4—A hat sewing machine comprising the work supporting arm H, having
 "the comparatively thin and flat portion at its forward end adapted to take
 25 "between the brim and crown of a stiff hat, and the concavity I, in its under
 "side in rear of said thin and flat portion adapted to receive the crown of a
 "hat; the said concavity I, extending above the lower side of the forward
 "flat and thin portion and being disposed at right angles to the length of the
 "arm, a hat gauge carried by the arm H, a binding guide carried by said
 30 "arm and a suitable organized stitch forming mechanism, substantially as
 "specified."

On the 1st of May 1901 the Patentees commenced an action against *Battersby & Co., Ltd.*, for infringement of the Patent, claiming the usual relief.

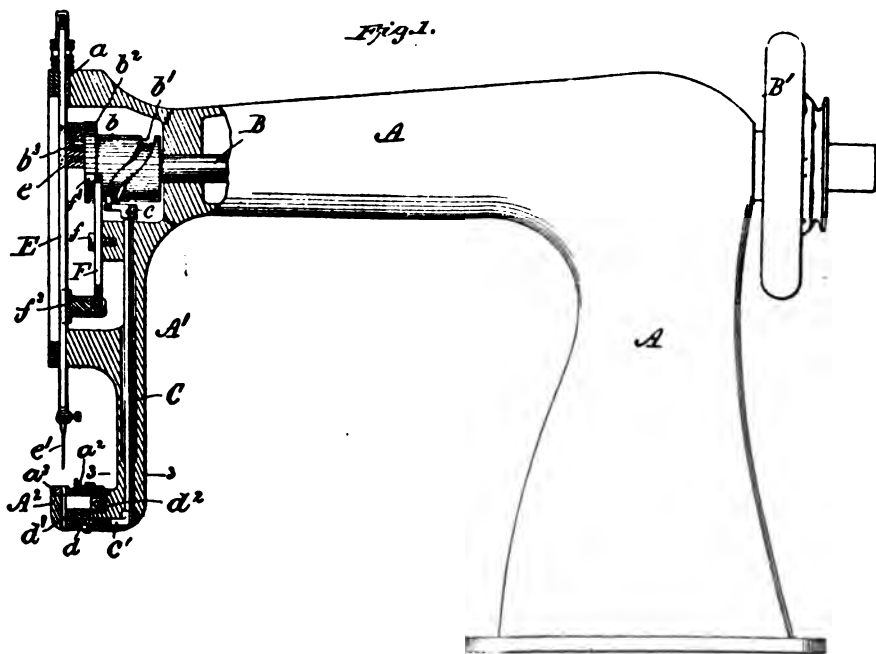
- By their Statement of Claim the Plaintiffs alleged—(1) that they were the
 35 registered owners of the Patent; (2) the amendment of the Specification, and
 that the original claim was framed in good faith and with reasonable skill and
 knowledge; (3) that the Patent was valid; and (4) that the Defendants had
 infringed.

- By their Particulars of Breaches the Plaintiffs alleged that the Defendant
 40 Company had infringed the Patent and the first, second, third, and fourth
 claims thereof, in manner following, viz., that the Defendant Company
 had subsequently to the date of the Patent used certain machines manufactured
 by the *Singer Manufacturing Company*, or some other person or Company,
 without the Plaintiffs' authority for the purpose of attaching bindings to the
 45 brims of hats in the improved manner described and claimed in the first,
 second, third, and fourth claims of the Patent as amended in accordance with
 the decision of the Comptroller-General, dated the 3rd of April, 1901; that the
 machines so used included and applied the method of attaching to a hat, having
 a stiff, curved, or rolled brim, a binding having its inner edge connected to the
 50 inner side of the brim by stitches extending through the same and being turned
 over the edge of the brim, so as to cover the edge and also cover and protect
 the connecting stitches, such binding having its ends connected together
 subsequent to its connection to the brim and prior to its being turned over the
 edge of the same, being the method substantially specified in the Specification
 55 so amended as aforesaid; and the Particulars went on to allege in detail
 that the machines so used had the combinations substantially specified and
 claimed in the second, third, and fourth claims of the Specification.

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The Defendants by their Defence denied infringement, and alleged the invalidity of the Patent by reason of the matters in the Particulars of Objections appearing.

The Particulars of Objections alleged—(1) that the Patentees were not the first and true inventors of the alleged invention; (2) that the alleged invention was not useful; (3) that the alleged invention was not new; (A) that the alleged invention claimed in the first claiming clause of the final Specification of the Patent had been publicly used in the realm by the Defendants at their works at Offerton Hat Works, Stockport, in the county of Chester, continuously for the last thirty years; (B) that the alleged invention described in the second, third, and fourth claiming clauses of the said Specification had been published in this realm prior to the date of the said Letters Patent by the publication at the Patent Office Library of the final Specifications of the following Letters Patent:—[Eleven Specifications were mentioned for which see 20 R.P.C. 535, including *Thomas*, No. 9074 of 1884, for which see 20 R.P.C. 535]. (4) that the alleged invention, as to all the claiming clauses thereof was not proper subject-matter for valid Letters Patent; that under this head the Defendants would rely upon general public knowledge and common general knowledge in the hat and sewing machine trades, and upon the matters alleged in paragraph 3, and would also allege that the alleged combinations claimed in Clauses 2, 3, and 4 were mere collections of old and well-known parts of sewing machines all commonly known and used, and that no invention was required to collect the same together, and that the collection of parts named in the said claims were not combinations which formed good subject-matter for valid Letters Patent.



The alleged infringing machine was stated to be made under Letters Patent No. 21,875 of 1898, granted to *J. K. Macdonald*, on a communication from abroad by the *Singer Manufacturing Company*. Fig. 1 of the drawings to the Specification of this Patent is shown above.

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The action came on for trial before Mr. Justice *Buckley*, who held that Claim 1 was for the method of attaching the binding by means of the machine, that novelty and utility in respect of all the claims were established, and that the Defendants had infringed, and judgment was given for the Plaintiffs accordingly.*

The Defendants appealed.

Astbury, K.C., *A. J. Walter*, and *H. A. Colefax* (instructed by *G. D. Wansbrough*) appeared for the Appellants.

Moulton, K.C., *T. Terrell*, K.C., and *Whinney* (instructed by *Slack*, *Monro*, and *Atkinson*) appeared for the Respondents.

Astbury, K.C., and *A. J. Walter* for the Appellants.—This is an appeal in a Patent action from a judgment of *Buckley*, J., affirming the Patent and granting an injunction for infringement. The Patent is one for putting the ribbon binding round the edge of a hat and for a sewing machine for doing it. The first claim is for the fixing on of the ribbon as we say apart altogether from any particular machine by which it is done, which was thought by the Patentee to be novel, and which turns out to be nothing of the kind. The Court below, however, has held that the first claim is for putting it on by a machine, and that Claims 2, 3, and 4 are claims for a sewing machine for the purpose of stitching the band on the hat. We say that Claim 1 is not for putting it on by a machine; it is a claim for putting it on in a particular way with a result that is admittedly after the evidence quite old. With reference to the machine, we say that the machine itself, unless it is confined to very small detailed improvements, is one which has been known for years; but, in addition to that, Claim 3 is a claim for the sewing machine in gross, which does not contain the only novelty which is a feature of the other machines and of the machine itself. Sewing machines of two classes were known at this date; sewing machines in which there was a top arm in which the driving mechanism for working the needle and the feed mechanism were carried, and a lower arm in which the mechanism for driving the shuttle and the lower portion of the feed mechanism were placed. There was another type of machine, namely, a machine having only the upper arm which carried the whole of the mechanism and from which hung the work supporting table. Both these classes of machines were known. In every sewing machine there was a feed mechanism which carried the work forward, after one stitch had been made, into the position in which the next stitch was to be put in. The particular feed mechanism of this machine was also a well known form—that is to say, in which the needle performed the function not only of piercing the material and passing the thread through, but in which the needle itself received a transverse motion and carried the work forward so that it was in the right position, when the needle went up and moved back, to come down and put in the next stitch. It was also well known that there was a guide—that is, something against which the edge of the material that was being sewn could be pressed, so that the distance of the stitching from the edge should be a constant distance. This was commonly described as a gauge. There was also known an attachment by which when you were sewing together two articles, such as a ribbon and a piece of material, there was a guide in which the ribbon could be placed so as to keep the edge of the ribbon and the edge of the material in a constant relation to each other. All these fittings were perfectly well known in sewing machines. There was also known, in particular relation to the hat industry, the method in which you put the binding equally over both edges, and the method in which you sewed with what has been called the ladder stitch. At the date when this Patent was taken out it was believed by the Patentee that he had in fact invented a new method of securing the binding of a hat to the brim. What was the method by which the hat binding was secured to the brim? It had nothing

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to do with the means by which the stitches were put in. It had solely to do with the position in which the stitches were put. Whether the stitches are put in by a machine or whether they are put in by hand, the method of securing the binding to the brim so that it can be afterwards snapped over is absolutely independent of the agency by which the stitches are inserted. Sewing with a machine *per se* can do nothing but attach the ribbon to the hat. That is all it does, and that is what the hand does too. Does the fact that it is sewn with a sewing machine do anything more except to sew with the aid of a mechanically moved needle the same thing that has been sewn with the hand of an operator? It does not do anything else. It is a confusion of language to describe sewing a thing by a machine as a method. It is not a method at all. There is no difference in the sewing of that to the sewing of anything else. The machine performs its function of passing the needle through and carrying the thread through stitch after stitch and nothing else. There is no new invention, no new method in the sewing machine. The sewing machine performs its ordinary function of sewing a thread and nothing else. It has absolutely nothing to do with the new process beyond the fact that it is a mechanically operated needle instead of a hand operated needle. The sewing machine is outside the first claim altogether. It performs nothing but the physical act of putting in the stitches, and it is no part of the method. The method is the method described, namely, so attaching the ribbon that when it is sewn on one edge it can be turned over. If that is the true construction, whether or not the machine is in Claim 1, we have not infringed, as the binding having its ends connected together subsequent to its connection to the brim is an essential element of the first claim. We do not do that. We make a complete circle of the ribbon in the old and well known way, and we connect the ends before we touch the machine. So that we say we have not infringed the first claim, no matter how it is construed, because the binding connected together subsequently is an essential element. We have not infringed the second or third claims because we have not got a gauge which is made essential by them in the claim, and, with regard to the fourth claim, we say it is a claim for the machine as shewn in the drawings which we have not got.

T. Terrell, K.C., and Whinney (Moulton, K.C., with them) for the Respondents.—This is really a very clever invention if the problem, that the Patentee had to solve when he started, is once realised. It is the first time that a tape or binding has been sewn on to a material by a sewing machine when the binding is put underneath and the needle has gone through the material first; the needle goes through the material first, which is the felt in the case of a hat, and through the binding after. It is a difficult problem to solve, and it is solved in an exceedingly ingenious manner. If done by hand it is comparatively easy; it is only when you use a machine that you have the problem. On the evidence a woman did 12 hats a day by hand, and according to the Appellants' evidence she can do 15 dozen a day by the machine, and according to our evidence 45 dozen. This machine is enormously used in the trade. There was a great demand in the hat trade for a machine which will do this operation. Many machines were tried; none succeeded—everybody did it by hand. The Patentee comes forward with his machine and he succeeds, and it is adopted by the trade. That is not conclusive of invention; but the Courts have always said that that goes a long way towards proving subject-matter in an invention. Now, what is the combination in Claim 3? It is a combination of five parts, each one of which was old, and existed before in numerous forms. There were numerous forms of feeding mechanism, of shuttle mechanisms, of gauges, and of work supporting arms. The Patentee has selected out of all those numerous forms one, and he has described its qualities, and he has put the one out of each set of different forms together, and it is the selection of those five suitable elements, the bringing them together and putting them in combination, which makes the machine that accomplishes his purpose. The

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Patentee succeeded in making a machine by means of which he can sew upside down. If that is not invention, if that is not subject-matter to do that, then we are wrong. The true interpretation of Claim 1 is this: "My invention is an invention for a method of attaching the bindings to the rims of hats, in the course of which I use a machine. My invention also is the machine which I use." There is not a single word of any other method of doing it except the doing it by a machine; it is clear the claim is one for doing it with the assistance of this machine. Now, as to infringement, the Appellants say they have not infringed because we claim as part of Claim 1 that the binding is connected together subsequent to its connection to the brim and prior to its being turned over, and they say we have not done that, we have connected the binding together before its connection to the brim, and the question is—Is that infringement? The machine, we submit, is the essence of the invention; the machine which enables you to sew the binding on. The machine is the real thing invented, and the sewing the binding on is another invention. We say also that the other claims have been infringed. We submit that the appeal should be dismissed.

Astbury, K.C., replied.

The judgment of the Court was delivered by

- 20 *ROMER, L.J.*—This case is one of considerable difficulty, but the conclusion I have arrived at is that the judgment of Mr. Justice *Buckley* should not be disturbed.

The claims in the Specification which give rise to difficulty are those numbered 1, 2, and 3. I will first deal with Claim 3. That is for the machine without the concavity formed in the lower arm to allow the hat to be conveniently placed as the band is sewn to the brim. If that claim is good, then Claim 2 (which is for the machine with the concavity) is clearly good.

- Undoubtedly sewing machines are so numerous, and have been applied to so many purposes, that no one part of the patented machine can be claimed as absolutely new. But the question is whether the combination of parts so as to form a particular machine is not novel, and required invention, so as to form good subject-matter for a Patent. The Appellants urged that Mr. *Swinburne*, the Plaintiffs' expert witness, had in his evidence admitted that the patented machine without the concavity, even as a combination, had nothing novel in it, and there are some parts of his evidence which, taken by themselves, appear to support the Appellants' view. But, on reading carefully his evidence as a whole, I am satisfied that this view is not correct, and that, on the contrary, his evidence is to the effect that the combination was novel and required invention. And, apparently, this was the view of his evidence taken by Mr. Justice
- 30 *Buckley*. The expert witness for the Defendants, Mr. *Dugald Clerk*, was undoubtedly of opinion that the combination was not one that required invention, or had such novelty in it as to support a Patent for it. In this state of the expert evidence, it is important to consider the evidence as to the alleged anticipations and the public knowledge at the date of the Patent.

- It is significant that no machine is alleged as an anticipation in the Defendants' Particulars of Objections; and the Defendants have failed to prove that at the date of the Patent any machine existed or was known which, without alteration, would do the work that can be done by the patented machine. Indeed there is evidence that the Plaintiffs' machine was not only the first to do that work but that it was a complete novelty in the trade, and enabled the bindings to be sewn on the brim of the hard and curled brimmed hats in a new and useful way. In fact the utility of the machine is not seriously in dispute. And that invention was required appears from this, that, although there was a demand for a machine such as the Plaintiffs', and attempts had been made to produce one, no person prior to the production of the Plaintiffs' machine had been thoroughly successful in those attempts. I may instance the hat-binding machine which was the subject of *Thomas's* Patent as specially illustrating this, for that machine

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had obvious and admitted defects avoided by the Plaintiffs' machine, and yet it had never occurred to the inventor of the *Thomas* machine how he could avoid those defects or produce a machine like that of the Plaintiffs. I do not think the merits of the Plaintiffs' machine are the less because it is now seen what a little alteration was really required in, or in the adjustment of, some of the parts of previously known machines, in order to produce a machine which would do the work first done by the Plaintiffs' machine. Now that the Plaintiffs' invention is known, it is easy to do what was ingeniously suggested by the Defendants' Counsel in the argument before us—that is to say, take a previously known machine, and, with what might appear at first sight a somewhat insignificant alteration or re-adjustment, make it do the work of the Plaintiffs' machine. On the evidence as a whole, therefore, I come to the same conclusion as that arrived at by Mr. Justice *Buckley*, namely, that the Plaintiffs' machine (even without the concavity) could do work which was useful and desired, and which no other then known machine could do, and that the machine was novel and useful and required invention and could form good subject-matter for a Patent, and accordingly that Claims 2 and 3 of the Specification are valid.

I ought perhaps to add with reference to Claim 3, the Plaintiffs' machine without the concavity will sew binding even on hats with hard curled brims, though not, of course, so easily or conveniently as with the concavity in accordance with Claim 2. That the Patentee has pointed out that this machine can also be used to sew bindings on soft-brimmed hats clearly does not, in any way, invalidate his Patent.

Then, as to infringement, I think the Defendants have infringed. The only way they can differentiate the machine used by them from the patented one is by pointing out that they do not use the loop "t" referred to in the Plaintiffs' Specification. But that loop was found in practice to be unnecessary, and was not, in my opinion, an essential or substantial part of the Plaintiffs' machine, and I think the Defendants have, in effect, taken and used the Plaintiffs' machine.

It only remains, therefore, for me to consider Claim 1. After much hesitation, I have come to the conclusion that, that being a claim merely for the method shown of sewing on the binding to the brim as a continuous process, it would not be fair to the Patentee to extend the claim beyond one for the exact process shown, and that as the only process of sewing shown or suggested in the Specification is that done by the patented machines, Claim 1 does not extend to cover a case where the sewing is done by hand or otherwise than by that machine. Accordingly, I think that the claim is not invalid as suggested on behalf of the Appellants.

This view is supported by the fact that the Specification, in the first part of it, speaks of the machine not as being a separate invention, but as being part of the invention. Seeing that the Defendants have infringed the machine, it is unnecessary to consider whether they have or have not also infringed Claim 1.

In the result, in my opinion, the appeal must be dismissed with costs.

Sandow, Sandow, Ltd., Brookes, and Waldenstein v. Szalay.

IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, STIRLING and COZENS-HARDY.

March 22nd, 23rd and 24th, 1904.

SANDOW, SANDOW, LD., BROOKES, and WALDENSTEIN v. SZALAY.

- 5 *Patent.—Action for infringement.—Injunction granted in respect of one Patent sued on.—Appeal.—Patent held not to be infringed.—Appeal allowed.*

S., Ltd., who were the proprietors of a Patent granted to J. R. for "Improvements in dumb-bells for physical culture exercises," brought an action for infringement of the same and of another patent not relied on at the trial. The
10 *invention consisted in a dumb-bell formed in two parts, divided longitudinally, with springs between them. In the Provisional Specification the Patentee expressly mentioned compressed air springs. The Complete Specification omitted any mention of them, but the second Claim mentioned resilient means of expansion generally. The Defendant's dumb-bell had inflated india-rubber*
15 *balls between the halves of the dumb-bell at each end. The Defendant attacked the validity of the Patent on various grounds, and denied infringement. It was held at the trial that the Specification claimed a combination; that it was not a claim for the invention of mere details; but that it embodied a new principle or idea; that the Patent was valid, and that the*
20 *Defendant had infringed, and judgment was given for the Plaintiffs on this Patent, a certificate of validity being granted. The Defendant appealed.*

Held by the Court of Appeal (STIRLING, L.J., doubting), that on the evidence as to the state of knowledge no new result was attained by the Patentee, and that the inference to be drawn from the omission of mention of air springs in the
25 *Complete Specification was that the Patentee did not intend to claim them, and on the construction of the Specification that they were not claimed and that under the circumstances an air spring could not be claimed as a mechanical equivalent for the springs described in the Complete Specification. The appeal was allowed, with costs.*

- 30 *This was an action by Eugen Sandow, Sandow, Ltd., and two licensees, commenced on the 29th of June 1903, to restrain the infringement of Letters Patent (No. 17,855 of 1898) granted to Joseph Robinson for "Improvements in "dumb-bells for physical culture exercises" and of another Patent not relied upon at the trial.*

Sandow, Sandow, Ltd., Brookes, and Waldenstein v. Szalay.

The Provisional Specification of *Joseph Robinson* was as follows :—"My invention relates to improvements in the construction of dumb-bells and consists in the application of one or more springs attached to the dumb-bell, thus causing the dumb-bell to acquire a firm grip when held in the hand. The firm grip of the dumb-bell is intended to, and does cause a continuous tension 5 of the muscles of the arms when used for physical culture exercises.

"My invention consists of one or more flat steel springs, steel spiral springs, rubber springs, or compressed air springs, or a combination of these several springs, attached to the interior, or in the handle portion of the dumb-bell in such a position and manner as to cause the dumb-bell to be firmly grasped 10 when in use.

"My invention consists of a dumb-bell constructed of wood, compressed pulp, metal or other suitable material. The usual method of construction I adopt is to form the dumb-bell in two longitudinal sections and insert the steel or other springs between the two sections of the dumb-bells. 15

"My invention may be constructed by fixing the steel or other springs, by screws or other suitable means; a joint or hinge is fixed at one end of the inside of section, to allow the dumb-bells to open at one end, the springs being arranged so as to keep the two sections apart, when not being held in the hand. Two pieces of leather or rubber are attached to the open end of 20 the sections to prevent the springs extending the sections too far apart.

"The special advantage is that by the application of a combination of springs, it causes a continuous tension of the muscles, thereby enabling a person using these dumb-bells to gain strength and health in a much more efficient manner, and with less exertion, causing the person to feel refreshed after such 25 exercise."

The Complete Specification was as follows :—"My invention relates to improvements in dumb-bells, and consists in the application of one or more springs to the dumb-bells so as to cause the same to require a firm grip when held in the hand. This firm grip of the dumb-bell is intended to, and does, 30 cause a continuous tension of the muscles of the arms, wrists, hands, and fingers when used for physical culture exercises.

"The invention consists principally in the application of flat, curved, or spiral springs, or a combination of several springs, to the interior or to the handle portion of the dumb-bell in such a position and manner, that when in use the 35 grasp on the handle will cause the spring or springs, to be compressed.

"The dumb-bells may be constructed of wood, compressed pulp, metal or other suitable material.

"The manner in which my invention is to be performed or carried into practical effect will be readily understood on reference to the sheet of 40 drawings hereunto annexed and the following explanation thereof.

"It will be obvious that various ways of giving this expansive action to the bar or handle may be adopted without departing from the distinctive features of my invention, but for the sake of illustration I have shown on the drawings various different forms which the invention may take. 45

"In the modification shown at Fig. 1 the bar *a* and the two 'bells' *b* are divided into two parts longitudinally, being hinged together at *c* at one end and a bow spring *d* fixed between the two to keep the two sections apart when not being held in the hand, the open hands being prevented from being 50 extended too far apart by a band *e* of leather or other suitable material.

"In the modification shown partly in section at Fig. 2, the two sections are held together by screws *f* and are distended by coil springs *g*.

"In Fig. 3 the two sections are separated by a bow spring *d* (as in Fig. 1) and are kept in place by steady pins *h* and are prevented from expanding too much by india rubber rings *e*. 55

"In the modification shown in longitudinal section at Fig. 4 and transverse section at Fig. 5 the 'bells' *b* are hollow and are divided transversely instead

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" of longitudinally they are held together by a screw *f*. The handle consists of
 " a series of spring bars *a* bowed out in the centre, which must be compressed
 " when the handle is grasped.

- 5 " The modification shown at Figs. 6 and 7 is somewhat similar, with the
 " addition of a spiral spring *i* inside, the tension of which can be increased or
 " diminished by turning the screw *f*.

" Figs. 8 and 9 resemble Fig. 2 with the exception that two coiled springs *g*
 " are used at each end instead of one and the sections are kept from expanding
 " too much by india-rubber bands *e*.

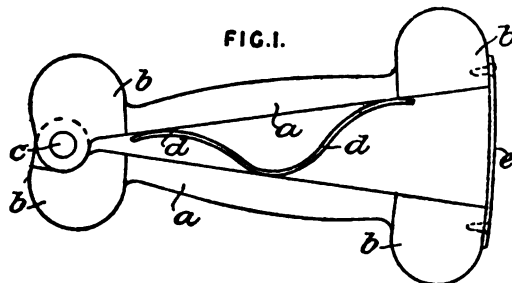


FIG. 2.

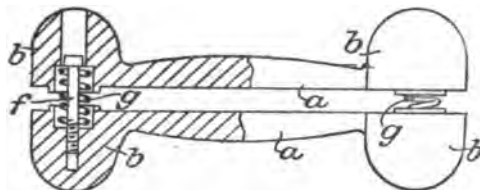
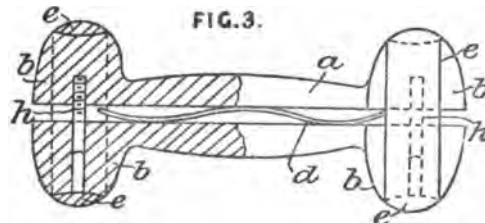


FIG. 3.



- 10 " In the modification shown partially in section at Fig. 10 the 'bells' *b* are
 " made hollow with conical centres *j* inside, the handle is made of a series of
 " bars *a* bowed in the centre, and with their ends *a'* bevelled to fit against the
 " cones inside the 'bells.' The latter are held together by the screwed rod *f*
 " and the cones are forced inwards so as to expand the handle by coiled
 15 " springs *g*.

- " In the modification shown in partial sectional elevation at Fig. 11
 " and transverse section at Fig. 12 the interior of each 'bell' *b* is made
 " in a box form, and the ends of the curved bars *a* which form the handle
 " fit inside the same being expanded by split circular springs *k* inside the
 20 " cranked ends."

The Patentee claimed:—"The improvements in dumb-bells for physical
 " culture exercises which consist in making the handle or bar (which unites

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"the two bells) compressible and at the same time resilient by means of springs, so that when in use the grasp of the hands compresses the springs, thus causing a continuous tension and play of the muscles of the arms, wrists and hands, thereby enabling a person using these dumb-bells to gain strength and health in a much more efficient manner, and with less exertion than with the ordinary dumb-bells, in the manner substantially as hereinbefore described. 5
 "2. A dumb-bell having a handle consisting of two or more parts, and resilient means for expanding said parts, adapted to be compressed by the hand, substantially as and for the purpose hereinbefore described."

The Pleadings so far as they related to *Robinson's* Patent and are material to this report were as follows—by their Statement of Claim the Plaintiffs stated that (1) the Plaintiffs, *Sandow, Ltd.*, were the owners of the Patent, and that *Joseph Robinson*, the grantee, was the first and true inventor of the invention described in that Patent; (2) that the Plaintiffs *Brookes* and *Waldenstein* were licensees from *Sandow, Ltd.*; (3) that the Defendant had infringed the Patent; (4) and that he threatened and intended to continue such infringements. They claimed an injunction and the usual consequential relief. 15

By their Particulars of Breaches the Plaintiffs stated (1) the Defendant had at various times previously to the commencement of the action, and subsequently thereto, infringed the Patent by making, selling, and making profitable use of certain dumb-bells and other appliances being the same, or essentially the same, as the dumb-bells or appliances described in and covered by the above Specification and claimed by Claims 1 and 2. (2) They complained of the sale by the Defendant of two pairs of dumb-bells only colourably differing from dumb-bells described in and covered by the Specification; (3) of the sale by the Defendant of large numbers of such dumb-bells to divers persons whose names were not known on dates not fully known to the Plaintiffs; (4) of the manufacture for sale and the use of a certain dumb-bell, which was produced in Court by the Defendant. 20 25 30

By his Defence the Defendant, in paragraphs 1, 2, 3, and 4, traversed paragraphs 1, 3, and 4 of the Statement of Claim, and stated (5) that the Patent was not new nor valid, for the reasons given in the Particulars of Objections.

By the Particulars of Objections the Defendant alleged—(1) The Defendant had not infringed the Patent; (2) the alleged invention comprised therein was not proper subject-matter in that it did not involve the exercise of any invention or ingenuity, and did not point out any sufficient improvement; (3) the second claim was too wide and too general, and comprised more than he had (if anything) invented; (4) the Complete Specification was ambiguous, and did not sufficiently describe the materials or things directed to be used; (5) the alleged invention was not new at the date of the Patent by reason of the following prior publication and prior user; (6) *Publication*.—The publication within the realm in the following Specifications, filed in the Patent Office: (a) *James Brotherhood*, No. 3556 of 1885; (b) *Percival Everitt*, No. 13,259 of 1889; and (7) by three books, deposited in the Patent Office Library in 1897, on physical culture and gymnastics, edited by Colonel *Amoros*, entitled "Manuel Complet d'Education Physique," and described in Vol. I., pages 67, 68, and 69, and illustrated on pages 11 and 17 of Vol. III.; (8) *Prior user, manufacture, and publication*.—(a) By an appliance known as "*Spencer's Grip*," manufactured at the works of Messrs. *Gillman and Spencer*, and used in 1895 by the Defendant and others, including the members of "The Weight Lifting Club"; (b) the user in 1892 by *A. W. Spencer*, at *F. Galton's* Anthropometric Laboratory in the South Kensington Museum, of a dumb-bell hand-grip or appliance then known as "*Salter's Dynamometer*," substantially the same as the dumb-bells described and claimed by *Robinson*; (9) for many years prior to *Robinson's* Patent it was common knowledge amongst athletes and in schools 35 40 45 50 55

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of physical culture in England, that tension and play of the muscles of the arms, wrists, and hands were produced by gripping steel springs, and such method was constantly practised. *Robinson's* alleged invention was only an example of this method, and did not possess subject-matter for valid Letters

5 Patent.

The action was tried by BYRNE, J., who held that the Patent embodied a new principle or idea and was valid, and had been infringed. Judgment was given for the Plaintiffs on *Robinson's* Patent, with a certificate of validity (*ante*, page 33).

10 The Defendant appealed.

P. H. V. Nicolas (instructed by *E. F. Weldon*) appeared for the Appellant; *T. Terrell*, K.C., and *O. Leigh Clare* (instructed by *G. E. Lewis*) appeared for the Respondents.

Nicolas, for the Appellant.—I do not say that the Patent is anticipated, but that
 15 on the true construction of a Specification it is not a wide one, and the Defendant has not infringed. There are considerable differences between the devices employed—as much as between solid and pneumatic tyres. If the Patentee knew of the means now used by the Defendant, then the Patent is bad, for he has not fully disclosed his invention, *Lewis v. Marling* (1 Webs.; 490 at p. 496), *Wood v.*
 20 *Zimmer* (1 Webs., 82). [VAUGHAN WILLIAMS, L.J.—A Patentee is not bound to make a catalogue of mechanical equivalents.] No, but he is bound to show the best way of carrying out his invention. The evidence is that the Defendant's is the cheapest and best way. The Patentee gives one method—namely, metal springs. [VAUGHAN WILLIAMS, L.J.—What would you say to
 25 curved whalebone?] The Complete Specification clearly indicates a metal spring. If it covers any kind of spring it is bad. Claim 2 is too wide. The Defendant has a better and cheaper method. If the Patentee knew of the Defendant's method he has not disclosed it, and the consideration for the grant is bad. The Patentee is in the same position as the patentee in *Monnet v. Beck*
 30 (14 R.P.C. 777), where he was either claiming an impossible process or one not described. If the Patent includes what the Defendant does, the Specification claims what is not described. If "resilient means" covers all kinds of resilient means whatsoever, Claim 2 is a claim for a principle and is bad, *Automatic Weighing Machine Company v. Knight* (6 R.P.C. 297), following *Neilson v. Hurford*
 35 (1 Webs. 295). [VAUGHAN WILLIAMS, L.J.—If a principle is embodied in a particular combination, would it not be infringement if some one substituted mechanical equivalents? The suggestion is here that what the Defendant uses is a well-known form of spring.] It is not a spring at all, merely an air cushion. It is not a mechanical equivalent; everything in the combination was old, the
 40 dumb-bell in sections, and the resilient means. [*Terrell*, K.C.—I do not agree.] If the Patentee did not know of our way, he cannot claim what he did not invent, *Tetley v. Easton* (Macrory P.C. 48), *Rushton v. Crawley* (L.R. 10 Eq. 522). The Public have a right to be told what the Patentee claims and what he does not, so that they may know what they may use and what they may not.
 45 [VAUGHAN WILLIAMS, L.J.—By an accurate definition of what the invention is.] The Specification meant to include only metal springs, flat, curved, or spiral. Air springs are mentioned in the Provisional Specification, but are omitted in the Complete Specification. As to the state of knowledge:—(1) Ordinary dumb-bells were well known; (2) Colonel *Amoros's* Gripping Machine, to be used in
 50 gymnastic exercises, was known; (3) "*Salter's Grip*" was used for physical culture; (4) Also a dial with a spring in the middle for similar purposes; (5) "*Spencer's Grip*" had also been used in schools of physical culture, and it has the principle of Fig. 1 of the Specification. Make the handles of iron and then one has Fig. 1 of the Specification. Further, one must have a split wooden pattern
 55 in order to make a dumb-bell. Neither a split dumb-bell, *per se*, nor resilient means, *per se*, could be claimed. The Patent is for a combination of well-known means to perform their known functions. The question is whether

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Claim 2 is for a combination within *Curtis v. Platt* (L.R., 3 C.D. 135n); or within *Proctor v. Bennis* (4 R.P.C. 333). I submit the former; and that the Patentee is to be confined strictly to his combination, and the doctrine of mechanical equivalents does not apply; *Gosnell v. Bishop* (5 R.P.C. 151). The result is old. [VAUGHAN WILLIAMS, L.J.—Was there any instance of dumb-bells fitted with internal resilient springs, so as at the same time to exercise the muscles of the arm as well as of the hand and wrist?] It is true there was nothing of that kind which was called a dumb-bell, but "*Spencer's Grip*" was so used in fact. *Byrne, J.* thought that a dumb-bell was necessarily heavy. That is not so. [Terrell, K.C.—The object of the invention is the "continuous tension."] Fig. 1 is the only form of the invention indicated in the Provisional Specification. Having regard to the common knowledge, the Patent is not within *Proctor v. Bennis*. If it is within *Curtis v. Platt*, then the doctrine of mechanical equivalents does not apply, although I deny that our air cushion is a mechanical equivalent. Even if the Patent is within *Proctor v. Bennis*, the substance of the invention must be taken. *Ticket Punch Register Company, Ltd. v. Colley's Patents* (12 R.P.C. 171) shows that the doctrine of mechanical equivalents only applies if there is a new result, and then the substance must be taken to constitute infringement. *Byrne, J.*, held that a new idea or principle was involved, but I submit that the principle is to be found in *Spencer's Grip*. Even if a new principle is involved, the Defendant has carried it into effect in a totally different way and has not infringed, *Lord Halsbury, in Pneumatic Tyre Co. v. Tubeless Pneumatic Tyre Company, Ltd.* (17 R.P.C. 77). To infringe the combination the whole must be taken; (*Gwynne v. Drysdale* 3 R.P.C. 65). *Byrne, J.* based his judgment on a wrong definition of a dumb-bell. A dumb-bell has not necessarily a knob at each end. I do not say that "*Spencer's Grip*" is an anticipation, but the Specification must be construed with regard to the knowledge of the time. There are many advantages in the Defendant's dumb-bell that are not in the Plaintiff's, *e.g.*, cheapness and facility of repairs, and that you cannot come to the end of the resiliency. No workman reading the Specification could make the Defendant's machine. Having regard to what went before, there was nothing new in substance or result. [The Judgment of BYRNE, J., was read.]

Terrell, K.C., and *Clare* for the Respondents:—The first thing is to find out from the Specification what is the invention and what is claimed. There is no doubt what the Patentee meant by a dumb-bell. As to the prior knowledge, no dumb-bell was ever made in two pieces before the Patent; what was proved was that the patterns for casting them were in two pieces. A spring means something which is capable of deformation, but which reverts to its original form when the force is removed. An air ball is a curved spring. [VAUGHAN WILLIAMS, L.J., referred to the change from the Provisional to the Complete Specification, and the position of the word "curved."] In the Complete Specification the Patentee puts the matter in a general form, all reference to the material is left out, but as an air spring could not be flat or spiral, he introduces the word "curved." [VAUGHAN WILLIAMS, L.J.—All the words used refer to metal springs or the like.] As to *Curtis v. Platt* and *Proctor v. Bennis*, the Court in every case finds out what is the substance of the invention and sees whether that is taken. If here the substance is having a spring action between the parts of the dumb-bell, it is an infringement to have a spring of any kind. There is no evidence that people would not at once know that an air spring would do. [VAUGHAN WILLIAMS, L.J.—The onus is on the Plaintiffs.] [*Dugald Clerk's* evidence as to infringement was referred to.] We submit that the words are capable of a construction covering the infringement, but apart from that the substance must be looked at. Claim 2 covers all "resilient means," and therefore covers all known kinds of spring. [VAUGHAN WILLIAMS, L.J.—The claim does not enlarge the Specification.] The claim defined the invention. The Patentee meant to get the "continuous tension" coupled with the weight of the dumb-bell.

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The "continuous tension" was new, and gives a different result on the muscles of the arm. The Patentee meant a combination of this with a dumb-bell; and it is clear what he meant by a dumb-bell. [VAUGHAN WILLIAMS, *L.J.*—"Resilient" means must be of the character described in the Specification.] An air-spring is not in terms included, but it is not excluded. An air-spring is substituted for a metal spring, and the Court has to say whether the combination is taken. An india-rubber ball is a well-known form of air-spring. [VAUGHAN WILLIAMS, *L.J.*, referred to the omission of air-springs in the Complete Specification, although mentioned in the Provisional Specification, and suggested that that would have been relied on by the Patentee if an air-spring had been used before for the purpose.] The Patent would have been bad as anticipated. If so, it is an infringement. The real invention was the dividing of the dumb-bell and putting the spring in between the parts. The division of the cases into classes instanced by *Curtis v. Platt* and *Proctor v. Bennis* has been wrongly used. The question is what is the real invention? But if the invention is for an equivalent for something done before, then the substitution of another equivalent is not infringement. The question here is whether the claim is for a resilient dumb-bell or for a dumb-bell made resilient in a particular way. A Patentee is not bound to give all ways of carrying out his invention. The wording of the Specification shows that the Patentee is not describing the only forms of the invention, and Claim 2 shows what he considered the real merit of the invention to be, namely, the spring action, and that the Defendant takes.

Nicolas, in reply:—"Curved spring" is said to cover what the Defendant has, but I submit that this construction is wrong. The difference between *Curtis v. Platt* and *Proctor v. Bennis* has been often acted upon. [VAUGHAN WILLIAMS, *L.J.*—The object being new has been referred to as one of the characteristics of the difference, and it is here said that the object was new.] That is not so on the evidence. The development of the muscles by the use of springs was old, and such devices were used in exercises. [*Clare*.—The Patentee invented the use of resiliency in a dumb-bell. In *Gadd v. Mayor of Manchester* (9 R.P.C. 259 and 516), the principle of a pontoon was old for other purposes. Here the Patentee claims the use of an old principle as applied in a dumb-bell.] [VAUGHAN WILLIAMS, *L.J.*—The overpowering of springs as a physical exercise was old, and dumb-bells were old, but the Patentee, it is said, invented the combination of this in one instrument. The new object was raising the weight plus overcoming the force of the spring. Then it is said that the Defendant has a mechanical equivalent.] The difference between the grip and the dumb-bell is merely one of degree in weight. I do not say that the Patent is anticipated, but I rely on common knowledge to limit the scope of the invention. Further, although the article and object are new, the doctrine of mechanical equivalents does not apply, unless the substance of the invention is taken. The air-spring is abandoned in the Complete Specification. [VAUGHAN WILLIAMS, *L.J.*—Every process which will produce the same result is not a mechanical equivalent. If it involved invention it is not a mechanical equivalent.] [*Terrell*, K.C.—A mechanical equivalent must be that which was known to be a mechanical equivalent at the date of the Patent (*Heath v. Unwin*, 2 Webst. 236).] The *Ticket Punch* case is the leading case on mechanical equivalents; but if the Patent is not within *Proctor v. Bennis*, the doctrine of mechanical equivalents does not apply. [VAUGHAN WILLIAMS, *L.J.*—You must have invention, otherwise your device is left as a mechanical equivalent; what is your invention? Is it the discovery of the air-spring?] [*Terrell*, K.C.—With reference to air-springs being omitted from the Complete Specification, *Aktiebolaget Separator v. Dairy Outfit Company* (15 R.P.C. 327) decided the exact point.] [VAUGHAN WILLIAMS, *L.J.*—There were there two descriptions of one thing, and the Patentee only in the Complete Specification adopted one description.] The Complete Specification is the

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dominant document. The omission of air-springs in the Complete Specification shows the Patentee's intention, and is almost an invitation to the public to use those. If the Patentee knew of the Defendant's device he ought to have disclosed it; if not, he cannot claim an improvement of which he was ignorant. The whole of the Complete Specification applies only to metal springs. The Statute says that the Patentee shall describe his invention. The Defendant has not a spring at all, his combination is quite different. I submit that the combination is of a *Curtis v. Platt* type; but, if not, the pith and marrow are a flat, curved, or spiral spring. Even where there is a new principle another person may carry it into effect by different means. The Patentee is bound to disclose any improvement in his Complete Specification; so if here he knew of our improvement his Patent is bad for not disclosing it.

VAUGHAN WILLIAMS, *L.J.*—I find myself with great deference to Mr. Justice *Byrne* unable to come to the same conclusion as he came to here.

I will deal in a moment with the nature of the invention described in the Specification of *Robinson's* Patent, but before I do that I want to say a word or two with regard to the state of knowledge in relation to these mechanical appliances that are used for the cultivation of a man's bodily strength in a gymnasium. I thought at one time that in this case the real invention at which *Robinson* arrived was, that there being undoubtedly knowledge at the date of his Patent that you might substitute as an exercise of strength for over-powering weight, which formerly had been really the subject-matter to which strength was applied, the strength of a spring, and it being also known that you might educate the human muscles by either of these processes—you might apply the muscles to the lifting of weights, and you might apply the muscles to controlling the force of springs—it seemed to me at one time that *Robinson's* Patent was the first Patent in which those two modes of exercising and educating human muscles were combined in one machine or instrument. If that had been so, I should have been disposed to say myself that the result sought to be attained by *Robinson's* Patent was a new result; but when I came to look at the evidence I came to a different conclusion. I came to the conclusion, on the evidence, that the exercise of the human muscles in controlling a spring had, at the date of this Patent, been so appreciated by those who were engaged in this sort of business, that it had really become known generally that you might substitute for weight, whenever you wished, the controlling of the power or force of a spring.

I have before me the judgment of Mr. Justice *Byrne* in the Reports of Patent Cases, volume 21, page 39, and I find that Mr. Justice *Byrne* said: "As to the 'alleged prior publications I do not find that the Specifications or the passages 'from the 'Manual Complet d'Education Physique' show prior publication.'" Stopping there I may say that these publications were not put in for the purpose of proving prior publication; they were put in simply and solely for the purpose of showing the state of knowledge at the date of *Robinson's* Patent. Mr. Justice *Byrne* goes on: "Neither *Spencer's* Grip, nor *Salter's* Dynamometer 'have any resemblance to dumb bells. To exercise fingers and wrists and to 'measure strength of grip are objects quite different from the objects of dumb-bells which are to exercise the muscles of the arms as well as of the wrists, 'hands and fingers. The notion of swinging any of the things referred to in 'dumb-bell fashion is absurd.'" But when I look at the evidence of Mr. *William Henry Freeman* upon page 28 in the shorthand writer's transcript, I find this. He is asked the question: "Were you a member of the Weight 'Lifting Club?" (A.) "Yes." (Q.) Did you know *Spencer's* Grip and did "you use it there?" (A.) "Yes." (Q.) "About what year?" (A.) "As 'near as I can say about eight or nine years ago"—so that is a date prior to *Robinson's* Patent. (Q.) "For what purpose did you use it?" (A.) "For 'measuring the strength of the fingers and for the development of the 'fore-arm. Not only the upper part of the arm but the other." That seems to

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me to come out to exactly the same thing that the dumb-bell exercise does; but the question goes on: "Was it used for the same purpose as *Robinson's* thing "was used?" (A.) "Yes." (Q.) "Did you also use these other things *Salter's* "dynamometer?" (A.) "Yes, and I have seen them used in various public-
 5 "houses. There used to be a man going about the streets with one of these "kind of things for trying the grip of the hand." I do not think that I need read any more of this, excepting that he says again, which is only repeating what he said before: "I could use *Spencer's* grip as a dumb-bell for "strengthening the arms." (Q.) "But you could not use it as a dumb-bell?"
 10 (A.) "Yes." Of course it would not be sufficient that the witness should say you could so use it, but in the earlier part of his evidence it seems to me that he did so use it; and as to this evidence I am reminded that there is no cross-examination whatsoever.

The conclusion I have come to with regard to this evidence is that it negatives
 15 the suggestion that it was a novelty to attain by *Robinson's* Patent the result that you could, in machines used for the very exercises for which dumb-bells are used, utilise the over-coming of the force of the spring as a substitute for weight. I felt less hesitation in saying that this was the state of knowledge, which is described by this witness, because the view that he takes is really a
 20 view that is indorsed by *Sandow* in his advertisement, and most emphatically indorsed. I need not read the advertisement at length, but the substance of the portion of the advertisement to which I am referring is this:—He is speaking of the annoyance of having to change your dumb-bells as you grow either older or stronger, and want some heavier test upon which to exercise your strength.
 25 He says that the user of these dumb-bells, supplied with these springs, which the pupil is to grip, does away with the necessity of constantly changing your dumb-bells, which amounts, as I understand it, to this—that the grip of the spring is substituted for the weight of the dumb-bell in the exercises.

It seems to me, for the reasons I have just given, that it is impossible for the
 30 Plaintiffs under *Robinson's* Patent to claim that his dumb-bells achieve a new and an unknown result.

Having started with that, let me look at the Specifications. We find on page 1, beginning at line 8, in the Provisional Specification:—"My invention consists of one or more flat steel springs, steel spiral springs, rubber
 35 "springs, or compressed air springs, or a combination of these several springs, "attached to the interior, or in the handle portion of the dumb-bell, in such a "position and manner as to cause the dumb-bell to be firmly grasped when in "use." When we come to the Complete Specification, we find that passage very materially altered. It appears upon line 5, page 2, of the Complete
 40 Specification:—"The invention consists principally in the application of flat, "curved, or spiral springs, or a combination of several springs, to the interior or "to the handle portion of the dumb-bell in such a position and manner that, "when in use, the grasp on the handle will cause the spring or springs to be com- "pressed. The dumb-bells may be constructed of wood, compressed pulp, metal,
 45 "or other suitable material." I have read the last two lines only as confirmation of what I have already said, of how completely the Patentee takes the view that the spring and the grip, or the compression of the spring, is substituted for the weight. He does not consider that it is necessary that his dumb-bells should be constructed of any weighty material. But to go back to the com-
 50 parison of these clauses, it will be seen that the words "rubber springs or "compressed air springs" are left out. Those words, which are in the Provisional Specification, are left out in the Complete. Then when we come to the Complete Specification, "steel" is left out, and we have got "flat, curved, or spiral springs." "Curved" did not appear in the Provisional Specification. Now what is the
 55 meaning of these words in the Complete Specification? Mr. *Terrell's* suggestion was that the Patentee only meant to describe more briefly than he had done in the Provisional Specification, the identical springs which he had thus described

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in the first instance and he suggested that the word "curved" which appears in the Complete Specification, was meant to cover "rubber springs or compressed air springs." Mr. *Dugald Clerk*, who was called as a witness, does not agree with him there. He says, and says in the plainest possible manner, that in his judgment the words, "flat, curved, or spiral springs," refer to metal 5 springs, and do not cover that, which I will call for shortness, the springs in the Defendant's dumb-bells, which are pneumatic cushions. What Mr. *Dugald Clerk* says is this. Although he takes the view that the words, "flat, curved, or "spiral springs," only refer to metal springs, yet he thinks that these words do not exclude the pneumatic cushion springs, and that the user of the word "princi- 10 pally" in line 5 prevents such springs—that is the pneumatic cushion springs—from being excluded. Well, I do not, as a matter of construction, arrive at the same view that the witness arrived at. It is quite plain that in the Provisional Specification there is a specific sort of spring described, which is plainly omitted in the Complete Specification. What is the proper inference to draw from that? 15 I cannot agree with the conclusion of Mr. Justice *Byrne* upon this point. On page 39. He says: "The first point to notice on the Specification is that there is no reference in the Complete Specification to compressed air springs specifically, "such a reference having been contained in the Provisional Specification, but "reading the two fairly I do not think that it is left out as an abandonment of 20 "any form of spring. The Complete Specification leaves out the word 'steel' "in reference to the flat, curved, or spiral springs, spoken of in the Provisional Specification, and it obviously would take in whalebone, cane, india-rubber, "compressed air, or metal of any kind, such as copper, aluminium, iron, or any- "thing else in the nature of a spring, which would give the effect the Patentee 25 "desired to produce. I think the intention is to enlarge and not to diminish the "nature or material of the springs as mentioned in the Provisional."

I prefer in construing this Specification to deal with it in the way described in the Judgment of Sir *George Jessel* in *Stoner v. Todd*, (L.R. 4 C.D. 58). He said: "That being so, we do not find, as a rule, that complete description 30 "in a Provisional Specification which is required to enable a workman of "ordinary skill to carry out the invention. When we find in the Final Specification that, in the description of one of the subordinate matters of the "invention, one of the details has been abandoned, that is a notification to the "public that the inventor could not work it, or thought it useless, and 35 "consequently omitted it altogether." That is the view I take of this Specification. I think that the natural inference to draw from the inclusion in the Provisional Specification of the compressed air-springs, is that the Patentee had such a spring present to his mind at the time when he drew his Provisional Specification, but that between that time and the Complete 40 Specification, he arrived at the conclusion that it was not feasible to apply the pneumatic cushion spring to dumb-bells for this purpose. And when I look at the Defendant's dumb-bell I can quite understand that a Patentee, and even an ingenious Patentee, when he came to try to utilise a pneumatic cushion as a spring for the purpose of these dumb-bells, found that it was 45 not easy to invent a mode by which he could do this. I find no difficulty, therefore, in coming to the conclusion that *Robinson*, the Patentee, did omit the reference to the air spring for the reason that he found he could not work it, and thought that for this purpose it was useless.

If I once come to the conclusion that the nature of this invention was not 50 such that the result was new, and come to the conclusion that the Patentee abandoned the pneumatic cushion spring as not suitable for his invention, the only question I have to ask myself is—Can it be said in this state of circumstances that the pneumatic cushion spring was a mere mechanical equivalent for the metallic springs which are described in the Complete Specification? I 55 wish to say in passing, as I have used the words "metallic springs," that I only use those words because it is a convenient heading under which to collect

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the sort of springs that are described in the Complete Specification, but I do not mean to say that in my judgment the words of the Specification are limited to metallic springs. I agree with Mr. Justice *Byrne*, to take one example, that a whalebone spring would plainly come within the words.

5 The words cover any spring which, whatever might be the material of the spring, would be capable of taking the "flat, curved, or spiral" form which, of course, could be taken by steel springs—by all metallic springs, and not alone by those, but also by whalebone and other springs. The question which I have to ask myself is—Can it be said under these circumstances that
10 these pneumatic cushion springs are a mechanical equivalent for the springs described in the words to which I have just referred? I think not. One has a right to start with this assumption that the Patentee did not himself think that for this purpose you might use whichever of these two forces you liked, that is the resilient force coming from the pneumatic cushion
15 and the resilient force coming from the metallic springs. I do not consider that he thought so, and when I look at the Defendant's dumb-bells I am of opinion that, so far from this being a known mechanical equivalent, it required considerable invention to find out that you could use pneumatic springs for this purpose. As I understand the rule about known mechanical equivalents it is
20 not sufficient in the application of the rule to say that the particular form of spring, *qua* spring, was known. It must be known as a form of spring which could be used for this very purpose. I do not mean to say that it need have been actually used at some prior time for that purpose, but I mean that I do not think that it ought to be treated as a mere colourable imitation of a step in the
25 Patentee's combination if the nature of the substituted step taken is of such a character that it would not be present to the mind of a workman or other person conversant with this sort of matter that he could substitute the one form for the other. I think in this case that the majority probably, if not all, of the people concerned with this sort of matter, having read *Robinson's* Specification, would not arrive at the conclusion: "Oh, if I like, I may have a pneumatic
30 "cushion spring instead of a metal spring." I think it required considerable thought and invention to arrive at that conclusion. It would not be enough for the Defendant to show that his dumb-bell is an improvement upon *Robinson's* dumb-bell. He must do more than that. In my judgment his dumb-bell
35 differs, and differs substantially, from the combination dumb-bell described in *Robinson's* Specification.

Under these circumstances, as I do not think that this is a case of mere substitution of a mechanical equivalent, I am of opinion that this appeal ought to
40 succeed, and that the Plaintiffs cannot say that the Defendant's dumb-bell is an infringement of their Patent.

STIRLING, *L.J.*—This is an action for infringement of a Patent taken out in 1898 for "Improvements in dumb-bells for physical culture exercises." I need not say that in the year 1898 dumb-bells were very well known as a means of
45 improving and developing the strength of the muscles of the arms and of the shoulders; and, speaking broadly, the improvement which is claimed by the Patent is a combination of a dumb-bell with a spring, the dumb-bell being an ordinary dumb-bell divided into halves, with a spring placed between the halves in such a way as to cause, as the Patentee states in his Specification, a continuous tension of the muscles of the arms, wrists, and hands.

50 At the date of the Patent, the use of springs for developing and strengthening the muscles of the hands and fingers and the wrists, was known, but the learned Judge in the Court below took the view of the evidence that the combination which is patented by *Robinson*, the Patentee, was the first instrument which combined the advantages in physical culture of the dumb-bell and of the
55 spring as used for strengthening the muscles of the shoulders, arms, wrists, hands, and fingers. If that be the true view of the evidence, I, speaking for myself, should have great difficulty in departing from the conclusion at which

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the learned Judge ultimately arrived. I say no more than that, because there is one point which, if it were necessary, I should desire to consider a little further than I have done, namely, what would be the effect in that case of the peculiar circumstance that the Patentee in his Provisional Specification has claimed the use of rubber springs and of compressed air springs, which he does not mention in his final Specification? Subject to that, as at present advised, I should agree with the view that was taken by Mr. Justice *Byrne*. But our attention has been called to the evidence of Mr. *William Henry Freeman*, and my learned brethren are of opinion that that evidence shows that there was in use at the date of the Patent an instrument, known as *Spencer's Grip*, which was in fact used at once for the purpose of a dumb-bell and also for the purpose of giving strength to the muscles of the fore part of the arm, and of the wrist, and of the hands and fingers. Speaking for myself, I will only say that I do not feel entirely sure that was the true view of the evidence, but that is a matter in which I think it would be unbecoming of me to differ from my brethren, and if that view of the evidence be taken, I think there is a very material difference in the principle which is to be applied to the construction of the Patent. Therefore, with that reservation, I agree with what has been said by my Lord in the conclusion he has arrived at.

COZENS-HARDY, *L.J.*—I am of the same opinion, and I have very little to add. As a matter of construction, first, of the Provisional Specification, and next, of the Complete Specification, two points seem to me to be reasonably clear. In the Provisional Specification, the Patentee had an idea, which he put into writing, that he had an invention, consisting of, amongst other things, either flat steel springs, spiral steel springs, rubber springs, or compressed air springs. It is quite clear that he then thought that compressed air springs would work with this invention. When we come to the Complete Specification, he uses words which, to my mind, perfectly clearly show that he did not intend to include air springs. The words there used are—"The invention consists principally in the application of flat, curved, or spiral springs, or a combination of several springs." It was argued rather faintly by Mr. *Terrell* that an air cushion or an air spring might fall within the meaning of the words "curved spring." Well, his own expert witness, Mr. *Dugald Clerk*, dealt with that very shortly. I am reading from the Judge's notes—"Line 5, page 2, refers to 'metallic springs; would cover a whalebone spring or any metal, flat, curved, or spiral; do not include air springs.' Then he goes on to say—"But do not exclude it because of the word 'principally' there used." Well, I ask myself, why this change between the Provisional Specification and the Complete? Why the dropping out of the air cushion? The inference I draw is that the Patentee in the interval between his Provisional Specification and his Complete had either come to the conclusion that an air spring would not work, or that at least he did not know whether it would work or would not, and that, in fact, by abandoning that part of his Provisional claim, he said—"I do not claim the air cushion; you may use it if you can."

That being so, it seems to me it is too late for him to now rely upon the general words in his Complete Specification on the ground that the substance of his invention has been taken. He cannot call that a known mechanical equivalent which he did not, at the time when he took out his Patent, recognise as a mechanical equivalent, but which, on the contrary, he deliberately excluded.

I will not say anything more except on the one point, and it is a very short point, upon which Lord Justice STIRLING has expressed a doubt. It really turns, I think, entirely upon the true meaning and effect of those very few sentences from the evidence of Mr. *William Henry Freeman*, which have been read by my Lord, and as to which I may say there was no cross-examination of any kind. It does seem to me that that evidence must be accepted, and, being accepted, we are not dealing here with what may be called a "master" Patent. We are simply dealing with a Patent which seeks to attain a known object by

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one particular means. The learned Judge's note of that evidence seems to me really to give the pith and marrow of it. The note says—"Knew *Spencer's* "Grip about eight or nine years ago. Was used to strengthen arm." If that be so, this cannot be regarded as a master Patent; it must be regarded simply as a
 5 combination Patent, and as, I think, a combination Patent with this peculiarity about it, that the Patentee has deliberately excluded one particular kind of spring, and said in effect to the public, "You may use this without infringing "my Patent."

Nicolas.—I ask that the appeal be allowed with costs here and below, and for
 10 the usual certificate that the Particulars of Objections were reasonable.

VAUGHAN WILLIAMS, *L.J.*—Yes.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE SWINFEN-EADY.

March 25th, 1904.

15 BADISCHE ANILIN UND SODA FABRIK v. CHEMISCHE FABRIK VORMALS
 SANDOZ IN BASEL.

Patent.—Action for infringement.—Practice.—Service of Notice of Writ out of jurisdiction.—Motion to set aside.—Order XI., rule 1 (f.)

*The owners of a Patent obtained leave to serve Notice of the Writ in an action
 20 for infringement of a Patent on the Defendants out of the jurisdiction. After service the Defendants moved to set the proceedings aside. In answer to the affidavit filed on behalf of the Plaintiffs, the Defendants filed affidavits stating that the substance sold by them was a different product made by a secret process, which was altogether different from the Plaintiffs' specified process.*

25 *Held, that the Plaintiffs, having made out a primâ facie case of infringement within the jurisdiction, the Order for service out of the jurisdiction was rightly made.*

Held, also, that there being a conflict of evidence on the facts, the matter could not be disposed of on motion.

30 *Order XI., r. 1 (f) does not enable the Court to direct service out of the jurisdiction of a Writ claiming damages for infringement of a Patent which has expired at the date of the Writ, although an injunction is also sought in respect of another Patent.*

Badische Anilin und Soda Fabrik v. Chemische Fabrik vormals Sandoz in Basel.

On the 10th of February 1904, the *Badische Anilin und Soda Fabrik* commenced an action against the *Chemische Fabrik vormals Sandoz in Basel*, claiming an injunction to restrain infringement of Letters Patent, No. 14,723, of 1891, and damages, or an account of profits in respect of infringement of Letters Patent, No. 15,374, of 1887; and also in respect of Letters Patent, No. 14,723, of 1891, delivery up and costs. 5

This was a motion by the Defendants, that the Order dated 8th February 1904, giving the Plaintiffs leave to issue the writ in this action with liberty to serve the Defendants with notice thereof in Basel or elsewhere in the confederation of Switzerland might be discharged, and that the service both of the writ and of the notice of the writ might be set aside, and that all further or other proceedings in the action might be set aside on the ground that the Defendants were not subject to the jurisdiction of this Court, and that the Order was obtained upon an insufficient affidavit containing misstatements of facts. 10

The Defendants were a firm of Swiss manufacturers carrying on business at Basel, in Switzerland. In pursuance of the Order of 8th February 1904, notice of the writ was duly served by Dr. *Ehrhardt*, one of the Plaintiffs' chemists in Basel, on the Defendants on the 3rd of March 1904. 15

The Plaintiffs alleged that the Defendants had infringed their Patent of 1891, by importing and selling within the jurisdiction, a substance which was identical with that of the Plaintiffs under the name of "Rhodamine G" or "Pink G." 20

The Defendants, on the other hand, alleged that the substance imported and sold by them was not an infringement of the Plaintiffs Patent of 1891, but was a different product, made by a secret process which was altogether different from the Plaintiffs' specified process. The effect of the evidence sufficiently appears from the judgment. 25

The motion was heard on the 25th of March 1904.

Asquith, K.C., and *Colefax* (instructed by *G. B. Ellis*) appeared for the Defendants; and *Moulton*, K.C., *Cripps*, K.C., and *J. C. Graham* (instructed by *J. H.* and *J. Y. Johnson*) appeared for the Plaintiffs. 30

Asquith, K.C., and *Colefax* for the Defendants.—The Order for service out of the jurisdiction ought to be discharged. The writ in the action claims damages for infringement of the Patent of 1887. At the date of the writ that Patent had expired, and consequently no injunction could be granted under Ord. XI. r. 1 (f) in respect of its infringement. The Court had therefore no jurisdiction to direct service of the writ out of the jurisdiction in such a case. As regards the Patent of 1891, the Defendants are a foreign Company domiciled abroad, and ought not to be brought over here to defend an action on such materials as are now before the Court. The Plaintiffs have made out no *prima facie* case of infringement. 35 40

Moulton, K.C., and *J. C. Graham* for the Plaintiffs.—The question in this case is not one of jurisdiction, but whether the statements of the Plaintiffs or of the Defendants are correct. The Plaintiffs are seeking relief in respect of something done in England. There is no tribunal, except an English tribunal, which can grant them relief. It is not a question of choice of *forum*, but a question of relief or no relief. If a party is voluntarily and properly here, the Court will not limit the number of causes of action. There is no reported case in which the Court has struck out a cause of action. [SWINFEN-EADY, J. 45 50
—I am against you on the point that because the Plaintiffs have one cause of action you can tack on other causes of action not within Order XI.] If the Court is of opinion that the writ should only include the Patent in respect of which the injunction is asked, the Plaintiffs consent to the writ being amended by confining it to that Patent. [SWINFEN-EADY, J.—I am clearly of that opinion.] 55

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Colefax replied.

SWINFEN-EADY, J.—This is a motion to discharge an Order for service out of the jurisdiction. It extends to two matters. It is said that the writ claims damages for the infringement of a Patent which had expired at the date of the writ, and that Order XI. does not enable the Court to direct service out of the jurisdiction in such a case. Order XI., Rule 1, sub-rule (f) provides for service out of the jurisdiction where any injunction is sought as to anything to be done within the jurisdiction, whether damages are or are not also sought in respect thereof. That obviously means in respect of the same matter as that in respect of which the injunction is sought, and one of the Patents having expired, there can be no injunction with regard to the infringement of that Patent. Therefore, it seems to me that in so far as the writ claims damages for infringing a Patent already expired, leave to serve such a writ out of the jurisdiction ought not to be granted. But the Plaintiffs have met the matter by submitting to have their writ amended, and undertaking to amend it so far as it seeks damages in respect of that Patent. On the writ being so amended that point is got rid of.

But the other point is the more material one. The Plaintiffs claim for the infringement of a Patent of 1891, which is, putting it shortly, for converting a substance, or dealing with a substance called tetra-ethyl-rhodamine, or Rhodamine B, and treating it as the raw material, and by applying a process to it converting it into a dye of a different colour, which is called Rhodamine G. The Plaintiffs allege that the Defendants infringe that Patent within the jurisdiction, by selling a substance identical with their substance—according to the language of Dr. *Ehrhardt*, the self same product, or an identical product—and they sell it under the name of Rhodamine G, or Pink G. There is no dispute that a substance is sold by agents of the Defendants within the jurisdiction under those two names “Rhodamine G” and “Pink G,” and similar substances but in a more concentrated form with the word “concentrated” or “extra” on them. The sale, therefore, of the substance within the jurisdiction is not a matter of dispute. The Defendants allege that that substance sold by them is made by a process which is not an infringement of the Plaintiffs’ Patent.

The evidence stands in this way. On behalf of the Plaintiffs Dr. *Ehrhardt* deposes that there is no process known to science, or that is generally known to science, or described in chemical literature, or which is the subject of general knowledge, and he is not aware of any other process than the Plaintiffs’ Patented process—the process described in their Specification—by which Rhodamine B is converted into Rhodamine G. Dr. *Ehrhardt* also states that the product originally called by the Plaintiffs Rhodamine B has been sold by the Defendants as Pink B, and under other names. That is outside this cause of action; that is the old Patent. The material part of his affidavit is this—“And similarly Rhodamine G has been sold “by them as Pink G, but in many cases the Plaintiffs’ names, Rhodamine B “and Rhodamine G, have been used by the Defendants for the self-same “products.” In other words, that the Defendants have not only sold the identical substance, sold by the Plaintiffs as Rhodamine G, as Pink G, but they have also sold it by the same name as the Plaintiffs’ name—the self-same substance—as Rhodamine G. Dr. *Ehrhardt* denies that the two dyes sold by the Plaintiffs and Defendants respectively are chemically quite different, as the Defendants allege, and he says he cannot understand how that statement is made, and that he emphatically contradicts it.

On the other hand, the Defendants in substance say this: “True it is, or may “be, that there is no process generally known to science, as a matter of common “scientific knowledge, by which Rhodamine B can be converted into Rhodamine “G, but we know a secret process, and it is by the employment of this secret

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"process, which is altogether different from the Plaintiffs' specified process, that
"we make the substance which we sell." They further say that their product
is not the same as that of the Plaintiffs, but chemically differs from it; that
applying one test, namely, the test of solubility, different results are given with
regard to their product and the Plaintiffs' product; and they pray in aid the 5
evidence of a skilled chemist who says that the Defendants' secret process has
been communicated to him; and that he has obtained a product by the use of that
process which is identical with the product made and sold by the Defendants,
but which differs in certain respects from the product made and sold by the
Plaintiffs under the same name. That, shortly, is the way in which their case 10
is put. I read the affidavit of Dr. Ehrhardt as denying *in toto* that the
substances are chemically quite different.

Under these circumstances I am clearly of opinion that there is an issue to be
tried between the Plaintiffs and the Defendants, and that the Plaintiffs have
made out a *prima facie* case. Whether the Defendants' process is a different 15
one, as they allege, or not, and whether the substances are the same, or chemically
different, are matters for the trial. Their evidence must be tested by cross-
examination, and when once the Court has come to the conclusion that the
Plaintiffs have made out a *prima facie* case of infringement of their Patent 20
within the jurisdiction—a fair case for trial—in my judgment that is a case in
which an Order for service out of the jurisdiction not only may be made, but
ought to be made; because it is open to this, that unless the Plaintiffs have
leave to serve the writ on a foreigner, or serve notice of the writ out of the
jurisdiction with a view to trying the action in this country, where is the action 25
to be tried; where is that issue to be determined? Courts in England do not
try the infringement of foreign Patents abroad. In the same way cannot I
assume that the Courts of foreign countries would try the infringement of
what they would deem to be foreign Patents—that is to say, try any issue of
the infringement of an English patent in England? This is the country in 30
which that issue, properly raised, ought to be determined.

Under these circumstances I am clearly of opinion that I cannot try that issue
on a motion to discharge the Order for service out of the jurisdiction, and that
in so far as the motion asks for that discharge it fails and must be dismissed;
and I think that it is proper, having regard to the other Patent, to make the costs
of both parties costs in the action. 35

Colefax asked for leave to appeal.

SWINFEN-EADY, J.—I do not think it is a case in which I ought to grant leave
to appeal. The question is only whether the matter should be tried or not. I
therefore refuse leave.

Woolley and Son v. Morrison.

IN THE COURT OF SESSION IN SCOTLAND.

INNER HOUSE.—SECOND DIVISION.

Before THE LORD JUSTICE CLERK, LORDS TRAYNER AND MONCRIEFF.

December 10th, 1903, and February 26th, 1904.

5

WOOLLEY AND SON v. MORRISON.

Trade name.—Name embossed on bottles.—Alleged passing off and deceit.—Action to restrain.—Interdict refused by the LORD ORDINARY and by the INNER HOUSE.

W. & S. and also M. were beer bottlers and possessed bottles on which, as in the
 10 *case of other Edinburgh bottlers, their respective names were embossed, and in*
which they bottled beer or aerated waters which they did not brew or make.
Prior to the institution of a "Bottlers' Exchange" in March 1902 (which
"Exchange," however, did not comprise all the members of the trade), the practice
of the trade justified the retention by individual bottlers of other bottlers' bottles,
 15 *returned in exchange for their own, and filling them and sending them out*
again as if they were their own. After March 1902, each bottler was supposed
to get back and fill only his own bottles, and individual bottlers tried to prevent
their rivals filling bottles embossed with any but their own names. In December
 20 *1902, W. & S. found in a grocer's shop seventeen of their bottles marked with their*
name, bearing also the name of the brewer but not of the name of any bottler,
although they had been filled by M. W. & S. thereupon sought to interdict M.
from filling their bottles and sending them on the market, on the ground that
by doing so M. represented that the beer so bottled and sold by him was beer of
W. & S.'s bottling.

25 Held, by the LORD ORDINARY, that *W. & S. had failed to prove that the*
Respondent's use of their bottles deceived the trade or the public, or was in the
circumstances fitted to deceive the trade or the public. Interdict was refused
with expenses. W. & S. reclaimed. The INNER HOUSE adhered to the Judgment
of the LORD ORDINARY.

30 This was an action of suspension and interdict, the Note being presented to
 the Court on the 22nd of January 1903. The Complainers were *Charles Woolley*
& Son, beer bottlers and aerated water manufacturers, 49 Elm Row, Edinburgh.
 The Respondent was *William Morrison*, wholesale bottler, 2 King's Road,

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Portobello. Both dealt (*inter alia*) in beer, ales, and stout, which they obtained from the brewers in bulk in barrels or otherwise and drew off from the barrels into bottles, which they sold to their customers and the public generally. Along with the beer, ale, or stout the brewers sent adhesive labels printed with the brewer's name, which were gummed on to the bottles before they were sent out. These printed labels sometimes had the bottler's name on them as well as the brewer's; sometimes they bore the brewer's name only. The Complainers also manufactured mineral waters, but they did not manufacture beer, ale, or stout, or any other liquor in which the Respondent traded. The Respondent did not manufacture or bottle mineral waters. The Complainers, for the purposes of their business, owned a large number of bottles upon which their name was marked. The name was, in most instances, moulded on to the bottle in the process of manufacture, but in many cases it had been engraved, sand-blasted, or otherwise put upon the bottles by a subsequent process.

There was a contract between wholesale bottlers in Edinburgh and district, whereby they formed themselves into an association called the *Edinburgh and District Aerated Water Manufacturers Defence Association, Ltd.* The members of the said association were, by the terms of their said contract, permitted to lift each other's beer, ale, stout, and aerated water bottles, from which they selected those branded or marked with their own name. They then sent those which did not belong to them to the bottle exchange or clearing-house of their said association, in order that they might then be sent to their respective owners. The contract was based on the expectation that each bottler would receive back the whole of his own bottles through the medium of the bottle exchange. The Respondent was not a member of the bottle exchange, and had never received authority to lift or use the Complainers' named bottles.

The Complainers averred that "The Respondent has in the past been using " for beer, ales, stout, or aerated waters of his own bottling or manufacture " bottles bearing the Complainers' name, and the Respondent may continue the " practice to the detriment of the Complainers' business. The Complainers " object to their name being used as if they were the bottlers or manufacturers, " in sales of beer, ales, stout, or aerated waters which are not bottled " by them." They said that they had expended great industry, care, skill, and capital in the development and extension of their trade as bottlers, which could not be maintained unless their trade name moulded on their bottles was protected. Their reputation depended on the bottles bearing their name being really filled by them. In particular they averred that the Respondent had sold beer bottled by him in bottles moulded with the name of the Complainers to *James Smith*, grocer, 160 Morrison Street, Edinburgh, on the 6th and 12th of December 1902. They asked that the Respondent should be interdicted from "selling or exposing for sale, or from having in his " possession for sale or for any purpose of trade, beer, ales, stout, or aerated " waters, or any other alcoholic or non-alcoholic drinks, not bottled or manufactured by the Complainers, contained in bottles which bear the name of the " Complainers either impressed, embossed, engraved, sand-blasted, moulded, or " otherwise marked thereon, or which have the Complainers' said name in any " way exhibited thereon." They also asked for interim interdict.

The Respondent in his Answers explained that when he sent out his bottled beer a charge was made for the bottles, a rebate being given for their value if and when they were returned. "This is the invariable rule in the wholesale trade, and it is the rule followed by the Complainers. In the course of business it occasionally happens that certain of the bottles returned to the Respondent are not plain bottles, but bottles marked with the names of other wholesale traders who use bottles stamped with their name. It is admitted that the Respondent may have sold to retail traders beer or stout bottled by his servants in a bottle or bottles so marked, and that some of such bottles

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"may have been marked with the name of the Complainers. Such cases are, however, accidental and exceptional. The name of the manufacturer of the beer, which is stated on the label, is the only matter of the slightest importance to, or which is in any way regarded by, members of the public in purchasing same. The name, moulded or otherwise, placed upon the bottle is not understood by the public as in any way referring to the bottler of the contents, and the public are in this respect in no way misled or deceived." The Respondent said that "had any complaint been made to him by the Complainers with regard to their marked bottles, or had he been asked not to use their marked bottles, he would have been quite willing, and he hereby expresses his willingness, to take every reasonable precaution against receiving into his premises any bottles marked with the Complainers' name, or selling beer or other liquors in bottles thus marked." There was no averment on the part of the Complainers that any warning had been given to the Respondent except that the *Edinburgh and District Aerated Water Manufacturers' Defence Association*, the "Bottle Exchange" to which the Complainers belong, had on 1st March 1902 and frequently thereafter, inserted an advertisement in the "Scotsman" newspaper notifying that the members of the association would fill and send out only their own bottles, and giving warning that any person found filling, dealing in, selling, illegally retaining, damaging, or destroying any bottles, &c., which were the property of members of the association would be prosecuted for infringing the rights of property of said members. A list of members of the association containing the names of the Complainers was appended to this advertisement.

On the 5th of February 1903, Lord PEARSON, Lord Ordinary on the Bills, having heard Counsel upon the Note and Answers, passed the Note from the Bill Chamber to the Court of Session, but refused interim interdict.

The Record was closed on the 4th of March 1903, and the case was sent to the Procedure Roll. On the 29th of May 1903, after Counsel had been heard on the relevancy, the LORD ORDINARY ordered a proof.

This was taken on 10th of November 1903. From the Proof it appeared that, prior to the institution of the "Bottle Exchange" in March 1902, the practice was for bottlers who had sent out full bottles to receive back an equal number of empty ones in exchange, without regard to whether these empties were plain glass bottles or were stamped with their own name or with the name of another bottler. They would then fill these returned empties and send them out again. After the institution of the "Exchange" a kind of clearing house was established for the benefit of its members, to which all the bottles were sent to be sorted out, each bottler receiving back those marked with his own name. Many members of the trade are not members of the "Exchange." These could get their bottles from it on payment of a small commission. The Complainers themselves, before the institution of the "Exchange," were indifferent what bottles were returned to them, but after it was formed they endeavoured with its aid to obtain the return of, and to get control over all their own bottles, yet they still accepted plain-glass bottles in exchange for their own. Suspecting that their bottles were being used by other bottlers they sent round to various shops, and found in that of *James Smith*, grocer, 160 Morrison Street, Edinburgh, three bottles stamped with their name, but filled by the Respondent and delivered by his servants to *Smith* on the 6th of December 1902, and fourteen, similarly stamped, filled by the Respondent and delivered to *Smith* on the 12th of December 1902. Ten of these bottles were marked "*C. Woolley & Son*, 49 Elm Row, Edinburgh," and the remaining seven "*C. Woolley & Son*, Edinburgh." They had all conspicuous adhesive labels giving the name of the brewer of the beer they contained but no bottler's name.

After hearing Counsel on the evidence, Lord KYLLACHY took the case to a vizandum, and on 21st November 1903, pronounced the following

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interlocutor :—The LORD ORDINARY, having considered the cause, refuses the prayer of the Note, and decerns : Finds the Respondent entitled to expenses, and remits the account thereof when lodged to the Auditor to tax and report. For the LORD ORDINARY'S Opinion, see *supra*, p. 67.

The Complainers reclaimed to the Second Division, the reclaiming Note 5 being boxed on December 10th 1903.

At the hearing on the 26th of February 1904, there appeared for the Respondent *C. D. Murray* and *G. H. Henderson* (instructed by *Kelly, Paterson & Co.*, S.S.C.); for the Complainers, *Campbell*, K.C., and *A. A. Fraser* (instructed by *G. A. Eadie*, S.S.C.) 10

For the Complainers, it was contended that they were entitled to interdict the Respondent from making use, without their leave, of the bottles which were the Complainers' property, and that they were entitled also to interdict the Respondent from using their trade name embossed on the bottles by which a misrepresentation was made to the public, and that although there was no intent 15 to defraud. The following authorities were cited :—*Merchandise Marks Act* 1887 sects. 2 (2), 3 (3), 5 (1c), (2), (3); *Rose v. Loftus* (57 L.J. Ch. 576); *Thwaites & Co. v. McEvilly* (116 Law Times 313); *Millington v. Fox* (3 M. & C. 338); *Reddaway v. Banham* (13 R.P.C. 218; L.R. 1896 A.C. 199).

Counsel for the Respondent were not called upon. 20

THE LORD JUSTICE CLERK.—Much of the argument which we have heard has been addressed to the question of an infringement of Trade Mark contrary to the provisions of the Merchandise Marks Act, but there is no averment as to the Statute on record. However, taking the case upon the merits, if the Complainers could show that there had been fraudulent use of any device belonging 25 to them they would be entitled to interdict. From the evidence it appears perfectly clear that until the institution of the Bottle Exchange in March 1902, it was quite common for bottles to be sold with the name of one person on the label and the name of another embossed on the bottle. The fact that the Defence Association was instituted is in itself proof of this indiscriminate use 30 of marked bottles. Now, it cannot be said that because such an association was formed and advertised in the newspapers such a practice can be set aside in a day. It must take time to alter such a public understanding. The Complainers might have been entitled to interdict if there had been intent to defraud. In the present case there was no such intention. A few bottles were discovered to 35 have been sold by the Respondent bearing embossed upon them the name of the Complainers, and that is all. The Respondent had no desire to infringe any right of the Complainers. Of course, if any trader were found using a label or Trade Mark belonging to another person and continuing to do so for a long time, that might afford a ground for interdict, for there would be intention to defraud. 40 But there is no such case here. I think the LORD ORDINARY'S opinion is most clear, and I concur in all that he says.

LORD TRAYNER.—I am substantially of the same opinion. I think the LORD ORDINARY correctly states that "the question in this case, as presented 45 "at the discussion, is a question not as to an unlawful appropriation of the "Complainers' property, or as to infringement of the Complainers' Trade Mark." The whole case turns on what the name embossed on the bottle means to the public. The cases quoted to us were cases of goods bearing a trade mark or trade name, which indicated that the contents of the bottles were manufactured by one person, when, in point of fact, they were manufactured by another 50 person. There is no such case here. The name embossed on the bottle might have been indicative of the ownership of the bottle, but gave no indication as to the manufacturer of the contents, because in each case the bottle bore a separate label to indicate who was the manufacturer. But apart from this, this is not a case for interdict. The Respondent's position is quite frank. He 55 acknowledges that he may have sold the bottles bearing the name of the Complainers, but says that such a sale was accidental, and that, had he been

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asked, he would have been willing to take reasonable precautions against a recurrence of it. When a man comes into Court in this position it cannot be said that he is to be subjected to interdict. On these grounds I think that the prayer of the Note should be refused.

5 Lord MONCRIEFF.—I am of the same opinion, and for the reasons stated by the LORD ORDINARY.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE JOYCE.

February 6th, 1904.

10 ASHWORTH v. ENGLISH CARD CLOTHING COMPANY, LD. (A).

Patent.—Action for infringement.—Costs.—Taxation.—Preliminary inspection of machinery by agreement of parties without Order.—Discretion of Taxing Master.—Rules of the Supreme Court, Order 50, Rule 3.—Costs allowed.—Erection of machinery at time of trial without Order.—“Luxury.”—Costs
15 *disallowed.*

In an unsuccessful action for infringement of a Patent, where a mutual inspection by Counsel and experts of elaborate and heavy machinery was arranged between the solicitors without the expense of obtaining an Order for the purpose, under Rule 3 of Order 50 of the Rules of the Supreme Court, the costs of such
20 *inspection were allowed, but not the Defendants' costs of erecting machinery in London at the time of the trial, when it was not seen by either the Judge or the Plaintiff.*

This was a Summons by the Defendants in an unsuccessful action for infringement of a Patent, to review the taxation of certain costs of the
25 Defendants. The action was dismissed, with costs, on the ground that the Plaintiff's Patent No. 16,047 of 1886 was bad for want of subject-matter, as well as on the ground of no infringement proved.*

* 18 R.P.C. 367 ; 19 R.P.C. 463 ; 20 R.P.C. 790.

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The Taxing Master, on taxation of the Defendant's costs, disallowed (a) fees to Counsel and an expert for inspecting certain elaborate and heavy machinery, the Plaintiff having admitted that a mutual inspection by both parties was necessary, and the inspection having been arranged between the solicitors without the expense of obtaining an Order of Court; and (b) the cost of setting up the machinery in London near the Law Courts, where it was inspected by Counsel and an expert for the Defendants, but was not seen by the Judge or those acting for the Plaintiff.

The Taxing Master disallowed the fees for inspection, in spite of the mutual arrangement, and although in his view it was reasonable and proper. His grounds for so doing were that without an Order under Rule 3 of Order 50 of the Rules of the Supreme Court, he had no discretion, and that it had never been the practice to allow the costs of a view of the *locus in quo* or of an inspection of the subject-matter of an action without some express direction on the subject; he referred to *Mitchell v. Darley Main Colliery Company* (L.R. 10 Q.B.D. 457), where inspection was allowed to the Plaintiff only on payment of costs in any event. He disallowed the costs of erecting the machinery in London as a luxury incurred by over-caution.

Younger, K.C., and *A. J. Waller* (instructed by *Rowcliffes*, Agents for *Ramsden, Sykes and Ramsden* of Huddersfield), appeared for the Defendants; *T. Terrell, K.C.*, and *J. C. Graham* (instructed by *W. J. & E. H. Tremellen*, Agents for *Blair and Seddon* of Manchester) appeared for the Plaintiff.

JOYCE, J.—With reference to the setting-up of machinery in London, I agree with the Taxing Master about that, and I will not allow it.

With regard to the other inspection, it was found to be necessary and proper, and I think it would be the very worst possible precedent if the costs were disallowed because the inspection was made without an Order of the Court for the inspection being obtained. I allow them, but I make no Order as to costs now.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE JOYCE.

February 6th and 20th, 1904.

ASHWORTH v. ENGLISH CARD CLOTHING COMPANY, LD. (B).

- 5 *Patent.—Action for infringement.—Costs.—Interest on costs paid by litigant unsuccessful in the Court of Appeal but successful in the House of Lords.—Satisfaction of judgment Debt.—Judgments Act, 1838 (1 & 2 Vict. c. 110), s. 17.*

An action for infringement of a Patent was dismissed with costs, and the Plaintiff paid the Defendants' costs with interest to date. Upon the Plaintiff
 10 *successfully appealing to the Court of Appeal, the Defendants repaid the amount so received with interest to date. The House of Lords restored the original Order, and the Plaintiff repaid the original amount of costs and interest, but refused to satisfy the Defendants' claim for interest at 4 per cent. on the amount from the*
date of the repayment after the Court of Appeal decision to the date of the
 15 *return after the House of Lords decision.*

Held, that the Defendants were entitled to this further sum in respect of interest.

This was a Motion by the Defendants in an unsuccessful action for infringement of a Patent for payment of interest on costs.

- 20 *On the 22nd of June 1901, the Plaintiff's action was dismissed with costs; and on the 26th of March 1902, the Plaintiff paid the Defendants' costs, £1013, with interest to date, amounting altogether to £1042.*

- On the 11th of July 1902, the Court of Appeal reversed the Order of the Judge at the trial, and on the 21st of July the Defendants returned to the*
 25 *Plaintiff the sum of £1042 with interest to date.*

On the 9th of November 1903, the House of Lords reversed the Order of the Court of Appeal and restored the original Order, and on the 23rd of November the Plaintiff repaid the £1042 together with the interest to the 21st of July 1902.

- The Defendants then claimed £51 for interest at 4 per cent. on the amount*
 30 *repaid to them as from the 21st of July 1902 to the 23rd of November, but the Plaintiff refused to pay this. The Defendants therefore applied by Motion for payment of this sum to them.*

- Younger, K.C., and A. J. Walter (instructed by Rowcliffes, Agents for Ramsden, Sykes and Ramsden of Huddersfield), for the Defendants. We are*
 35 *entitled to interest at 4 per cent. on these costs during the time they remained unpaid, as being interest down to date of judgment. This case is not governed by the apparently adverse decision in *Edge v. Gallon* (16 R.P.C. 509; 1899, W.N. 137) which only decided that where costs have been paid under an Order of the Court, and are then ordered to be repaid, that means the costs and not the*
 40 *interest.*

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T. Terrell, K.C., and J. C. Graham (instructed by *W. J. and E. H. Tremellen*, Agents for *Blair and Seddon*, of Manchester), for the Plaintiff. Such a claim for interest is statutory and can only be made by the Defendants if they bring their case within Section 17 of the Judgments Act, 1838, which provides that "Every judgment debt shall carry interest at the rate of £4 per cent. per annum from the time of entering up the judgment 5
"until the same shall be satisfied." Here it is plain that the event contemplated by the Statute, viz., the return of the moneys under the Order of the Court of Appeal and the granting of the "allocatur" in respect thereof, has occurred.

Younger, K.C., in reply. 10

Judgment was reserved and delivered on February 20th 1904.

JOYCE, J.—In this case, in the Court of first instance, the Plaintiff's action was dismissed with costs on the 22nd June 1901. On the 26th March 1902 the Plaintiff paid the Defendants' costs, £1013, with interest to date, amounting altogether to £1042. On the 11th July 1902 the Order of the Court below was reversed by the Court of Appeal, and on the 21st of the same July the Defendants, being required to do so by the Plaintiff, returned to him the amount he had paid for costs and interest. Pausing here for a moment, it appears to me that at that moment matters stood in the same position as if the Plaintiff had never paid or been ordered to pay these costs. On the 9th November 1903, the House of Lords reversed the Order of the Court of Appeal, and restored the original Order. The Plaintiff is willing to repay, and has repaid the Defendants' costs and interest that were returned to him under the Order of the Court of Appeal—this interest being interest on the Defendants' costs from the original judgment to the 21st July 1902. He objects, however, to pay interest on such costs for the period since the 21st July 1902, although he has had the money in his hands, without, as it ultimately turns out, being entitled thereto. But by law if these costs had never been paid at all the Defendants would be now entitled to have them with interest from the date of the original Judgment, and it appears to me that they ought not to be in a worse position by reason of having, under an Order of the Court of Appeal now reversed, returned the amount of these costs with interest to the 21st July 1902. I think that this return of costs, demanded by and received by the Plaintiff, put the Defendants in the same position as if they had never been paid by the Plaintiff. Therefore, in my opinion, the Motion is entitled to succeed. I should add that the case which was cited to me of *Edge v. Gallon* was altogether different. There the costs refunded were simply costs which an erroneous Order of the Court below, subsequently reversed, compelled the Defendant to pay, and there was no Statute or Rule entitling the Defendant to interest on the costs so refunded. Therefore there must be an Order according to the Notice of Motion, with the costs. 40

Macmillan and Others v. Ehrmann Brothers, Ltd.,
and
In the Matter of the Trade Mark "Macfarlane & Co."

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BUCKLEY.

March 15th, 16th, 17th, and 18th, 1904.

MACMILLAN AND OTHERS v. EHLMANN BROTHERS, LD.,

5

and

IN THE MATTER OF THE TRADE MARK "MACFARLANE & CO."

Trade name.—Action to restrain use of a name that was not either Plaintiffs or Defendants'.—No deception, or probability of deception proved.—Action dismissed.—*Trade Mark.*—Motion to rectify.—Rectification by consent.—

10 *Costs.*

A firm of Macfarlane & Co. (sometimes with various initials) traded as whisky distillers and merchants at Paisley from 1740 till 1897; they had a good local reputation. The then continuing member of the firm, J. Macfarlane, assigned the goodwill of the business to Foulds & Co., Ltd. The Plaintiffs were four
15 of the directors of Foulds & Co., Ltd. It was agreed that the business should be assigned by Foulds & Co., Ltd., to the Plaintiffs, but that assignment was not actually executed till after action brought. Foulds & Co., Ltd., remained the real owners of and carried on the business under the style of Macfarlane & Co. In the year 1897 Ehrmann Bros., the predecessors in business of the Defendants, began to use the
20 name "Macfarlane," or "Macfarlane & Co.," to denote a brand of whisky sold by them. They adopted the name at the suggestion of a gentleman named Macfarlane, who was associated with them in their business of dealers in wines and spirits. They registered the signature of "Macfarlane & Co." as their Trade Mark (No. 204,384). During the year 1899 the trade, nominally carried
25 on by the Plaintiffs, was extended to England. The Plaintiffs, when the respective trades of the parties came into collision, brought this action to restrain the Defendants from using the name "Macfarlane & Co.," so as to represent their whisky as that of the Plaintiffs. Order for Particulars of Defendants' advertising, &c., made.
30 The Plaintiffs also moved to rectify the Register of Trade Marks by removing the Defendants' mark "Macfarlane & Co.," No. 204,384.

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Held, that the Plaintiffs had failed to prove that the Defendants' acts had intercepted or were calculated to intercept the Plaintiffs' trade. The action was dismissed with costs.

On the admission of Defendants' Counsel that the registration of "Macfarlane & Co." as a Trade Mark could not be supported as it was not the signature of an existing firm, an Order to rectify was made on the Motion by consent with costs, including the costs of the Comptroller, but as no evidence on the Motion had been given, there could be no costs of evidence.

On the 23rd day of May 1903, R. D. Macmillan, J. Wishart, W. M. M. Turner, and J. B. C. Newton, trading as Macfarlane & Co., brought an action against Ehrmann Bros., Ltd., claiming an injunction to restrain the Defendant Company from selling, or offering for sale, whisky under the name or description of Macfarlane & Co., and from using the name or description of Macfarlane & Co. as part of or in connection with any labels or capsules affixed upon any bottles, jars, or casks of whisky offered for sale or sold by or on behalf of the Defendant Company, and also from stating or inserting, or causing to be stated or inserted, in any advertisement or circular, any words or expressions asserting or suggesting that they were offering for sale, or authorised to sell, Macfarlane & Co.'s whisky, so as to represent, or lead to the belief, that they were offering for sale, selling, or authorised to sell, the Plaintiffs' whisky. The Plaintiffs also claimed damages and costs.

The Plaintiffs, by their Statement of Claim, alleged shortly (1) that their firm was established in the year 1740, and traded up to the present time as distillers and Scotch whisky merchants, under the name of Macfarlane & Co.; (2) that they sold extensively in the United Kingdom and the Colonies whisky as "Macfarlane's Whisky," or "Macfarlane & Co.'s Whisky," and that they acquired a great reputation for such whisky, so that the trade and the public understood that whisky so called meant the whisky of the Plaintiff firm; (3) that the Defendant Company had for some time past sold other whisky under the name of Macfarlane & Co.'s whisky, thereby leading to the belief that the Defendant Company was advertising the Plaintiffs' whisky; (4) that the Plaintiffs did not know of this sale by the Defendant Company until just before the action; and (5) that the Plaintiff firm had suffered damage.

The Defendant Company, by their Defence, alleged shortly:—(1) That they denied that the Plaintiff Firm was established in 1740, or that it or the Plaintiffs ever traded as Macfarlane & Co.; (2) They denied that the Plaintiffs traded as a firm or were possessed of the goodwill of a firm of Macfarlane & Co., which had formerly traded at Paisley or elsewhere; (3) They alleged that if the goodwill of the old Paisley firm still existed it belonged to a Limited Company styled William Forbids & Co., Ltd., of which the Plaintiffs were directors or officers, and in which they were shareholders; (4) They denied the alleged reputation in the trade of the Plaintiffs' "Macfarlane whisky"; (5) They stated that they were the successors of the firm of Ehrmann Brothers, and were assignees of the business, goodwill, and Trade Marks of that firm; (6) That in the year 1897 they adopted "Macfarlane & Co." as a distinguishing brand; and caused the signature of "Macfarlane & Co." to be registered as their Trade Mark (Class 43, No. 204,384), and were the proprietors thereof; (7) That "in and ever since the said year 1897 the said firm of Ehrmann Brothers and the Defendants have used the said brand, "Macfarlane & Co." in the said firm, and also as 'Macfarlane' as a brand or mark to indicate and identify their whisky, and have sold large quantities

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"of such whisky under the said brand, and have very widely advertised the said goods thereunder. Whisky marked with the said brand or described thereby is, and for many years before the commencement of this action was well known, to the trade and public as being the goods of the Defendants";

5 (8) They denied that they had done anything that led, or was calculated to lead, to the belief that they were advertising or offering for sale the Plaintiffs' whisky, or any whisky other than their own; (9) They alleged that the Plaintiffs never sold any whisky as that of *Macfarlane & Co.*, but if they did use that designation it was always accompanied with the words "of Paisley,"

10 and that the Defendants' whisky was always distinguished in bold type by the words "*Macfarlane & Co., of Glasgow*"; and (10) They alleged that the Plaintiffs were estopped through laches and acquiescence in the Defendants' acts.

On the 19th December 1903 an Order for Particulars of the 7th paragraph of

15 the Defence was made by the Master. The Defendants were ordered to give Particulars as to "(a) How and where the Defendants have in and since the year 1897 used the Trade Mark No. 204,384 in Class 43, *Macfarlane & Co.*, exhibiting to the particulars a label showing user of the same Trade Mark; (b) how, when and where, the whisky sold under the name or brand of

20 "*Macfarlane & Co.* has been very widely advertised as alleged, and in what publications or lists, and identifying the same publications or lists; and, (c) when the said whisky marked with the said brand or described as "*Macfarlane's Whisky*" first became known to the trade and public as the "goods of the Defendants." Pursuant to the Order the following Particulars

25 were given: "(a) On the Defendants whisky labels of various issues, and of some of which issues specimens are exhibited hereto and are marked, etc., and on labels of other issues which have been exhausted and of which no reference copies have been kept; (b) by numerous circulars, price lists and insets thereto as circulated by the Defendants in hundreds of thousands or

30 more from time to time. The Defendants have not in their possession copies of all such price lists but can identify a number of them, by reference to the first eight items in the first part of the schedule to the Plaintiffs' affidavit of documents; (c) it was brought under the notice of such members of the trade and public to whom it was offered by the Defendants' travellers or by

35 Defendants' price lists and circulars, referred to from about the period of its registration."

On the 23rd day of February 1904, notice of Motion was served, on behalf of the Plaintiffs, that the Register of Trade Marks be rectified by the removal of the Trade Mark No. 204,384 in Class 43. On the Motion being brought on it

40 was ordered by *Buckley, J.*, to be put in the list next after the action.

The action came on for trial before Mr. Justice BUCKLEY on the 15th March 1904; the Motion to rectify was also in the list.

Astbury, K.C., and *J. S. Green* (instructed by *Greenwood and Greenwood*) appeared for the Plaintiffs; *Buckmaster, K.C.*, and *Kerly* (instructed by

45 *Hyman Isaacs and Lewis*) appeared for the Defendant; and *R. J. Parker* (instructed by the Solicitor to the Board of Trade) for the Comptroller-General.

Astbury, K.C., in opening the Plaintiffs case gave an outline of the nature of the evidence and of the case for rectification of the Register which was to come on after. [BUCKLEY, J.—All I have directed is, that it should be put in the

50 Paper next after the action. When the Motion is reached I shall deal with it.] We ask that the Court will act on the same evidence.

The Plaintiffs, *Turner, Newton and Wishart*, and other witnesses gave evidence. Documentary evidence as to the early history and nature of the business of *Macfarlane & Co.*, of Paisley, was also put in. The facts proved

55 are given fully in the judgment below.

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Buckmaster, K.C., for the Defendants, contended that the real purchasers of the old business of *Macfarlane & Co.* were *Foulds & Co., Ltd.*, and that the whole arrangement was a device to avoid the provisions of the Companies' Acts. [BUCKLEY, *J.*—No doubt *Foulds & Co., Ltd.*, were the owners of the business; but the Companies' Acts have nothing to do with this case.] The only parties who can complain are those who lose. [BUCKLEY, *J.*—Not necessarily so. What if trustees carry on a business?] The Plaintiffs are not *Macfarlane & Co.* at all, the business and goodwill belong to *Foulds & Co., Ltd.* The Defendants' business will be shown to be quite distinct, and their use of the name of *Macfarlane & Co.*, to have commenced in entire ignorance of the business of *Macfarlane & Co.*, of Paisley. It was adopted in the year 1897, at the suggestion of a gentleman of that name, then connected with the business of Mr. *Ehrmann*. A special mark, his family tartan, was also adopted from the same person. [BUCKLEY, *J.*—You were going to use the name "Macfarlane" either honestly or dishonestly. You might use it honestly none the less because it was not your own name, or dishonestly if it was your own name.] The Defendants' registered Trade Mark, the signature of "Macfarlane & Co.," was in the hand-writing of Mr. *Ehrmann*. [Counsel commented in detail on the evidence given for the Plaintiffs as to the nature and extent of their trade.] The Plaintiffs must show they had a reputation for "Macfarlane Whisky" before the Defendants began to deal in a Macfarlane Brand. The question is: Do people buy the Defendants' goods thinking they are buying the Plaintiffs? Their trade in Birmingham and the Midlands is simply that of *Ryder* who formerly sold whisky as "V.O.V.," and subsequently, after it was known, and after his arrangement with Plaintiffs added the name *Macfarlane & Co.* [BUCKLEY, *J.*—Take the case of "Boots" Chemists. You go and ask for the things they advertise. You do not ask for "Boots" Pills, &c., but merely the particular drug you want. Suppose somebody began to advertise "Boots" Camphor, &c. Would not that be actionable? Is it not really a question of fact, as to what the term "Boots" conveys to people's minds. Are you not dwelling too much on "V.O.V."?] It was proved that this business in *Ryder's* V.O.V. was practically all the English business the Plaintiffs had. Assume there was a Birmingham reputation only, and another begins innocently to trade under the same name in London, his customers knowing nothing of the Plaintiffs; when the respective areas become enlarged and come in contact, can the London trader be restrained? [BUCKLEY, *J.*—Directly he begins to trade in an area in which the use of the name enables him to steal the established trade of the other man, then I should say you could restrain him.] But the law does not limit a man's trade to one locality. One must enquire how it is that buyers are misled. [BUCKLEY, *J.*—Directly an innocent person finds he is receiving orders which are not meant for him, but are meant for another person, and executes them, he becomes a fraudulent person, but up to that time he is innocent. The injunction is to restrain him from selling the goods so as to pass them off as those of another man.] The claim here is not for passing-off at all, but for the use of the name. [BUCKLEY, *J.*—The last words of the injunction asked for ought to qualify the whole of it.] But we have never done these things, there is no evidence that anyone was misled by our labels or lists. [BUCKLEY, *J.*—The action is not with respect to "get up" at all. The action is for using a name so as to induce the belief that one is buying from Plaintiffs' firm of *Macfarlane & Co.*] There is no evidence that anyone was misled by our lists or labels, therefore, no cause of action. We will prove the origin of our use of the name of *Macfarlane*. In the trade, fictitious names are frequently used. Plaintiffs must prove that it was done to take some of the trade that would otherwise come to them, *Levy v. Walker* (L.R. 10 C.D. 436, per *James, L.J.*, at p. 447).

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Evidence was then called on behalf of the Defendants. The effect of it appears fully in the judgment of the learned Judge.

Kerly summed up the case for the Defendants.—It must be observed that there are motives for this action other than merely preventing the trade of the Plaintiffs being improperly taken. The evidence shows that the trade had combined against the Defendants, who were unpopular on account of the prices at which they sold. The Plaintiffs have no cause of action. The legal proposition is that only those who own the goodwill of a business can sue in respect thereof. The Act of 1883 (sec. 70) provides that a Trade Mark can be assigned only as part of the goodwill of a business. There is no right of action apart from goodwill, in the case of a Trade Mark, and it has been held that the same rule applies in an action for passing-off. [BUCKLEY, J.—That is quite plain; I accept your proposition.] An agent cannot sue because the acts alleged would amount to a tort to the business *Richards v. Butcher* (7 R.P.C. 288). If *Foulds & Co., Ltd.*, were suing, they would be met by a good Defence in that they were themselves representing to the public that the goods they sold were not their own blends, but those of another firm *Wood v. Butler* (3 R.P.C. 81). The Plaintiffs never carried on any business of their own; it was only as agents for *Foulds & Co., Ltd.* All the evidence supports this view. The agreement to sell the business was actually forgotten, and the assignment of it by *Foulds & Co., Ltd.*, to the Plaintiffs was never executed till after this action was brought. The Plaintiffs to succeed must prove that their trade was so widely known that when the name, *Macfarlane & Co.*, is heard of, it must necessarily convey the meaning that it denotes their trade. There is no such evidence here. They must prove a universal reputation in England; but there were other *Macfarlane's*, although not in the wholesale trade.

Astbury, K.C., in reply.—The Plaintiffs have proved that they are the successors of the original firm of *Macfarlane & Co.*, of Paisley. [BUCKLEY, J.—You had a real business locally known. You have not proved a general reputation in Birmingham, nor any English trade before 1899. Defendants began in 1897, and not in fraud of you.] We need only prove the general reputation in Scotland; our trade there is over 100 years old. The Defendants' leaflets have flooded Scotland. The Scotch customers would be deceived. Why allow it there? They may not use even their own name if they use it so as to deceive purchasers, *Turton v. Turton* (L.R. 42 C.D. 128). People who had been buying our whisky would be misled. [BUCKLEY, J.—There was a firm of *Macfarlane & Co.*, of Paisley, having a small, respectable business. You say, Mr. *Ehrmann* took the name of that obscure firm for improper purposes. It is highly improbable.] Even if he did not know then, he did later on, and it was not honest then to continue knowing what the result would be. In the cases of *Tussaud v. Tussaud* (L.R. 44 C.D. 678) and *John Brinsmead & Co. v. T. E. Brinsmead & Sons, Ltd.* (13 Times L.R. 3) the Defendants were restrained, although they carried on business in their own names. [Counsel commented in detail on the effect of the evidence.]

BUCKLEY, J.—In this action the Plaintiffs do not complain in any way of the get up of the Defendants' goods. They do not say as to matter of form or character of label or form in which the bottle of whisky is sold, or the manner of packing or the like, that there is any resemblance at all to theirs. No consideration of that kind arises at all in the case. Their complaint is that the Defendants sold whisky as *Macfarlane & Company's* whisky, and that the name of the Plaintiffs' firm is *Macfarlane & Company*, and that this must not be done, because orders may in that state of things be given to the Defendants which are intended for the Plaintiffs. There is no evidence of any orders having been so given, but I do not say that that concludes the case. I have got to see whether, as a matter of fact, it is made out to my satisfaction that if the

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Defendants continue to do that which they have been doing, they will in fact break the commandment, "Thou shalt not steal," by executing orders intended for the Plaintiffs which reached the Defendants.

Neither party to the controversy bears the name of *Macfarlane*. Their respective connections with that name will appear in the course of this Judgment. 5
For a great many years—the Plaintiffs say as far back as 1740—there has existed a firm of *Macfarlane & Company*, of Paisley, sometimes with and sometimes without the initial letter of a Christian name before it. It was *D. Macfarlane & Company* at one time and *T. H. Macfarlane & Company* at another, but for many years past it has been *Macfarlane & Co.* simply. I have no doubt at all 10
that for 100 years at least that firm has existed.

I may state these facts with regard to them: that they are found in the Assessment Rolls of 1807 and 1880; they are found in Directories of 1832, 1866, 1867, and 1885; that I have their "Bills Payable" book from 1867 to 1895; I have their parcels books from 1877 onwards; I have one of their stock books, 15
from 1879 until the present year, 1904; and there has been a witness of the name of *Longmuir* who went into their employment in 1867. That the firm has existed for a great many years there is no doubt at all. As regards their business, I am also satisfied that they have not had a trivial or imaginary 20
business. The stock book of which I spoke just now, from 1877 onwards, shows considerable sales and dealings over all those years. In 1883 their turnover is said to have been £15,600; in 1897, which is a year I have to mention further, it had come down, and it was only about £6800. After that it went up again, and in 1900 it was £14,000 odd, and in 1902 £16,000 odd. It was a perfectly 25
respectable firm carrying on business for years in Paisley, and as to their business connection, the short effect of the evidence, I think, is that they were not an advertising firm in the way in which firms advertise nowadays—I do not say their name did not appear in some trade circulars; it did—but they were not people who issued advertisements or price lists, or such things wholesale. They 30
seem to have done a quiet business. They were certainly known in Paisley and the neighbourhood, and have been for many years. People have bought their whisky, and say it is very good whisky; and I daresay it is. They had, before the year 1899, substantially no English trade at all. I do not say they never sold a bottle of whisky here, but with some qualification of that sort they had no English trade of any sort or description, and the general effect of 35
the evidence is that although they were known in Paisley and the neighbourhood, and Paisley people bought from them there and knew their name of *Macfarlane & Co.*, they were not generally known at all. They had a good local reputation, and nothing more.

In May 1897, (perhaps before that, in 1896, or somewhere thereabouts), the then 40
continuing member of the Plaintiffs' firm, *James Macfarlane*, went off to New Zealand. On the 25th May 1897, he executed in New Zealand an assignment by which he parted with the goodwill of this business to a Limited Company, called *Foulds & Co., Ltd.* It seemed from the evidence which I have had, that in the later years of *James Macfarlane's* ownership the business had 45
gone down, and ultimately he had left it—I do not know why—and he was minded to sell it. The Plaintiffs are four gentlemen, no one of whom is named *Macfarlane*, who were Directors of *Foulds & Co., Ltd.* As regards the form of the assignment a question has been raised about which it is not necessary to for me to come to any decision at all. It was this: that the 50
assignment was in the first place taken to *Foulds & Co., Ltd.* Then it seems to have occurred to them that if they were the owners of the business they would have to trade with the word "Limited" in the name of *Foulds & Co., Ltd.*, and they did not like that. Under those circumstances the business was assigned by *Foulds & Co., Ltd.*, to these four gentlemen. 55

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In point of fact, *Foulds & Co., Ltd.*, remained as before, the real owners of the business. Everything was accounted for to them, but the firm of *Macfarlane & Co.*, constituted by the four Plaintiffs, were the persons who ostensibly, at any rate, carried it on. It seems to me the result of the facts would be that if any
5 creditor wanted to sue for any debt incurred, he would sue these four persons, *Foulds & Co., Ltd.* not being parties in the action. However that may be I do not think it very much matters.

The Plaintiffs, then, in the year 1897, became entitled to the business. They seem to have proceeded energetically to try to raise it from its depressed condition,
10 and they succeeded. In 1899 they appointed a man named *Ryder* to be their agent at Birmingham, and the English connection of the Plaintiffs began from the year 1899. Mr. *Ryder* seems to have been an energetic person. He made a good many sales in Birmingham, and the sales extended to a good many other places—Cardiff, Worcester, Huddersfield, Moseley, near Birmingham, one man
15 at Twickenham, and other people in Paisley or in the neighbourhood. The English business increased. In 1900 it was a little over £4,000; in 1901 nearly £6,000; in 1902 nearly £8,000; and in 1903 a little over £11,000. Those, I think, are all the material facts that I need state for the moment as regards the Plaintiffs' business.

I now take up the story of the Defendants. The Defendants, in 1897, or rather their predecessors in title, a firm of *Ehrmann Brothers*, were carrying on business in Finsbury Square, in London. It is proved completely to my satisfaction that in the year 1897, a certain Captain *Macfarlane* came into
20 communication with them, who seems to have been a person who was willing to tout for orders from persons of high station, and to recommend whiskies, wines, and spirits, provided he could catch a customer. He seems to have been employed by *Ehrmann Brothers* at the beginning of 1897, or probably a little earlier. The first letter I have of his is the 8th January 1897. Captain
25 *Macfarlane* suggested that *Ehrmanns* should start a "Macfarlane Blend" of whisky, and he mentioned it to certain people of high station. I have a number of letters before me, but I am not going to read them at length, because it is beyond dispute, that in 1897 Captain *Macfarlane*, being in communication with *Ehrmann Brothers* suggested to them that they should start a "Macfarlane & Co." or a "Macfarlane" blend of whisky, and that he offered them the use of
30 his tartan and his coat of arms. He suggested they should get a label, which in point of fact, the Defendants used, and which is before me, and which as I have said, does not resemble in the smallest degree the Plaintiffs'. That *Ehrmann Brothers* decided to accept, and accordingly that label was printed and used.

The way in which the Defendants conduct their business is to issue very
40 largely broadcast—by the million, Mr. *Ehrmann* says—certain lists describing their wines, and I have lists of theirs, of which the first in June 1897, which contains the "Macfarlane Whisky." There are several brands of it at different prices—10 years, 12 years, 14 years, 20 years, and 28 years. Now these lists are rather instructive in the case, and I will state what I have been able to
45 ascertain from those which have been put in evidence. There were lists in three colours: blue lists, white lists, and pink lists. The pink lists did not come into existence until the 8th of November 1900. All these lists irrespective of colour were numbered consecutively. Some of them bear dates, and others bear no dates. As to others the dates have been traced by communications with
50 Stationers' Hall. What I am able to gather is, that in June, August, and November 1897, there were three blue lists numbered respectively 128, 132, and 133, which all contained quoted for sale "Macfarlane Whisky." I think they are all in the same words exactly—"The Macfarlane." I have then got lists of the following numbers: 130 white, 136 white, which is dated August
55 1898; 139 blue, which is May 1899; 140 white, which is June 1899; 141

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white, which is March 1900 ; 142 pink, November 1900 ; 146, March 1901 ; undated 161 and 193, and 194 Star Rose, 1st January 1902 ; all of which contain whiskies, but none of which contain "Macfarlane Whisky." On the 6th February 1902 there is 194* a pink list in which the whisky pages are wanting, so I cannot say what may have been in them. But No. 202, the 16th April 1902 contains "Macfarlane Whisky," and so do subsequent lists of October 1902, and No. 255 on which this action is brought, and a subsequent one No. 281. The result of all that is, that in 1897 the list contains "Macfarlane Whisky." After 1897 to 1902 they do not contain "Macfarlane Whisky." For the reasons which I have assigned I think that the name "Macfarlane" was taken in the year 1897 *bonâ fide*, so far as any trade name can be taken *bonâ fide*, in the sense that a man named *Macfarlane* offered the use of his name. I am sorry to say from the evidence on both sides that it is common in the wine trade for a dealer to represent himself as being agent for firms of attractive names, which in point of fact have no existence at all, and which are really the dealer over again, and this was an instance of that kind. *Ehrmann Brothers*, not really being *Macfarlane & Co.* in any true sense, represented in their lists that they were selling wines of a firm of *Macfarlane* which did not exist. It was a mere name for the purpose of selling. The question is whether they did that so as to give any cause of action.

In 1902, as will be apparent from what I said just now, the Plaintiffs had extended to England the trade such as it was of moderate dimensions which they were carrying on in the sale of whisky, and the facts to which I drew attention might lead to the Court being persuaded that in 1902 the Defendant Company of *Ehrmann Brothers, Ltd.*, which had been incorporated in the interval, namely in 1900, were resuming the use of the name *Macfarlane & Co.*, because they wished to divert trade which was intended for the Plaintiffs. I have watched the evidence very carefully all the way through, to see if I could find any indication or any facts which would lead me to the belief that in resuming in the list No. 202 the name *Macfarlane & Co.*, the Defendants did so by reason of any suggestion arising from their knowledge of the Plaintiffs' trade. I fail to find any at all. The link is wholly wanting. There is the fact that they did not use the words from 1897 to 1902, but there is nothing to show me that they resumed them in 1902 with any purpose of intercepting the Plaintiffs' trade. Evidence has been given before me by Mr. *Ehrmann* and by the travellers of *Ehrmann Brothers, Ltd.*, and they say—and I have no reason upon the evidence to disbelieve what they say—that these blue lists of 1897 which did contain the name of *Macfarlane* had been printed in such numbers in 1897 that the stock lasted on over the interval of time, and they have all told me that without a break over this period of time they were soliciting orders for *Macfarlane & Co.*'s whisky, and receiving them and executing them. The books of *Ehrmann Brothers* have been produced, and there was ample opportunity of contraverting that statement if it was not true. The statement has not been displaced. Significant, therefore, as the fact is with regard to the lists, I arrive at the conclusion that the Plaintiffs have not made out that the words were dropped in 1897 and resumed in 1902 in any way with the intention of taking the Plaintiffs' trade. I therefore absolve the Defendants from any imputation of any intention of taking the Plaintiffs' trade, either when they first used the words in 1897 or when they resumed them on their lists in 1902.

But that does not conclude the case, because, if I arrive at the conclusion that in point of fact the use of the words has the result of intercepting orders intended to be executed by the Plaintiffs so that they are executed by the Defendants, the Plaintiffs would still be entitled to relief. Now, how do the Plaintiffs stand as regards this? First one general observation.

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No single person of any sort or description has been called who said :
" I read the Defendants' list, and I thought that what they were offering was
" the Plaintiffs' whisky and I ordered from the Defendants under that belief."
I do not say that that concludes the case either. If I find that the words are
5 calculated to induce that belief, I might find that without evidence of cases
in which it had that result, but the fact that there is no evidence at all that it
ever had that result is, of course, a very important factor in arriving at a
conclusion as to this.

As regards any evidence of deception it is confined to three witnesses
10 only. They are first a Mr. *Faulkner* who is a manager to *Merritt & Co.* of
Mark Lane, who are agents for *Foulds* for the country places exclusive of
London. His evidence comes to this : that in March of last year he received
the pink list No. 255 with a certain yellow inset in it. This yellow inset has
been dwelt on a good deal. It is a paper which is headed, " A Revolution in
15 " the Whisky Trade," and it contains an advertisement of these whiskies,
quoting five brands of them. Mr. *Faulkner* says that he looked at it, and
seeing the name of *Macfarlane & Co.*, which of course he knew because he was
Foulds agent and knew that *Foulds* and *Macfarlane* had the relationship which
in fact subsisted between them, thought that *Ehrmann Brothers, Ltd.*, who
20 seem to be persons not very acceptable to the trade, were selling the Plaintiffs'
whisky, and he spoke to Mr. *Turner* one of the Plaintiffs about it. Mr.
Turner also seems to have been rather startled at this state of things, and the
scheme which I am going to describe was arranged between them. Mr.
Faulkner wrote under the name of " *Shorland* " asking for certain sample
25 bottles, and he used the name of " *Shorland* " to conceal his identity, and he
received certain sample bottles and the invoice, and he found it was not the
Plaintiffs' whisky. Mr. *Faulkner* does not pretend to say that when he got
the whisky he was deceived at all. He could not be because, as I have
pointed out, the label is totally different, and was described as coming from
30 *Macfarlane & Co.* of Glasgow, and he knew perfectly well that his firm
was *Macfarlane & Co.* of Paisley. There was no deception at all on him for he
knew he was getting a different thing to what he ordered. He wrote to find
out and he found out that it was not the Plaintiffs' whisky. That is the end of
that list. It comes to nothing more than this : that *Faulkner* who is an expert in
35 these matters and who of course knew *Macfarlane's* name very well, because he
was their agent or *Foulds'* agent, seeing their name in this list wanted to find out
what it meant and he found out. The next was a man named *Masters*, who is a
Director of a Company of spirit merchants in Mark Lane. He says he saw the
pink list about eighteen months ago. He seems to be as struck as *Faulkner*
40 was by the appearance of *Macfarlane* in *Ehrmanns'* list. When he saw
Turner, one of the Plaintiffs, he questioned him about it and said that if it was
the Plaintiffs' whisky which was being sold through *Ehrmanns'* he would have
nothing further to do with *Macfarlane & Co.*, because *Ehrmann Brothers, Ltd.*
were so distasteful to him that he would not have had anything to do with
45 them, if that were through them. That is the end of *Masters* evidence. He
found out what we all know ; that in point of fact this was not the Plaintiffs'
whisky at all. The other witness was a man named *Thompson*, who lives at
Huddersfield and he has known the Plaintiffs' whisky for about two and a-half
years. In January or February 1903, he saw a pink list and he thought it
50 referred to *Macfarlane & Co.* of Paisley. He put himself into communication
with the Trade Protection Association, and *Newton*, who is another of the
Plaintiffs, was taxed with supplying *Ehrmanns* with it. *Thompson* said that if
that was so he should consider whether he would give them any further orders,
if they allowed the Defendants to go on selling their whisky. So far as I know
55 those are the only instances at all of anyone who has been deceived, and when

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you come to look at them they really come to nothing at all. The other evidence, to summarise it shortly only comes to this. There are eight trade witnesses, including one from Scotland, two from London, and others from other places, and this man *Thompson*, whom I have just mentioned, at *Huddersfield*. Their evidence simply comes to this that they have known of *Foulds & Co.* and they have brought from *Ryder* generally. They were people who knew *Macfarlane & Co.*'s whisky as being the Plaintiffs' whisky and they had not heard of anyone else who supplied the whisky. That is the whole of their evidence. Then there are the consumers, one from Glasgow, one from Renfrewshire, one from Paisley, and another is a man named *Bailey* of *Twickenham*, who is an oil and colourman, and he has bought the Plaintiffs' whisky for many years. He seems to have been told by somebody that it was a very good whisky, and he used to write up by post every now and again and have three gallons of it at a time. Those are the only consumers that have been called. What does that evidence come to? It seems to me that it does not come to more than this—this is common ground and I do not understand the Defendants to dispute it—that *Macfarlane & Co.* of Paisley blended whisky; they were not distillers at all, but they blended whisky or it was blended for them, and they sold it, and they had a good reputation in a local and limited area, and persons bought it, and bought it because it was *Macfarlane & Co.*'s whisky. They had always bought it as such and did buy it as such. But the Defendants on their part assumed a trade name which happened to be *Macfarlane & Co.* but which was taken—subject to that I am going to say next—without any knowledge that there was a firm of *Macfarlane & Co.* of Paisley who had good business, which either the Defendants were desirous of intercepting or which they in point of fact did intercept by that which they did. I do not think it is proved that they did either the one or the other.

It only remains to state something further as to the knowledge which Mr. *Ehrmann* had in 1897 of the existence of *Macfarlane & Co.* of Paisley, I think that he had some. It is proved that in 1882 there had been put on the Trade Marks Register a label "Fine old Scotch Whisky, *D. Macfarlane & Co.*, Paisley," with the device and "M" and a couple of arrows above it. The person who registered that mark was "*Daniel Macfarlane* for and on behalf of the firm of *D. Macfarlane & Co.*, 29, Lady Lane, Paisley, Renfrew, N.B., Spirit Merchants." When *Ehrmann* in 1897 was desirous of registering a certain other label with the signature of *Macfarlane & Co.* he employed a Patent Agent named *Wildbore*, who has told us—and the letters which have been looked into bear out his statement—that when the registration of that mark of 1897 was under consideration the Comptroller called attention to this mark of 1882 of *D. Macfarlane & Co.*, Lady Lane, Paisley. Mr. *Ehrmann* therefore knew in 1897 that there had been and there might be still a firm of *D. Macfarlane & Co.* of Paisley, and so far as appears he did nothing further. I think that incident begins and ends there. He did not concern himself as to whether they were still existent, and he did not abstain from registering his label with the signature "*Macfarlane & Co.*" by reason of the knowledge which I think certainly he did that that firm existed. That does not lead me to qualify the opinion I have formed irrespective of that fact. Whether he ought to have made more inquiry I am sure I do not know. By that circumstance I am by no means satisfied that he assumed this name of *Macfarlane & Co.*, in order to intercept and get the benefit of the trade of this firm of *Macfarlane & Co.*, of Paisley, which at that time was of exceedingly modest dimensions—1897 was its lowest point.

The result of the whole case as it seems to me is this; that—however little the Court may approve of a firm taking another name, which is not their own, for

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the purpose of putting forward a firm whose name is put forward as the vendor or sellers of the whiskies of another firm which in point of fact does not exist and as to which the buyer might possibly have had some ground of complaint—the Plaintiffs have failed to show that in doing that thing the Defendants did anything which intercepted or tended to intercept the trade of the Plaintiffs.

The whole case really turns on the determination of the pure question of fact: Did or did not the act which the Defendants do, produce, or is it calculated to produce, the result of intercepting the Plaintiffs' trade? I answer that question in the negative. I therefore think that this action fails, and I dismiss it, and in dismissing it I do not see why any other result should ensue when a plaintiff comes here with a cause of action which he cannot maintain, and so I dismiss it with costs.

Astbury, K.C.—Then, my Lord, there is the motion to take this mark off the Register. I presume from your Lordship's Judgment that that must succeed.

15 *BUCKLEY, J.*—What do you say, Mr. *Buckmaster*?

Buckmaster, K.C.—I will just say a word to my client. [The learned Counsel consulted with his client]. I have spoken to my client, my Lord. Both from what your Lordship has said and from the facts as we now know them I think it would be difficult for me to contend that the signature was the signature of a then existing firm, and on that ground I will consent to the Register being rectified. I say on that ground because, of course, many other grounds have been alleged in the Notice of Objections that they have given to us. It is only on that ground that I accede to it. That would follow, of course, with the usual consequences too. There is only one thing further. Mr. *Ehrmann* wants me to say that if your Lordship thinks there is any reasonable alteration that he ought to make in his style of trading, he would be willing to do it as a purely voluntary act on his part. He does not want to trade so as to interfere with other people's business. He offers to say "not connected with any other firm of *Macfarlane & Co.*" He will put, as he has put, "of Glasgow" in every one of his lists. If that will help the Plaintiffs, it shall be done.

Astbury, K.C.—I do not want to assent to anything now which would prevent my clients, if they are so advised, trying their fortune elsewhere.

BUCKLEY, J.—By all means reserve your right of going elsewhere, but I should have thought, apart from that which you might hold entirely in reserve, an alteration under which the Defendants may so cease to do it ought to be accepted. You will put it on the first page, of course?

Buckmaster, K.C.—The Defendants will put it wherever they put "*Macfarlane & Co., of Glasgow,*" and they will say "not connected with any other firm of *Macfarlane & Co.*"

40 *BUCKLEY, J.*—Nobody wants to preclude the Plaintiffs from going to the Court of Appeal, of course, but if they determine not to go to the Court of Appeal, they are willing to accept this offer that the Defendants will put on their lists, "*of Glasgow,*" and "not connected with any other firm of *Macfarlane & Co.*"?

Astbury, K.C.—Certainly, my Lord.

45 *Buckmaster, K.C.*—The Defendants are not going to destroy existing lists, or anything of that kind, but they will put it in all future lists.

Astbury, K.C.—I am asked to mention that the costs of the Comptroller will have to be provided for.

Buckmaster, K.C.—They must be paid by us. We cannot help it.

50 *Astbury, K.C.*—There is one matter in connection with the Motion, and that is your Lordship allows it with costs?

BUCKLEY, J.—Yes.

Astbury, K.C., asked for some direction about the taxation of these costs, as the Plaintiffs had given notice they would file no evidence, but would rely on that given in the Action.

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BUCKLEY, J.—There will be no costs of any evidence, if no evidence has been filed.

Astbury, K.C.—We have given verbal evidence.

BUCKLEY, J.—You have not given any evidence. I only took the evidence in the Action. The Motion was purposely left until after the Action was over. 5
The costs of the Motion, which are given to you, will not include any costs of evidence. There has been no evidence given.

Astbury, K.C.—I thought that the letter we wrote was a proper one, viz., that, as the evidence we should file on the Motion would only be repeating the evidence we proposed to give in the Action, we should rely on the evidence 10
given *viva voce* in the Action.

BUCKLEY, J.—But you could not do that. I refuse to treat it in that way. I simply put the Motion in after the Action, leaving the question of what should be done with the evidence to be considered then. I have made no Order except 15
by consent.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE JOYCE.

March 2nd, 3rd, 4th, 5th, 8th, 9th, 12th and 14th, 1904.

IMPERIAL TOBACCO COMPANY (OF GREAT BRITAIN AND IRELAND), LD. v.
PURNELL AND CO. 20

Passing-off.—"Get-up."—Narrow red band round cigars.—Common to the trade.—Name of brand.—Fraud neither alleged nor proved.—Judgment for Defendants.

The predecessors of the Plaintiffs, who were cigar manufacturers, in 1888 commenced to sell cigars under the name "Marcella," and having round them 25
a narrow band of red paper five thirty-seconds of an inch in width, with the name of the brand printed thereon in white. They contended that these cigars were so well known and so much asked for as "narrow red band" cigars, as to entitle them to an injunction restraining the sale by the Defendants of cigars bearing similar bands three-sixteenths of an inch in width, and 30
sold under the name "Purnella." It appeared that the Plaintiffs first knew of the Defendants' cigars in 1901, although the Defendants alleged that they had sold "Purnella" cigars since 1882 in large quantities, and other cigars bearing similar bands since 1878. Evidence was also given of other long uses of cigar-bands of practically the same width and style. 35

Held (1) that a plain red band for cigars of whatever width was common and open to the trade; (2) that the Defendants' red band was sufficiently distinguished from all other red bands by the name "Purnella"; and (3) that even if the Plaintiffs had used a narrow red band to a greater extent than any other manufacturer, that gave them no exclusive right thereto. The Action 40
was dismissed, with costs.

*Imperial Tobacco Company (of Great Britain and Ireland), Ltd. v.
Purnell and Co.*

The Plaintiffs, the *Imperial Tobacco Company (of Great Britain and Ireland), Ltd.*, carried on in London and in many other places a large business as manufacturers and vendors of tobacco and cigars. They carried it on in succession to several firms whose business, goodwill, trade marks, and trade

- 5 names were vested in them. Among these firms was a firm trading under the style or firm name of *Allen Brothers*, who, about 1888, adopted the title of "Marcella" as the name of a new brand of cigars which they put upon the market with a narrow band of red paper about five thirty-seconds of an inch in width encircling each cigar, and carrying the name "Marcella."
- 10 Their sales of these cigars rapidly increased, and the average quantity sold in each month of the year prior to the trial was over one million. By reason of the distinctiveness of the band, the Plaintiffs alleged that soon after their introduction on the market, and continuously since, the cigars were commonly asked for, and ordered, and spoken of by the names "Narrow Red Band Cigars,"
- 15 "Little Red Band Cigars," "Red Banders," "Narrow Red Banders," and similar names referring to the "Red Band" or "Narrow Red Band," and that any one who asked for or ordered cigars by any such name intended and expected to receive the Plaintiff Company's "Marcella" cigars, and no others.

- In their Statement of Claim, the Plaintiffs alleged "that it was in 1901 that
- 20 "they were informed that *John Purnell*, who carried on business as a wholesale "cigar merchant at Shoreham, in Sussex, and whom they now sued as *Purnell and Co.*, was selling cigars bearing narrow red bands similar to their own, but "with the word 'Purnella' instead of the word 'Marcella.'" They then communicated with the Defendants, but, receiving no supply, and being unable
- 25 to meet with any such cigars, concluded that they had been misinformed. In November, 1902, they renewed their investigations, and in January, 1903, discovered such cigars of the Defendants on sale in the South of England at a price cheaper than that of the Plaintiffs' cigars. They thereupon issued the writ in this action.

- 30 By their Defence the Defendants denied that the Marcella cigars were spoken of by the names in question except for the purposes of trap orders; they alleged that various other cigar makers had used similar narrow red bands, and said that they had not replied to the letters received from the Plaintiffs prior to these proceedings because they regarded them as idle threats
- 35 (1) in view of the long user of their own narrow red bands, and (2) the common use in the trade.

The action came on for trial before Mr. Justice JOYCE on 2nd of March 1904.

Neville, K.C., Astbury, K.C., Bankes, K.C., and Sebastian (instructed by *McKenna & Co.*), appeared for the Plaintiffs.

- 40 *Walter and St. John Morrow* (instructed by *C. Urquhart Fisher*) appeared for the Defendants.

Neville, K.C., opened the Plaintiffs' case, shortly stating the facts.

- The Plaintiffs' witnesses were then called. *E. J. Lambert*, manager of the "Lambert & Butler" branch of the Plaintiff Company, described the origin of
- 45 and trade in the cigars in question. A number of trade witnesses, including *F. Gage, Swansea; Jesse Saxby, Kilburn; T. S. Bowles, Cardiff; A. Jackman, Glasgow; H. W. Styles, Brighton; V. A. Stewart, Southend-on-Sea; A. F. May, Ryde; J. H. Thompson, Brighton; W. Dickinson, Manchester; J. P. Burns, Glasgow; D. W. Anderson, Glasgow; W. R. Rowland, Redhill; T. C. Dolan,*
- 50 *Liverpool; A. Hughes, Reading; W. J. Lovett, Birmingham; F. Knight, West Bromwich; G. Towill, Exeter; H. Brabeer, Portsmouth; J. R. Miller, Reigate; and N. S. Harvey, Portsea,* gave evidence to the effect that for a period going back thirteen years they had heard the term "narrow red band" applied very frequently to "Marcella" cigars, and had not ever heard it applied to any other
- 55 cigar. A number of customers gave similar evidence, including a carpenter who smoked "two or three shillings worth a week and knew them as often as

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" 'narrow red band cigars' as 'Marcellas,' " and a frequent smoker who said it was six months before he noticed the name " Marcella " on the band. [JOYCE, J.—Nobody smokes a cigar without looking at the band!—Neville, K.C.—Well, my Lord, I positively deny that, because I have smoked many cigars and always take the band off.] H. J. Walsh, a secretary to the Plaintiff Company, deposed 5 as to being handed " Purnella " cigars in response to orders in January 1904 for " narrow red band cigars " at several hotels, including the " Crown Inn " at Portslade, kept by one Greenyer, who, as he alleged, said, " They are cheap, but " a lot of people think they are ' Marcellas.' "

On behalf of the Defendants, a body of evidence was given to the effect that 10 the term " narrow red brand " did not exclusively denote the Plaintiffs' cigars, and that a number of different brands of cigars bearing narrow red bands of practically the same width had been on the market for many years, e.g., " Cuba House," " Prince Imperial," " Hayward's Special," " Sherwood Rangers," " Flor Fina " and others. This evidence was given by T. J. Fletcher and 15 A. H. Dexter, both of Nottingham; A. S. Catlow, Leicester; C. Tyler, Sheffield and Nottingham; A. Bottomley, Halifax; G. J. Freeman, Hoxton; C. M. Smeaton and F. Wooll, traveller and secretary to Robinson & Barnsdale, Ltd., Nottingham; A. J. Temple, Hammersmith; D. Lyons, of Stepney, who had 20 manufactured " Purnella " cigars for the Defendants for the last four years, for three of which he had put the narrow red bands upon them; W. H. Newman, London; J. Moore of the Tobacconists' Supply Syndicate, London; W. Thorpe, London, and others. G. Greenyer, landlord of " The Crown Inn," Portslade, denied making the above-mentioned remarks imputed to him, and said that his words were: " I do not know; they might look a little like them (' Marcellas'), 25 " but they are not the same price." The Defendant John Purnell deposed that in 1878 he had sold cigars called " La Nettie," afterwards " La Nellie," bearing narrow red bands with those names in white letters upon them; that, although his books did not show sales of " Purnellas " earlier than 1894, he had in fact sold them from 1882 or 1883, and at an average of 30,000 a year for the last 30 10 years; and that he had never heard of the Plaintiffs' " Marcella " cigars before 1897.

Walter, summed up the Defendants' case.

Neville, K.C., in reply. The Plaintiffs are entitled to the injunction for which they ask, both because of the probability of deception by means of the 35 narrow red band, and having regard to the manner in which the Defendants adopted the name " Purnella."

JOYCE, J.—This case has occupied a very long time, and no doubt a great deal of money has been spent in the contest, but I think now, as I have thought 40 all along, it really can be disposed of in a very few words.

I am of opinion that the Plaintiffs have not and cannot have a monopoly in any particular width, or length if you please, of a plain red band, the use of such band—a plain red band—being common and open to the trade. Secondly, I am of opinion that the red bands of the Defendant, each of which is plainly 45 stamped with the word " Purnella," are well and sufficiently distinguished from all other red bands, including the somewhat narrower band of the Plaintiffs, who as a matter of fact, plainly stamp all their bands with the word " Marcella." Every cigar manufacturer or tobacconist in this country is entitled to make or sell cigars of any size or shape he pleases, and no one can doubt that the practice of applying bands to cigars for sale is common and open 50 to the trade. It was not contended before me, nor is it the fact, that any manufacturer or dealer is not entitled to apply to his cigars a band of every or any colour he may from time to time prefer, just as much as a grocer may wrap up and sell a pound of tea in paper of any colour he pleases.

No complaint was made before me as to the use of the word " Purnella," and, 55 if such complaint had been made, no ground for it has been established before

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- me. The claim of the Plaintiffs is that no one but themselves is entitled to use for cigars a plain narrow red band like that used by them, whatever may be the legend or letters upon it. I make the Plaintiffs' band to be five thirty-seconds of an inch in width. The Plaintiffs complain of the Defendant's band
- 5 which is about three-sixteenths of an inch in width. As I understand, the Plaintiffs do not complain of a red band as wide as about a quarter of an inch in width. Whether or not they would complain of a red band of less width than their own I do not know, and I think they have discreetly declined to state. This is the first time I have ever heard of such a thing as a right to a monopoly
- 10 in any particular width in a common band or anything of the kind. The size or colour of the band, or particular width of the band is incapable of registration, and its use cannot be protected under any Statute in force in this country. The Plaintiffs to succeed must make out that the use of a narrow red band by the Defendant was fraudulent in its origin, or has become so since by reason of
- 15 his having notice of what the Plaintiffs were doing. The Statement of Claim does not allege, nor in my opinion is there any ground for suggesting, that there has been any actual fraud in the Defendant, or that there has been any attempt or intention on his part to steal the Plaintiffs' trade. In my opinion the Defendant is a perfectly honest trader.
- 20 Upon the evidence I am not satisfied that the use of a narrow red band, when adopted by the Plaintiffs' predecessors, was novel or peculiar to them. I think such a band was probably used quite as early, if not earlier, by other people, if not by the Defendant himself. He has certainly used it for many years, and it has been used at various times by different persons, though many
- 25 of these have been intimidated, I think I may say, by the Plaintiffs into giving it up.

- I do not doubt that the Plaintiffs have used and do use a narrow red band to a greater extent than any other manufacturer; but this does not confer any exclusive right upon them. The only shadow of a foundation for the Plaintiffs'
- 30 claim is that the Plaintiffs' cigars, as it is alleged, have been occasionally asked for by persons, sometimes in jest or sometimes, though I doubt it, because they were unacquainted or imperfectly acquainted with the proper designation of these cigars, as a cigar with "a red band" or "narrow red band," which no doubt it is. If and so far as the Plaintiffs' cigars have been asked for by "a red
- 35 "band" I think that is immaterial, for a red band is open to the trade. If and so far as they have been asked for by "a narrow red band" that is somewhat different, but I am of opinion that the extent to which this has been done has been very much exaggerated by some of the witnesses on behalf of the Plaintiffs, and the fact of an article being occasionally asked for by a characteristic
- 40 common to itself and others which is open to the trade, gives no right to a monopoly of that characteristic. I am of opinion that a matter of one, or two, or three-sixteenths of an inch in difference in the width or narrowness of a band, which is open to the trade to use, cannot make the thing "distinctive" in the sense in which that term is used in cases of this kind. In the present
- 45 case the proper and sufficient distinction is in the name on the band.

- In my opinion the case is not like that of *Reddaway v. Banham* (12 R.P.C. 83; L.R., 1895, 1 Q.B. 286; 13 R.P.C. 218; L.R., 1896, App. Cas. 199), where the Jury found that "camel hair belting" meant belting made by the Plaintiff, as distinguished from belting made by other manufacturers, but it is more like the
- 50 case of the *Cellular Clothing Company, Ltd. v. Maxton and Murray* (15 R.P.C. 581; L.R., 1899, App. Cas. 326), where it was held that the word "Cellular" was an ordinary English word which appropriately and conveniently described the cloth by which the goods sold by the Respondents were manufactured, but the term had not been proved to have acquired a secondary or special meaning
- 55 so as to denote only the goods of the Appellants. If I am bound to state my opinion I do state that it has not been proved in this case that the words "narrow

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"red band," in connection with cigars, have acquired such a secondary or special meaning as to denote only the goods of the Plaintiffs.

I am of opinion that the Plaintiffs' cigars and the Defendant's cigars are perfectly distinguishable in the market by any customer whose peculiarities can be rightly regarded by the Court in considering cases of this kind, and I think a passage from the judgment of Lord Justice *Romer* in *Payton and Co., Ltd. v. Snelling, Lampard and Co., Ltd.* (17 R.P.C. 57) which judgment was expressly approved by the House of Lords (17 R.P.C. 628) applies to this case: "It seems to be a sort of popular notion of some witnesses that in considering whether customers are likely to be deceived you are to consider the case of an ignorant customer who knows nothing about, or very little about the subject of the action. That is a great mistake. The kind of customer that the Courts ought to think of in these cases is the customer who knows the distinguishing characteristics of the Plaintiff's goods, those characteristics which distinguish his goods from other goods on the market so far as relates to general characteristics. The customer must be one who, knowing what is fairly common to the trade, knows of the Plaintiff's goods by reason of these distinguishing characteristics. If he does not know that, he is not a customer whose views can properly, or will be regarded by this Court. Otherwise, see what would happen. There are many customers who have very little knowledge of goods on the market. In this case consider coffee tins. There is many a customer, for example, who deals at one particular small shop. He is accustomed to have his coffee sold to him in a round tin of one shape and in a red colour. He knows no other kind. Naturally if that man went to that same shop and was served with a tin of the same size and the same colour, knowing no other, he might well say, 'I thought this coffee was the same as the coffee that had always been served to me in this shop,' and yet it might turn out that if he knew the market the second tin was perfectly distinguishable from the first, and that the only relation between the two, the shape of the tin and the colour, was perfectly common to the market. A customer like that must not be regarded or considered in dealing with cases of this class, and I think that the Plaintiffs in cases of this kind are too fond of laying hold of customers of the class I have been referring to, persons of an ideal character, who either are particularly innocent or too easily deceived; but considering the customers whose views ought to be regarded in a case of this kind, I cannot come to the conclusion that the Defendants' tins could be used for a moment to deceive those customers." In the present case no real instance of mistake or deception by reason of there being a similarity in the bands used by the Plaintiffs and Defendant respectively has been proved, though both kinds of cigars have been sold for years; moreover I distrust the evidence of the Plaintiffs' witnesses who were sent to endeavour to get some of the Defendant's cigars sold to them as and for cigars of the Plaintiffs, and I ought to add this that I do not believe that Mr. *Greenyer* ever made the remark attributed to him by one of the Plaintiffs' witnesses, namely that the cigars were "cheap but a lot of people think they are 'Marcellas.'" I do not believe such a remark was ever made. There is no evidence that the Defendant's bands have done the Plaintiffs the slightest harm, I do not believe that the Plaintiffs have sustained one farthing damage by what has happened. In my opinion this is an attempt to acquire a monopoly to which the Plaintiffs are not entitled and to oppress other people and I can come to no other conclusion on the whole case but that this action fails and must be dismissed with costs.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE KEKEWICH.

January 26th, 27th, and 28th, 1904.

WURM v. WEBSTER AND GIRLING.

- 5 *Trade name of Band.*—Action for injunction to restrain Defendants from representing their Band to be the Plaintiff's by the use of certain names.—Action dismissed.

W. brought an action against W. and G. to restrain them from representing any band other than the Plaintiff's Band to be the "White Viennese Band," the
 10 *"White Hungarian Band," or the "White Band," claiming these titles as the trade names of his Band. At the trial he abandoned his case as to the two last titles.*

Held, that the Plaintiff had failed to establish that the title "White Viennese Band" had acquired a secondary signification as denoting his Band only, and
 15 *that no case of passing off had been established against the Defendants, and the action was dismissed with costs.*

On the 19th of November 1901, Anton Stanislaus Wurm commenced an action against Webster and Girling and Frank Oliver Charles Harrington. The Statement of Claim was as follows:—“(1) The Plaintiff, who was born in
 20 “Austria, is the proprietor and conductor of a band of Austrian and Hungarian musicians, known as ‘The White Viennese Band,’ ‘The White Hungarian Band,’ and the ‘White Band.’ The Defendant, Harrington, is also the conductor and proprietor of a band, which is generally known as ‘Harrington’s
 “Band,’ and the Defendants, Webster and Girling, are theatrical and musical
 25 “agents, carrying on business at 44 Upper Baker Street, in the County of London. (2) The Plaintiff’s said band has, since 1891, been well known throughout this country, and has acquired a great reputation and popularity under the said names or some or one of them, and it has always worn and been distinguished by a white uniform. No other band is known or has
 30 “acquired any reputation under the said names or either of them, nor is any other band well known or distinguished by a white uniform, and the use of any such names or a like name, or the same uniform or a like uniform, in connection with any other band than the Plaintiff’s said band, is calculated to mislead and deceive, and to induce the belief that such band is the Plaintiff’s
 35 “band. (3) About the beginning of the month of September 1901, the

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"Reverend *C. H. Gould*, the Rector of the Church of St. Paul, in the city of
 "Winchester (where the Plaintiff's said band is well known under the said
 "names, and by the said uniform), applied to the Defendants, Messrs. *Webster*
 "and *Girling*, through Messrs. *Teague and King*, music sellers, in the said
 "city, to engage 'The White Viennese Band,' meaning thereby the Plaintiff's 5
 "said band, to perform at the Guildhall, in the said city, on the 3rd of October
 "1901, and the said Defendants agreed to engage the said band for such
 "performance. (4) The said Defendants did not in fact engage the Plaintiff's
 "said band for such performance, but arranged with the Defendant, *Harrington*,
 "that he (the said Defendant) should take his band to perform at the place, and 10
 "on the date above-mentioned, under the name of 'The White Viennese Band,'
 "and the said Defendant's should be passed off as the Plaintiff's band. (5) By
 "reason of the arrangement above stated, the band of the Defendant, *Harrington*,
 "was from an early date in September down to the 2nd of October 1901,
 "extensively advertised for the said performance, as well in newspapers as in 15
 "posters, in and about the said city, as 'The Celebrated White Viennese Band,'
 "and on the 3rd day of October 1901, as 'Herr *Moritz Francois*' White Hungarian
 "'Band,' and on the last-mentioned date the Defendant, *Harrington*, and his said
 "band performed at the said Guildhall under the said names or one of them,
 "and the members of his said band were dressed in a white uniform similar to 20
 "that worn by the Plaintiff's said band, and by reason of such advertisement
 "and uniform the belief was induced that the said Defendant's band was the
 "Plaintiff's band. (6) The Defendants have, on other occasions, particulars
 "whereof the Plaintiff cannot at present give, but which are well known to the
 "Defendants, passed off the Defendant *Harrington's* band, as the Plaintiff's 25
 "band, and they threaten and intend to continue to pass off the said Defendant's
 "band as the Plaintiff's band, by calling it or advertising it by one or more of
 "the said names by which the Plaintiff's band is well known, or by some name
 "similar thereto, and by using a white uniform similar to that of the Plaintiff's
 "band in connection therewith. (7) By reason of the premises the Plaintiff 30
 "has suffered damage." The Plaintiff claimed "(1) an injunction to restrain
 "the Defendants and each of them from advertising or in any way representing
 "any band, other than the Plaintiff's band, to be 'The White Viennese Band,'
 "or 'The White Hungarian Band,' or 'The White Band,' and from advertising
 "or representing in any way, either by the use of any similar name or of a white 35
 "uniform that the Defendant *Harrington's* band, is the Plaintiff's band. (2)
 "Damages."

The Statement of Defence was as follows : "(1) As to paragraphs 1 and 2 of
 "the Statement of Claim, the Defendants admit that the Plaintiff and the
 "Defendant, *Frank Oliver Charles Harrington*, are respectively proprietors 40
 "of bands, and the Defendants, *Webster and Girling*, are carrying on business
 "as theatrical and musical agent as alleged. The wearing of a white military
 "or quasi-military uniform is found by the conductors and proprietors of bands,
 "such as the Plaintiff's and Defendant's to be attractive, and the Plaintiff and
 "Defendant *Frank Oliver Charles Harrington*, are accustomed to dress 45
 "their respective bands in uniforms of that colour. Except to the extent
 "aforesaid, paragraphs 1 and 2 of the Statement of Claim, and every allegation
 "therein contained are denied. (2) As to paragraphs 3 and 4 of the Statement
 "of Claim, the Defendants say that on or about the 29th July 1901, the
 "Defendants, *Webster and Girling*, received from Messrs. *Teague and King* in 50
 "the said paragraph 3 mentioned (but not from the Reverend *C. H. Gould*, in
 "the said paragraph also mentioned) an application as to the cost of 'five or
 "'six members of the White Austrian Band.' By that expression the Plaintiff's
 "band was not meant but the Defendant's band, or alternately any band dressed
 "in a white uniform of the character above-stated, which the Defendants, 55
 "*Webster and Girling*, were in a position to engage. The Defendants, *Webster*
 "and *Girling*, were in a position to engage the Defendant *Frank O. C.*

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- "Harrington's said white uniformed band, and a clerk of theirs replied meaning to give a quotation as to the cost of six members of such band. The Defendants, Webster and Girling, did not, nor did the said clerk mean in the said reply to refer, nor did they refer to the Plaintiff's band, nor did the Defendants
- 5 "Webster and Girling, agree to engage the same. By a mistake the said clerk in the said reply called the Defendant *F. O. C. Harrington's* said band 'The White Viennese Band.' It is by the Defendant, *F. O. C. Harrington*, and should have been by the said clerk described as 'The White Hungarian Band,' or (more fully) '*Francois*' or '*Herr Moritz Francois*' White Hungarian Band,"
- 10 "'*Francois*' or '*Herr Moritz Francois*' being a *nom d'orchestre* of the Defendant, *F. O. C. Harrington*. The Defendant, *Harrington*, does not, nor do the other Defendants desire that the phrases, 'White Viennese,' or 'Viennese White' should be applied to the Defendant, *Harrington's* band, and disclaim that title as applied thereto, of this the Plaintiff is well aware.
- 15 "The Plaintiff's band is not well known in Winchester under the names, or by the uniform in the said third paragraph alleged, or at all. The Defendants absolutely deny, that the Defendants, *Webster and Girling*, arranged with the Defendant, *Frank Oliver Charles Harrington*, that he should take his band to perform as alleged, or at all, under the name of 'The White Viennese Band,'
- 20 "or that the Defendant, *Frank Charles Oliver Harrington's* said band should be passed off as the Plaintiff's band. The Defendant, *Frank Charles Oliver Harrington*, was not aware of the correspondence between the said Messrs. *Teague and King*, and the Defendants, *Webster and Girling*, or their said clerk. (3) As to paragraph 5 of the Statement of Claim, the Defendants deny
- 25 "the alleged advertisements, and respectively say that they were not responsible therefor, if the same in fact existed, except to the extent, and under the circumstances following: The said Messrs. *Teague and King*, on the 17th September 1901, wrote to the Defendants, *Webster and Girling*, in reference to the said portion of the said band of the Defendant, *Harrington*—
- 30 "'Are we right in describing it as a part of Herr *Wurm's* band?' meaning the Plaintiff's band, and the Defendants, *Webster and Girling*, replied on the 18th September 1901, again using the word 'Viennese' by inadvertence for 'Hungarian.' 'The band must be advertised as '*Herr Moritz Francois*' White 'Viennese Band.' It is in every respect equal, if not superior to the one
- 35 "mentioned by you, but has nothing to do with the conductor named.' Thereupon, for some days the said band was advertised, as in the said letter directed. The Plaintiff, asserted to the said Reverend *C. H. Gould*, and or to the said Messrs. *King and Teague*, that the Defendant *Frank Oliver Charles Harrington's* band, was being represented as his, and the Defendants, *Webster*
- 40 "*and Girling*, on hearing of his allegation through their solicitors, offered the Plaintiff the engagement for his band, which the Plaintiff refused. Such offer was made to avoid any possible ground of complaint, and on the Plaintiff's refusal, the Defendants, *Webster and Girling*, directed Messrs. *Teague and King* to advertise, and they did in fact advertise throughout
- 45 "Winchester, as follows: 'The band which will perform to-day, is '*Francois*' 'White Hungarian Band' and not 'White Viennese' as accidentally described.' Members of the Defendant's said band, did perform at the Guildhall in their accustomed white uniform, under the description of '*Francois*' or '*Herr Moritz Francois*' White Hungarian Band. The Defendants do not admit that such
- 50 "uniform is so similar to the uniform of the Plaintiff's band as to create confusion, and in any event the belief alleged in the said paragraph has not been in fact induced, or alternatively, if it was the Defendants were not responsible therefor. (4) Paragraph 6 of the Statement of Claim, and every allegation therein is denied. (5) The Defendants deny the damage in
- 55 "paragraph 7 of the Statement of Claim alleged, but while denying liability the Defendants have paid into Court, the sum of £10 in satisfaction of the damages claimed by the Plaintiff herein."

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By his reply, the Plaintiff joined issue on the Defence, but accepted as satisfaction of the damages claimed the sum of £10 paid into Court.

The action came on for trial before Mr. Justice KEKEWICH on January the 26th, 1904. *Dickens*, K.C., *Warrington*, K.C., and *Jessel* (instructed by *Russell and Arnholz*) appeared for the Plaintiff; *Danckwerts*, K.C., *P. O. Lawrence*, K.C., 5 and *Rowlands* (instructed by *Lermite and Jerome*) appeared for the Defendants.

KEKEWICH, J.—Notwithstanding the numerous questions which have been raised and discussed in the course of this trial, I think the case may very well be disposed of on one ground. The real issue is whether the title of the Plaintiff's band, whatever that title may be, has acquired a secondary meaning, so that it is now known as his band without the use of his name, and that, when that title is used, everyone who ought to know at once recognises that the Plaintiff's band is referred to, and no other. That is what I understand is intended by a secondary meaning. I say everyone who ought to know, because it cannot be supposed—and was not supposed in the cases which have been referred to—the *Stone Ale* case and the *Yorkshire Relish* case, and others—that all the world knows, and that it is universally known. It is only known to those who, either from the trade or from their habits, would be likely to know. 10 15 20

First, I have to ask what is the title of the Plaintiff's band? He put forward in his Statement of Claim—and he adhered to it in his Answer to Interrogatories—three alternative titles, first, "The White Viennese Band," which I may say at once, to save repetition, may be taken to be synonymous with the "Viennese "White Band"; secondly, "The White Hungarian Band"; and thirdly, "The "White Band." It would have been practically impossible for him to have succeeded in that claim, because I think it is inconceivable, according to my knowledge of the world and the use of language, that the Plaintiff could have proved that the three titles of his band had all acquired secondary meanings so as to denote his band and his band only. The Plaintiff's Counsel discreetly gave up at once "The White Hungarian Band," and at the conclusion of the Plaintiff's evidence he also gave up "The White Band," with, if I may say so, equal discretion. It was certainly the weakest of the lot. Again, I cannot conceive it practically possible that anyone could establish a title to "The White "Band," so that nobody else could call their band "White." However, we have got those two out of the way, and I need say no more about them. 25 30 35

The question is whether the title "The White Viennese Band" has acquired a secondary meaning, so that among those who ought to know, and who have opportunities of knowing, who deal with bands in one way or another, would at once conclude when they heard the phrase "The White Viennese Band" that the Plaintiff's band, and no other band, was intended. That, to my mind, is the issue. 40

I have heard a great deal about the difference between Viennese music and other music, as to whether there is a conductor, or a leader, or a leader who sometimes conducts. All that seems to me to be, I will not say beside any question, but beside the question which I have to decide. The point on which I propose to dispose of the case is this. The Plaintiff has not proved to my satisfaction that his band is known by the name of "The White Viennese "Band," or has been known by that title so as to give it an opportunity of acquiring a secondary meaning. My conclusion on the evidence is that the Plaintiff's band has been known, and is known generally as "Herr *Wurm's* "White Viennese Band," and that the prefix of his name is really required in order to identify his band. I put aside altogether all the evidence respecting the ordinary prefix or addition of the conductor's name. Probably in a large number of cases you would find the conductor's name published with the title of the band, more perhaps as an advertisement of the conductor himself, and partly also, of course, to intimate to those who are likely to hear it, that the 45 50 55

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band will be conducted by somebody who has a claim to be famous. I put all that aside, I am dealing with the pure question of fact. Mr. *Warrington* in reply, has relied, as of course he necessarily would, on the evidence which he has called to show, that "The White Viennese Band" is understood by many
5 people to mean the Plaintiff's band, and he has also of course, called attention to the absence of evidence the other way. Necessarily there was an absence of evidence on the other side, because it would have been purely negative, and would have been of no avail. I take such distinguished witnesses as Lady *Jeune*, Lord *Pembroke*, and Sir *George Faudel Phillips*. They have employed
10 the Plaintiff; they know him well, and they know how excellent his band is. About that there seems to be no doubt at all, and particularly when it is conducted or led by himself. They know what they are asking for; they know of no other White Viennese Band. Really that is all their evidence comes to at all.

15 On the other hand, I have a large body of evidence pointing to the conclusion that the band is described and known generally as the Plaintiff himself invariably describes it in all the letters I have seen as "Herr *Wurm's* White "Viennese Band." Then remarks have been made on the character of the witnesses, that they are all interested in opening the door for the multiplication
20 of bands. That is perfectly true, but I have had before me a number of witnesses whose veracity I have no reason to doubt at all, and some of whom are extremely pointed. I do not think it necessary to name any but one. I have heard Mr. *Edwards*, the manager of *Chappell's* entertainment department, a gentleman of large experience, who gave his evidence remarkably well, and he
25 not only produced letters, but told me what he himself knew on the matter, and he told me—what others have told me—that if he is asked for "The White "Viennese Band," he would say which? Witness after witness has told me the same story. It is not recognised in the trade as necessarily meaning the Plaintiff's band, and it is in the trade to which you must look; because it is not
30 only among the people who go to listen, or the people who engage the band for the entertainment of themselves and their friends, but the reputation must be obtained among those who as agents and as managers of entertainment departments have to provide a band when required by the inquiries at their offices. They all tell the same story. They very likely know, and they do know, many
35 of them, that the Plaintiff's band is, I may say, the best—at any rate, the best known. They were very hesitating about any other White Viennese Band; they had heard of some, and it is very difficult, I agree, to find out if there is in existence, or has been, any distinct band called by that name, but still there is no denomination among them, no acquired name among them, such as White
40 Viennese Band. They want something else to add to it.

Then Mr. *Warrington* has called my attention to those cases in which the addition of the name of the proprietor did not prevent a secondary title being acquired. Certainly not. I do not say the addition of Herr *Wurm's* name prevents the title acquiring a secondary meaning, but what I do say is that the
45 secondary meaning has not been acquired without his name, that his name has been from first to last regarded as part of the title of his band, and that without it the title is not known in the sense, in which I consider it ought to be known, in order to acquire a secondary meaning.

Let me repeat, I do not pretend to say everybody ought to know. You
50 cannot prove universality, but before you can acquire a secondary meaning for your goods, or for a band, you must prove that among those who deal in such things, yours are generally known by the name which you set up. Among those who sell them, and those who buy them, whether it be ale or Yorkshire Relish, or a band, it is precisely the same story throughout; there must be that
55 general familiarity with the title as describing a particular article, before you can arrive at the conclusion that the secondary meaning has been acquired. In my view it has not been acquired in this particular case. If that is right,

Wurm v. Webster and Girling.

there is no object or reason for going into any of the other items of passing off; I have not heard Mr. *Dickens* on the question, and therefore perhaps I ought not to pronounce a decided opinion. But as at present advised, on the two points that have been raised, having formed a conclusion, I think I had better express it. First, as regards the use of the white uniform,—I know of no rule against 5 any man, who wishes to send a band down to a wedding, or for any other occasion, to prevent his putting his performers into a white uniform. I do not know why, because the Plaintiff uses gold lace, or blue cuffs and collars, another man should not do the same. They are open to all the world. I agree that if you see any other indication of attempting to pass off one band for 10 another, then you may look to the uniform among other indications, and form your own conclusion upon it, but the use of the uniform alone seems to me to be quite defensible. As I have had occasion to say before in a case of this kind, it may not be good taste to take another man's uniform, any more than it is good taste to put coffee into blue tins with a certain amount of lettering very like 15 your neighbour's, but still it is open to you to do so if you please.

Then as regards the Winchester incident, there again, without prejudice to any argument on the part of the Defendants, it seems to me that if the Plaintiff had acquired the title which he says he has, there was an offence committed in the first instance certainly, if not all through, in good faith, without meaning to 20 do any harm. Still I think an offence would have been committed against him, and that he would have been entitled to some relief against both Defendants. But I dispose of that part of the case, as I do of the rest, by saying that he must first prove that he had a title which had acquired a secondary meaning. I hold that he had not, and therefore the Winchester incident falls with the rest of the 25 complaint. There must be judgment, therefore, for the Defendants, with costs.

In the Matter of Geipel's Patent.

IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, STIRLING, and COZENS-HARDY.

January 21st, 22nd, 23rd, and 25th, and February 8th and 9th, 1904.

IN THE MATTER OF GEIPEL'S PATENT.

- 5 *Patent.—Petition for revocation.—Disconformity between Provisional Specification and Complete Specification.—Want of subject-matter, and of utility, and of novelty.—Disclaimer of part of invention.—Patent held invalid on ground of disconformity.—Form of Order of revocation.—Terms imposed on amendment by disclaimer under section 19 of the Patents, &c. Act, 1888.—*
 10 *Patents, &c. Act, 1888, section 26.*

In 1898 Letters Patent were granted to G. for improvements in and connected with steam traps. A Petition was presented for revocation of the Patent, and it was alleged in the Particulars of Objections, as amended and reamended, that the invention was not new, that there was no subject-matter, that the invention
 15 *was not useful, and that the Complete Specification of the Letters Patent described and claimed an invention different from and larger than the alleged invention described in the Provisional Specification. During the hearing of the Petition it was admitted that, in any event, the Specification would require amendment, as one modification of the invention was proved useless. It was*
 20 *held by Buckley, J., that there was good subject-matter for the Patent, but that disconformity between the Provisional Specification and the Complete Specification was established, as the nature of the invention described in the Provisional was the application, in the way described, of the principle of differential expansion, whereas the Complete covered an application, in a*
 25 *particular way described, of the principle of controlled expansion, and that the Patent must be revoked, unless within three months the Patentee obtained leave to amend by disclaimer. It was also held, that if the Specification was amended no injunction was to be asked for in any action brought for infringement of the Patent in respect of any steam traps made prior to the date of*
 30 *judgment, unless the Patentee established to the satisfaction of the Court that his original claim was made in good faith and with reasonable skill and*

In the Matter of Geipel's Patent.

knowledge. The Patentee, Respondent to the Petition, appealed, and there was a cross appeal by the Petitioners against the judgment as to terms under section 19.

Held, that there was no disconformity between the Provisional Specification and the Complete Specification, as otherwise a Patentee could not in any way vary from his Provisional Specification, and that the appeal must be allowed.

Held also, that the Judge had exercised his discretion with regard to terms as to disclaimer, and that the cross appeal must be dismissed.

On the 18th of April 1893 Letters Patent (No. 7860 of 1893) were granted to William Geipel for "Improvements in steam traps."

The Provisional Specification was as follows :—"This invention has reference 10
 "to an improved steam trap or method of draining automatically the condensed
 "water from steam pipes, or steam cylinders or jackets, steam receivers, or other
 "receptacles where it is desired to drain away the water as it forms, without
 "allowing steam to escape. The object of the invention is mainly to make a 15
 "more reliable and less costly apparatus and one which is accessible and can be
 "easily repaired. The apparatus consists essentially of two tubes of metal
 "having as different a coefficient of expansion as practicable, one end of the
 "tubes being the inlet admitting water and steam, the other end being the 20
 "outlet; thus the water or steam are within and not outside of the tubes.
 "These tubes may be either straight or bent into a circle, they are firmly
 "connected at both ends, one of the junctions being free to move, the other
 "being fixed; there is a slight distance between the ends of the tubes at
 "the fixed junction, but at the free junction they may be close together. In the 25
 "case of the straight tubes the two form two sides of a triangle the base into
 "which they are fixed making the third and smallest side. According as the
 "pipes are hot or cold the relative lengths thereof alter and cause movement
 "at one of the angles, this movement takes place at what I have called the free
 "end. Similarly if the two tubes are bent to a circle or part of a circle as 30
 "above mentioned, unequal changes in length of the tubes must cause motion
 "at the free end. The free end is attached either by a link, or levers, or rack
 "and pinion, or other device to the spindle of a cock or valve which is fixed on
 "the discharge out-let to atmosphere; the motion above mentioned causes the
 "cock or valve to be opened or shut according as there is water or steam only 35
 "in the pipe. I use preferably one brass and one iron tube, the brass tube
 "being nearest the steam inlet—the iron nearest the water out-let. When both
 "tubes are cold the cock or valve is held open, but when steam passes the brass
 "tube expands most and the cock is closed until water forms in sufficient
 "quantity to again cool the pipes. I may arrange the pipes so that they are not 40
 "in the same plane, in which case there is a circular movement caused which
 "I may use for operating the valve as above set forth. It will be observed that
 "there is no box or receptacle into which the working parts are placed as is so
 "often the case, on the other hand they are all exposed and thus free from the
 "destroying action of any impurity or deposit from the steam or water. The 45
 "water and steam merely pass through the tubes and the valve or cock which is
 "fixed at the end to atmosphere. There can be no loss of movement owing to
 "slackness of working parts so far as concerns the tubes; this is an important
 "desideratum, as the expansion is comparatively small and is so easily lost
 "where there are working joints. The opening and closing of the valve or 50
 "cock is regulated by adjusting the link or levers above described, there are
 "many obvious methods of doing this. There are other obvious ways of
 "arranging this steam trap, for instance, instead of having only two tubes I
 "may use three or more, and I may use a bell crank or other plan in place
 "of a lever for the triangular form of trap.

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The Complete Specification was as follows:—"This invention has reference to an improved steam trap or method of draining automatically the condensed water from steam pipes, or steam cylinders or jackets, steam receivers, or other receptacles where it is desired to drain away the water as it forms, without allowing steam to escape. The object of the invention is mainly to make a more reliable and less costly apparatus and one which is accessible and can be easily repaired. The apparatus consists essentially of two tubes of metal having as different a coefficient of expansion as practicable, one end of the tubes being the inlet admitting water and steam, the other end being the outlet; thus the water or steam are within and not outside of the tubes. These tubes may be either straight or bent into a circle, they are firmly connected at both ends, one of the junctions being free to move, the other being fixed; there is a slight distance between the ends of the tubes at the fixed junction, but at the free junction they may be close together. In the case of the straight tubes the two form two sides of a triangle the base into which they are fixed making the third or smallest side. According as the pipes are hot or cold the relative lengths thereof alter & cause movement at one of the angles, this movement takes place at what I have called above the free end. Similarly, if the two tubes are bent to a circle or part of a circle as above mentioned, unequal changes in length of the tubes must cause motion at the free end. The free end is attached either by a link, or levers, or rack & pinion, or other device to the spindle of a cock or valve which is fixed on the discharge outlet to atmosphere; the motion above mentioned causes the cock or valve to be opened or shut according as there is water or steam only in the pipe.

"I use preferably one brass & one iron tube, the brass tube being nearest the steam inlet, the iron nearest the water outlet. When both tubes are cold the cock or valve is held open, but when steam passes the brass tube expands most & the cock is closed until water forms in sufficient quantity to again cool the pipes.

"Referring to the drawings Fig. 1 shows the trap arranged with straight tubes; Fig. 2 with tubes bent to a part of a circle both of which are shown with cocks operated by a lever on bell crank. Fig. 3 shows in section the trap arranged with a valve, and Fig 4 is an end view of the same, the tubes being in section through A. B. *a, a*, are the tubes having the higher coefficient of expansion, preferably of brass or copper; *b, b*, are the tubes having the lower coefficient, preferably of iron; steam or water enters at *c* or *c*₁, and leaves at *d*; *e* is the base into which the ends of the tubes are fixed, this in the case of Figs. 3 and 4 is shown combined with a receptacle for holding a certain quantity of water should there be a sudden rush; *f, f*, are the levers or bell crank for connecting the free end of the tubes *i, i*, with the plug of the cock or spindle of the valve. The working of the trap may be more easily understood by reference to the diagram Fig. 5. When the tubes are cold or comparatively cold, which will be the case so long as they contain water, they take up the position shown by the full lines; but whenever the water is discharged & steam follows then the tubes become hotter, & the sides *a*, of the triangle expands most, the tubes assuming the position shown by the dotted lines; the base, *e*, being fixed. Consequently the lever, *f*, moves from the position shown in the full lines to that in the dotted lines and so closes the valve or cock. When water again enters the tubes they cool, and side, *a*, contracts most thus bringing the tubes back to the position shown in the full lines & reopening the valve or cock, & so on.

"I may arrange the pipes so that they are not in the same plane, in which case there is a circular movement caused which I may use in operating the valve as above set forth.

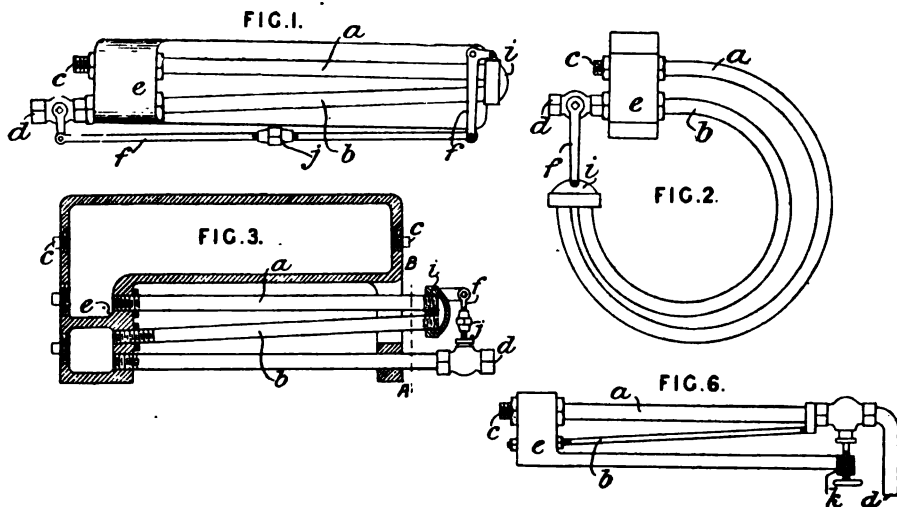
"It will be observed that there is no box or receptacle into which the working parts are placed as is so often the case with other traps, on the other hand the

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"working parts are all exposed & thus free from the destroying action of any impurity or deposit from the steam or water. The water & steam merely pass through the tubes and the discharge valve or cock. There can be no loss of movement owing to slackness of working parts so far as concerns the tubes; this is an important desideratum as the expansion is comparatively small & is so easily lost where there are working joints. 5

"The opening and closing of the valve or cock is regulated by adjusting the link or levers *f*, above described by the nut *j*, or otherwise, there are many obvious methods of doing this.

"There are other obvious ways of arranging this steam trap, for instance, 10 instead of having only two tubes I may use three or more, or instead of one of the tubes I may use a tie rod. Such an arrangement is shown in Fig. 6. In this case the length of the rod, *b*, remains constant while according as the tube, *a*, is cold or hot the valve is opened or closed. In this case the valve is moved, the spindle being adjusted by the screw, *K*, to a fixed position. Since 15 the valve and outlet move in this arrangement I may use a flexible tube or expansion piece or bellows, in case it is necessary to conduct away the discharged water; or I may place the valve at the junction of the two tubes at the free end so that the iron tube, *b*, carries off the water after passing the valve, the length of the tube, *b*, in this arrangement remains practically 20 constant, & the opening & closing is done by the contraction and expansion of the tube *a*.



"In some cases I may insert a receiver between the inlet to the trap and the steam pipe or vessel in order to hold a body of water in the event of a sudden rush." 25

The Patentee claimed:—"First. A steam trap wherein the opening & closing of the discharged valve or cock is effected by the motion set up by two or more tubes of metal having different expansion co-efficients, the said tubes being fixed at one end & free to move at the other end, the water or steam passing through the inside of the tubes only, as above explained. Second. 30 The combination of two metal tubes having different expansion co-efficients, or of one metal tube & one tie rod having different expansion co-efficients & through which water & steam are discharged, one end of the said tubes, or

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"tube & rod, being fixed, & the other ends being connected together & free to move with a lever, or link, or spindle, or other similar arrangement for opening & closing the outlet valve or cock substantially as described Third. The improved apparatus for discharging water from steam pipes, or receivers, or other vessels arranged and operating substantially as above described."

- 5 In January 1903 a Petition was presented by *Charles Hibbert Berry* (under the authority of the Attorney-General) for the revocation of the Patent. The Petition alleged that the Patent was invalid for the reasons set forth in the Particulars of Objections.
- 10 The Particulars of Objections were as follows :—" 1. The said alleged invention was not new at the date of the said Letters Patent. The said alleged invention was published in this realm prior to the date of the said Letters Patent in the following Specifications :—[Fifteen Specifications were mentioned (for which see 20 R.P.C. 549) including *Kusenberg* No. 1084 of
- 15 "1875, and *Royle* No. 807 of 1877.] The whole of each of the above Specifications is relied on as against all the claims in the Specification of *Geipel* (No. 7860 of the year 1893). 2. The said alleged invention is not the proper subject-matter of Letters Patent. The Petitioner will rely in support of this objection upon all the Specifications set out in paragraph 1 hereof and upon
- 20 "the common general knowledge in the trade of the construction and working of steam traps. 3. The said alleged invention is not useful. 4. The Complete Specification of the said Letters Patent describes and claims an invention different from and larger than the alleged invention described in the Provisional Specification. The Petitioner intends to allege that the combination of
- 25 "one metal tube and one tie-rod used as described in the said Complete Specification and claimed in the second and third claims thereof is not described or foreshadowed in the Provisional Specification."

- The Petition came on for hearing in June 1903 before Mr. Justice *Buckley*, who held that there was good subject-matter for the Patent, but that discon-
- 30 formity between the Provisional Specification and the Complete Specification was established, as the nature of the invention described in the Provisional was the application, in the way described, of the principle of differential expansion, whereas the Complete covered an application, in a particular way described, of the principle of controlled expansion, and that the Patent must be revoked,
- 35 unless within three months the Patentee obtained leave to amend by disclaimer. He also held that, if the Specification was amended, no injunction was to be asked for in any action brought for infringement of the Patent in respect of any steam traps made prior to the date of judgment unless the Patentee established to the satisfaction of the Court that his original claim was made in
- 40 good faith and with reasonable skill and knowledge.*

The Respondents to the Petition appealed, and the Petitioners also appealed against the Order of *Buckley, J.*, as to terms in case of disclaimer. On the hearing of the appeals,

- Bousfield, K.C.*, and *A. J. Walter* (instructed by *Frank Evelyn Jones*, agent for *W. T. Hill*, of Manchester) appeared for the Appellants; and *T. Terrell, K.C.*, *Astbury, K.C.*, and *Gray* (instructed by *Faithfull and Owen*) appeared for the Respondents.

- Bousfield, K.C.*, for Appellant.—The Patent has reference to steam traps. It is an apparatus for automatically letting out of hot steam pipes the condensed
- 50 water which accumulates there. The device by which this invention works is founded upon what one may call the differential expansive action of two members which are heated by the steam. When the steam condenses and hot water accumulates at a point, that hot water gradually gets cold. When that hot water is discharged steam comes in where the hot water was before and

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expands a portion of the pipe which before was cooled by the hot water. So that this invention has to do with the particular way of utilising the expansion and contraction so produced for the purpose of automatically opening and shutting the valve. [COZENS-HARDY, L.J.—Has Mr. Justice *Buckley* held the Patent invalid on the ground of disconformity?] Yes, he held it bad on two 5 grounds. First, on the ground that Fig. 2 will not work. We accept that portion of the judgment. The other ground was that the particular modification shown in Fig. 6 was not in the Provisional Specification. That is the part of the judgment we are challenging. My observations will be directed to the one point, as to whether Fig. 6 is or is not a proper modification of the kind of 10 thing which was described in the Provisional Specification. I say that Fig. 6 is a legitimate and proper development or modification of that which is described in the Provisional Specification as Fig. 3. Instead of two tubes, there is a tube and a solid rod. On the evidence, this solid rod contracts and expands, but very little. To put the case against me at its highest, I assume that the rod B 15 remains a fixed length. There is, therefore, B remaining constant, still the difference in length of the legs, which produces the result desired. As a matter of fact, the expansion of B as a tube in Fig. 3 works against the result. In that respect Fig. 6 is better than Fig. 3. There is still differential expansion. If in Fig. 3 we could get a material of which the coefficient was zero, which did not 20 expand, or of which the coefficient of expansion was negative—that is, which contracted—that would be better. These things are physically possible. There are some things which contract with heat; water, for instance, below four degrees Centigrade. The action of Fig. 6 can be put in this way. Supposing A and B expand equally you get no movement at the valve; but the less the 25 expansion of B is, the more movement you get. In Fig. 6 you may reduce the expansion of B to nothing, that is all. [The Specification was read.] The other side contend that the Patentee has described in that an apparatus consisting essentially of two tubes, and that in Fig. 6 there are not two tubes, but one tube and a tie rod. The Specification says “the water or steam is thus within and not 30 “outside the tubes. These tubes may be either straight or bent into a circle, they “are firmly connected at both ends, one of the junctions being free to move, “the other being fixed.” The one point against me is the fact that Fig. 6 has a tie rod instead of a second tube. I have three observations to make on that point. The first is that, supposing there was no Provisional Specification, there 35 would be no difficulty in reading the Complete Specification as a whole, namely, that description in which the Patentee says it consists essentially of two tubes, and the clause in which he says you may modify it by only having one. There is nothing there inconsistent. Secondly, reading that sentence to the end, it is evident that the real essence is not the two tubes, but this, “Thus the water or 40 “steam are within and not outside of the tubes.” By essential he meant no more than “important.” When he says that his apparatus consists of two tubes with a different coefficient, “one end of the tubes being the inlet “admitting water and steam, the other end being the outlet; thus the water or “steam are within and not outside of the tubes,” he is referring to what is 45 essentially an important feature; that instead of having this thing dipped in water and living in water it is something through which the steam passes, so that it does not tend to become decomposed. Thirdly, that is not the language of limitation but of description. This is an engineer describing his apparatus. He is not in those words attempting to define his invention in the sense of 50 distinguishing it from other things that have gone before; he is simply wanting to point out what is the important feature of it. [The evidence was referred to and Mr. Justice *Buckley*'s judgment in the Court below was read.] The learned Judge classified the apparatus thus—those moved by free expansion, those moved by controlled expansion, and those moved by differential expansion. 55 As to Fig. 6 the learned Judge said “the water and steam do not pass “through two of the tubes so as to call into action their relative expansions,

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"but it passes only through the one tube, and the outlet is at the end of that, and there it is discharging. Subject to something that I am going to say, the result of that is that he is here availing himself, not of the principle of differential expansion, but of the principle of controlled expansion."

- 5 The case where one of the tubes does not expand is that of equal differential expansion. The two legs are connected together, and one of them expands more than the other. Supposing one expands and the other does not expand at all, it is still the difference in the length of these legs, produced by expansion, which causes the movement. Fig. 6 and Fig. 3 cannot be put into
10 a different class and one called a case of controlled expansion and the other differential. The learned Judge said, "Fig. 6 is, as I say, not based upon the principle of differential but on that of controlled expansion, and it seems to me to be really in a modified form just what *Royle* and *Kusenberg* did." It is only the modified form we are claiming. We claim the arrangement of
15 two legs, coming to a point so that they get the sideways movement shown in the figure. Nothing of that is touched by *Royle* or *Kusenberg*. The learned Judge held that the Patentee relied on controlled expansion, and, that being so, there was disconformity between the Provisional Specification and the Complete Specification. It is an artificial distinction—the distinction between
20 controlled and differential expansion. It might be said that both Fig. 6 and Fig. 3 are examples of controlled expansion, because, of course, the movement of the end point is a movement by the two tubes which connect it to the base. The function of the parts is to be considered, and whether Fig. 6 is not a reasonably fair modification of Fig. 3, and whether it does not grow out
25 of Fig. 3, and whether it is not such a modification that the Patentee is really bound, having gone into it, during the period of provisional protection, to describe it to the public in order to deal fairly with the public, and show an alternative form—certainly advantageous—which he has come to in the course of his experiments. There is nothing new in the principle of differential
30 expansion. But this Patent is a new application of the principle. It is to have the two tubes which expand differently, and to fix them at one end upon a base to join the other two things together. We are using the same principle when, instead of having two tubes, we simply have one of them a rod, which for this purpose remains at constant length. The movement is still obtained because
35 one leg is lengthened under the influence of the steam, so that you get a differential expansion of the two legs, and we still pass the steam through the one tube whether it is the combined tube A and B or not. The case of *Woodward v. Sansum* (4 R.P.C. 166) has a bearing on this case, particularly the judgment of *Cotton*, L.J., at the bottom of page 174, and the judgment of *Lindley*, L.J., in the middle of page 177. [*Gadd v. Mayor, &c. of Manchester* (9 R.P.C. 516) and *Ward v. Hill* (20 R.P.C. 189) were also referred to.]

- T. Terrell*, K.C., and *Gray* for the Respondents.—The question of disconformity is a serious point in patent law. If a man is allowed by cover of having
45 a provisional protection to get as his Patent something which he did not invent at the time he lodged his Provisional Specification, he may get ahead of inventors who really did invent it first, and get a prior date to them. This case must be decided from two points of view—first, as a matter of construction of the Specification, and then as a matter of fact as to the Specification. The
50 Specification of all Letters Patent is a document addressed to the public, who are supposed to read it with the knowledge of the art of the time. The state of the art in question at the time of this Patent was this—there were many different sorts of steam traps. The rods were known. The use of the expansion movement of steam was well known, and the two traps, *Kusenberg* and *Royle*,
55 were also known. *Kusenberg* is a case of distortion by controlled expansion. By means of this controlled expansion he gets a large movement on the valve, and is able to open and shut his valve. *Royle* is *Kusenberg* upside down.

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Geipel operates by the same principle. The difference between *Geipel's* Fig. 6 and *Kusenberg* is that he has used his distortion at the end, and *Kusenberg* has used his distortion in the middle. Both used the same distortion for the same purpose, but took it from a different point. The learned Judge said: "It seems to me to be really in a modified form just what *Royle* and *Kusenberg* 5 "did." Supposing he had held there was no disconformity, he would have to hold the Patent was bad because of *Kusenberg* and *Royle*. There must be two different metals to allow the principle of difference of coefficient expansion to operate. The essence of this invention is that the whole thing must work at the same temperature or else it would not be a steam trap at all. If the inven- 10 tion is to be read so widely as to include every restraint which makes a distortion, then *Kusenberg* becomes an anticipation. The two arguments on disconformity and subject-matter are correlative, and there must be election of one. In that case, the question is whether Fig. 6 ought to be disclaimed or not. There must be substantial invention. *Geipel* in Fig. 6 uses the new 15 principle of having two tubes of two different metals as well as the old principle of distortion. Fig. 6 does not work by that new principle. It is in effect *Kusenberg*, and, if Fig. 6 is nothing but a development of Fig. 3, then Fig. 3 and Fig. 6, being the same invention, do not contain subject-matter which distinguishes them from *Kusenberg*. The Patentee says that it is necessary for 20 him to obtain a motion of the valve under circumstances in which the valve is raised from one temperature to another, yet in neither Specification is a case contemplated in which one part of the valve is at a different temperature from another. Two tubes of the same metal will not do. There must be two tubes of different metals. The Patentee is not entitled to claim Fig. 6 whether he 25 had invented it or not. If Fig. 6 is allowed, then the Patent is too wide, on the ground of the anticipations by *Kusenberg* and *Royle*. Looking at the Specification, nowhere does it point to the possibility of one tube, and, if one tube were possible, it would not be necessary to have two different metals. Under all circumstances it is assumed that the trap is to have one temperature, 30 and it only works and enables the valve to open and shut by having two different metals. That is the essence of the Patent. Fig. 6 does not work by having two metals of different coefficients of expansion. *Pneumatic Tyre Company, Ltd. v. Leicester Tyre Company, Ltd.* (14 R.P.C. 851, at page 869, line 25) lays down the limitations to be put upon a Patentee in his Provisional 35 Specification. The Patentee has in this case used words which exclude an area which might otherwise have been within more general phraseology. Fig. 3 does not work unless there are two different metals having different expansion coefficients. It ought to be compared with Fig. 6 as closely as possible. There is no modification of the Provisional Specification described or foreshadowed 40 in any shape or form which does not require of its essence that the metals shall be of different coefficients of expansion, and taking every figure which is shown in the Complete Specification down to that part of the letterpress which did appear in the Provisional Specification that is essential, and unless there is in these the essential features the traps will not work. With regard to Fig. 6, 45 it consists of an expanding tube which is restrained from expanding by reason of a stay rod, and that is *Kusenberg*, and nothing else. It depends not in the least upon the metals which are used, but on the difference of temperature in the tube which carries the steam and the stay rod which obstructs the motion. In both cases it is by distortion, and distortion in identically the same form and 50 identically the same way. If that is so, Fig. 6 is outside the Specification. It is not the same invention, and the Patent is bad.

Bousfield, K.C., replied.—The Respondents' argument is based on an artificial classification of these steam traps, and they endeavour to establish that Fig. 3 shall come within the particular definition of the classification, and Fig. 6 is 55 without it. [VAUGHAN WILLIAMS, L.J.—Is not that artificial classification essential to your case?] No. The function of the Provisional Specification is

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essentially not to limit a Patentee to a particular invention. He may work upon his invention.

A discussion then took place on the cross appeal of the Petitioners as to imposing terms in the event of a disclaimer, in which substantially the same arguments were used as in the Court below.

VAUGHAN WILLIAMS, *L.J.*—I think we all agree that the Judge has a discretion, not merely a limited discretion as suggested, in the matter. The Judge knows much more about the case than we do, and he has exercised that discretion, and I do not think we ought to review it.

Under those circumstances, I think the best way will be to abstain from making any observation upon the arguments which were put forward at the Bar, whether I agree with them or whether I do not. I think this appeal ought to be dismissed with costs.

STIRLING, *L.J.*—I agree.

COZENS-HARDY, *L.J.*—I agree. It is not for me to say whether I should have exercised the discretion in the same way that the learned Judge has, but having exercised it I cannot say that he has gone so wrong that we ought to review it.

Judgment on the main appeal was reserved and delivered on the 8th of February 1904.

STIRLING, *L.J.*—This is an appeal from an Order made by Mr. Justice Buckley on a Petition for the revocation of a Patent, by which it was ordered that the Patent should be revoked unless within three months, or such further time as the Court should allow, the Patentee obtained leave to amend the Specification by disclaiming Figs. 2 and 6 of the drawings attached thereto. The appeal extends only to so much of the Order as relates to Fig. 6, it being admitted that the decision as to Fig. 2 was well founded.

The ground on which the learned Judge held that Fig. 6 must be disclaimed was that in respect of it there is disconformity between the Provisional Specification and the Complete Specification. The Patent relates to improvements in steam traps, which are devices used for draining the condensed water from steam pipes, or other receptacles for steam. It is desirable that these traps should act automatically as the water falls, and for this purpose advantage is taken of the expansion and contraction of metals caused by variations of temperature in such a way that when water is formed there is opened a valve through which the water is discharged. Prior to the date of this Patent this had been effected in various ways. These different methods have been classified by the learned Judge under three heads, which are in substance as follows : First, free expansion which takes place where a tube is allowed freely to elongate under the heat of steam, and to contract freely when water forms, and the tube consequently cools, the tube, by its expansion or contraction, actuating a lever so arranged that at the moment when the water forms the valve is opened by the action of the lever. Secondly, controlled expansion, where a tie rod, or tie rods, is or are connected with the tubes so as to control their expansion and contraction in such a way as to produce a movement which is used to open the valve. Thirdly, differential expansion, which, in the language of the learned Judge, "consists in having two of the tubes with different coefficients of expansion, so that you get, as the temperature is higher or lower, a greater amount of expansion, or a greater amount of contraction in the case of one tube than in the case of the other," the variations in figure thence arising being applied to open or close a valve. The learned Judge has held, and I think rightly, that the invention described in the Provisional Specification falls within the third class. In that Specification the Patentee states as follows :—"The apparatus consists essentially of two tubes of metal, having as different a coefficient of expansion as practicable, one end of the tubes being the inlet admitting water and steam, the other being the outlet ; thus the water and steam is within and not outside of the tubes. These tubes are

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"firmly connected at both ends, one of the junctions being free to move, the other being fixed; there is a slight distance between the ends of the tubes at the fixed junction, but at the free junction they may be close together." The two tubes "form two sides of a triangle, the base into which they are fixed making the third and smallest side. According as the pipes are hot or cold the relative lengths thereof alter and cause movement at one of the angles. This movement takes place at what I have called the free end." In the Complete Specification the Patentee describes, by reference to Figs. 1, 3, and 4 of the drawings, a trap which is admitted to conform to the Provisional Specification. In those figures the letter *a* designates the tubes having the higher coefficient of expansion, preferably of brass or copper, while *b* designates those having the lower coefficient, preferably of iron. In this arrangement the steam and water passes through both tubes. The mode of working of the trap is explained in the Complete Specification by reference to Fig. 5 of the drawings. The Patentee says: "When tubes are cold, or comparatively cold, which will be the case so long as they contain water, they take up the position shown by the full lines; but whenever the water is discharged, and steam follows, then the tubes become hotter, and the side of the triangle expands most, the tubes assuming the position shown by the dotted lines, the base *c* being fixed. Consequently the lever *f* moves from the position shown in the full lines to that shown in the dotted lines, and so closes the valve or cock. When water again enters the tubes they cool, and side *a* contracts most, thus bringing the tubes back to the position shown in the full lines, and reopening the valve or cock," and so on. The particular mode of motion produced in this way was at the date of the Patent entirely a novel mode of opening and closing the valves. Nothing is found in the Provisional Specification which aptly describes the device represented by Fig. 6. In the Complete Specification the following description is given:—"There are other obvious ways of arranging this steam trap; for instance, instead of having only two tubes I may use three, or more, or instead of one of the tubes I may use a tie rod. Such an arrangement is shown in Fig. 6. In this case the length of the rod *b* remains constant, while according as the tube *a* is cold or hot the valve is open or closed. In this case the valve is moved, the spindle being adjusted by the screw *k* to a fixed position. Since the valve and outlet move in this arrangement I may use a flexible tube, or expansion piece or bellows in case it is necessary to conduct away the discharged water, or I may place the valve at the junction of the two tubes at the free end, so that the iron tube *b* carries off the water after passing the valve; the length of the tube *b* in this arrangement remains practically constant, and the opening and closing is done by the contraction and expansion of the tube *a*." The device so described forms the subject of a second claim, which is as follows:—"Secondly, the combination of two metal tubes having different expansion coefficients, or of one metal tube, and one tie rod having different expansion coefficients, and through which water and steam are discharged, one end of the said tubes, or tube and rod being fixed, and the other ends being connected together, and free to move with a lever, or link, or spindle, or other similar arrangement for opening and closing the outlet valve or cock, substantially as described." In dealing with this portion of the Patent the learned Judge, after pointing out that the language of the second claim is inaccurate, inasmuch as the water or steam is not discharged through the rod, but is discharged through the tube only, proceeds as follows:—"It is true that in the immediately antecedent words he says, 'having different expansion coefficients,' and if you read that literally I agree he has said, 'My tie rod is to have a different expansion coefficient to my metal tube.' But he has told you above that the length of the rod is to remain constant, which is equivalent to saying that it does not matter that the coefficient of expansion of my rod is different from that of my tube. I do not think in Fig. 6 he has relied on differential expansion at all. I think he has

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“relied on controlled expansion. That being so, it seems to me that there is
“disconformity between the Provisional Specification and the Complete Spec-
“fication. The Provisional Specification goes to differential expansion: this
“particular claim is a claim to controlled expansion.” With the greatest
5 respect for the learned Judge, I am unable to agree with this part of his judg-
ment. In particular I cannot agree that the Patentee by saying that the length
of a rod is to remain constant has done what is equivalent to saying that it does
not matter that the coefficient of expansion of the rod is different from that of
the tube. Neither according to the terms of the Provisional and Complete
10 Specifications, nor in actual working, is it essential to the success of the patented
invention that both the tubes referred to in the Specifications should expand.
What the Specifications do require is that the coefficients of expansion of the
two tubes should be different, a condition which is satisfied if the coefficient of
one be of considerable amount, and that of the other zero; that is to say, if the
15 second tube is inextensible, or incapable of expansion by heat. Whether the
second tube expands under heat only to a slight extent, or does not expand at
all, the motion relied on by the Patentee for opening and closing the valve will
be produced, and will be of the same nature as when the second tube is of iron,
as suggested in the Specifications. Such motion is attributable to “differential
20 “expansion,” though that is a term which does not occur in the Specifications
any more than “controlled expansion.” It appears to me that in reality those
terms, though they may be convenient for purposes of classification, are not in
strictness mutually exclusive. If, then, an apparatus in which one of the tubes is
inextensible falls, as I think it does, within the Provisional Specification, it
25 seems to me that an apparatus consisting of one tube in combination with a
tie rod cannot be excluded merely on the ground that the tie rod is inextensible,
for in both forms of apparatus differential expansion is made use of. In the
argument before this Court other grounds were urged in support of the decision.
It was contended that the Patentee in his Provisional Specification states that
30 his apparatus consists essentially of two tubes of metal, and that it was not
permissible for him to claim by his Complete Specification an apparatus con-
sisting of one tube and a tie rod. Now the function of the Provisional
Specification is to describe the nature of the invention, while the Complete
Specification must particularly describe and ascertain the nature of the
35 invention, and in what manner it is to be performed. In *Woodward v. Sansum*
(4 R.P.C. 166), Lord Justice Cotton, at page 175, says: “A Patentee putting in
“a Provisional Specification, showing the nature of his invention, is not bound
“to describe the way in which that can be carried into effect and operation, but
“if he does describe a way of doing it, and before he files his Complete Specifi-
40 “cation he either finds improvements in that way, or a different way of
“carrying into effect that which is described as his invention in the Provisional
“Specification, he is bound to give the public the benefit of what he has
“discovered as regards the mode of carrying the invention, the nature of which
“must be described in the Provisional Specification, into effect, even although
45 “there may be improvement, and even invention, which was not known to him
“at the time.” A Patentee therefore is at liberty to describe in his Complete
Specification a method of carrying his invention into effect different from that
given in the Provisional Specification, provided this new method is really within
the invention of which the nature is described in the Provisional Specification, and
50 the question whether this is so or not is one, not of construction of the Specifi-
cation, but of fact, as was decided in the same case of *Woodward v. Sansum*.
In the present case I think the invention was the application of differential
expansion, so as to produce a new mode of motion for the purpose of opening
and shutting a valve in steam tubes and other receptacles. In the apparatus
55 described in the Provisional Specification this mode of motion was produced by
the differential expansion of two tubes. In the Complete Specification it was
also obtained by the differential expansion of a tube and rod. Both methods

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are, in my opinion, within the invention, and the evidence shows that the second naturally arises out of the first: see the cross-examination of Mr. *Swinburne* at question 827. I apply to this case the language of Lord Justice *Lindley* in *Woodward v. Sansum* (4 R.P.C. 177) "It appears to me that if we
"were to hold that this Complete Specification was bad, as being more extensive 5
"than the Provisional Specification, we should find ourselves driven to go this
"length: that a man could not vary from his Provisional Specification at all,
"and that if he had done more than describe the nature of his invention in
"general terms, that is to say if he had condescended to describe anything
"particularly clearly and intelligibly, he would thereby tie himself down to 10
"what he had so described, and would find himself unable to introduce into
"his Complete Specification any variation, however obvious, or however much
"it might naturally grow out of, or be involved in, the nature of his real
"invention."

It was also pointed out that in the case of the tie rod it was admitted by Mr. 15
Swinburne, who gave evidence on behalf of the Patentee, that in Fig. 6 it was
practically immaterial that the coefficients of expansion in the tube and in the
rod should be different; and it was urged that it was of the essence of the
invention described in the Provisional Specification that the two coefficients
should be different. To this it was answered that, however this might be, the 20
Complete Specification was in entire conformity with the Provisional Specifi-
cation, because the claim made in respect of Fig. 6 is limited to the combination
of "one metal tube and one tie rod having different expansion coefficients,"
and I think the answer is sufficient. The Patentee certainly appears by his
Provisional and Complete Specifications to have confined his claims within 25
narrower limits than, so far as I can see, were absolutely necessary, and when
questions as to infringement arise he may find himself in a position of very
considerable difficulty. But on a Petition for revocation no question as to
infringement can arise. The only matters to be considered are those relating to
the validity of the Patent, and it is no ground of objection that the ambit of 30
the Specification is too narrow.

These objections being disposed of, it becomes necessary to deal with a point
which was argued in the Court below, as well as before us, but was not dealt
with by the learned Judge, who referred to it in the following passage:—
"Now, if I thought that controlled expansion was within his (that is the 35
"Patentee's) Specification, and that the principle he was availing himself of
"was that, and not that which it seems to me to be, there might be very great
"difficulty as to subject-matter, but I am not of that mind. It appears to me
"that he has not relied, in his Provisional Specification, on controlled expansion
"at all, and I do not think that he has relied on it in his Complete Specification. 40
"He has throughout relied on differential expansion. Fig. 6, as I say, is based,
"not on the principle of differential, but of controlled, expansion. It seems to
"me to be really in a modified form just what *Royle* and *Kusenberg* did."
For the reasons already stated I am unable to agree with the view that Fig. 6 is
not based upon the principle of differential expansion. It was contended, 45
however, that the invention described in Fig. 6 was bad for want of subject-
matter, on the ground that it was a mere modification of the inventions of
Kusenberg and *Royle*, to which the learned Judge refers. I am opinion that
this contention is not well founded, for this reason: that the motion of which
the Patentee avails himself to effect the opening and closing of the valve, is of 50
an entirely different kind from that employed by *Kusenberg* and *Royle*. The
Patentee, whether his apparatus consists of two tubes, or of one tube and a tie
rod, avails himself of the motion produced by differential expansion at a point
at or near the junction of the tubes, or the tube and the tie rod, as the case may
be, that junction being free to move while the other ends of the tubes or the 55
tube and tie rod remain fixed. *Kusenberg* and *Royle*, on the contrary, used
devices consisting of combinations of tubes and tie rods in which the junctions

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of the tubes and tie rods were kept fixed, while points situated in the tubes or the tie rods were caused to move in straight lines, and this is a mode of motion entirely different from that made use of by the Patentee.

5 The mechanical device employed by the Patentee in the present case was novel at the date of the Patent, and has been held by Mr. Justice *Buckley* to offer advantages not afforded by the devices of *Kusenberg* and *Royle*. That decision, so far as regards Fig. 3, has not been appealed from, and with it I agree. In my view Fig. 6 is a modification and natural development of Fig. 3, and in Fig. 6 the same novel mode of motion is made use of, and the same
10 advantages are gained as in Fig. 3. I think, therefore, that this objection fails, and the conclusion is that the appeal ought to be allowed.

VAUGHAN WILLIAMS, *L.J.*—The judgment delivered by Lord Justice STIRLING is the judgment of the Court.

Walter.—The appeal will be allowed with costs? I do not know what the
15 Order will be with regard to the costs in the Court below, in so far as they were increased by this part of the case. At present the Order of Mr. Justice *Buckley* is that we pay the costs in the Court below. Of course a considerable amount of time was occupied by this question of disconformity. The general costs of the action we must pay, because we were wrong on one of the figures,
20 but the Order I should ask your Lordships for is that the appeal be allowed with costs, and a direction that we should have the costs in the Court below, so far as they were increased by this part of the case. I cannot ask for more than that. The costs have been taxed and paid in the Court below.

VAUGHAN WILLIAMS, *L.J.*—It would be much better for both sides, in this
25 state of things, where the costs have been taxed and paid, to avoid if possible any further expenditure in ascertaining how much of the costs below were attributable to this part of the case.

Walter.—If your Lordships could do that, my clients are quite ready to leave it to you to say what proportion.

30 *Terrell*, K.C.—We are entitled to the general costs of the Petition. The general costs of the Petition are themselves two-thirds or thereabouts of the whole of the costs. Then we are entitled to the general costs of the issue upon which we have succeeded, if your Lordships are fixing that.

Walter.—The amount of the bill of costs was 660*l*.

35 VAUGHAN WILLIAMS, *L.J.*—If you will let us have the bill itself we will look at it. It will be amply sufficient to enable us to judge what the proportion should be, and we will do so as soon as we have seen the bill.

On the following day the case was mentioned again.

40 VAUGHAN WILLIAMS, *L.J.*—The Respondents must return, in our opinion, 125*l*. of the total sum of 660*l*.

Terrell, K.C.—Would it not be convenient to do this? My clients will have to pay the costs of the appeal, so if they add 125*l*. to their costs of the appeal I think that will meet it.

VAUGHAN WILLIAMS, *L.J.*—Yes, that will produce the same result.

Poulton and Son v. Kelley and Son.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE SWINFEN-EADY.

March 4th, 1904.

POULTON AND SON v. KELLEY AND SON.

*Action for Infringement of Patent and for Passing-off.—Motion for 5
Interlocutory Injunction.—Injunction granted.*

On the 20th of February 1904, *William Poulton* (trading as *Poulton and Son*) commenced an action against *Kelley and Son*, claiming an injunction to restrain the Defendants :—“(1) From passing-off or enabling or assisting others
 “to pass-off, or from endeavouring or attempting to pass off, seating blocks and 10
 “flue covers manufactured by the Defendants or by any person other than
 “the Plaintiff, as ‘Special Seating Blocks and Flue Covers of Messrs. *Poulton*
 “‘*and Co.*’s pattern,’ or as or for the Plaintiff’s manufacture, or from
 “passing-off, or attempting, or enabling, or assisting others to pass off the
 “Defendants’ goods or goods manufactured for them as and for the Plaintiff’s 15
 “goods ; (2) from selling or contracting to sell, or offering for sale, or
 “procuring to be sold under the name or description of ‘*Poulton’s Patent*
 “‘*Curvilinear Seating Blocks and Flue Covers,*’ or any name describing
 “goods manufactured by the Plaintiff, as seating blocks, flue covers, or goods
 “other than and except those manufactured by the Plaintiff ; (3) from the 20
 “infringement of the Plaintiff’s Letters Patent dated 23rd February 1893,
 “No. 3987.”

The Plaintiff moved for interlocutory injunctions in the terms above set out.

It appeared from the affidavits filed on the Motion, that the Corporation of 25
 the City of Coventry, in May 1903, invited tenders for extensions of their
 electric lighting works, and that the Defendant, who was a builder and
 contractor trading as *Kelley and Son*, tendered for and obtained the contract,
 which was signed on the 1st of August, 1903. The Specification stated “Special
 “Seating Blocks and Flue Covers of *Poulton and Co.*’s Pattern are to be used.” 30
 The Defendant, who alleged that he was unaware when he read the Bill of
 Quantities, and did not gather from the Specification that the Plaintiff had a
 Patent, had some correspondence with him, and inferred therefrom, as he
 alleged, that the Plaintiff did not make and was not willing to make flue covers
 of the pattern specified by the City Engineer, and that he did not make seating 35
 blocks of the exact dimensions specified. The Defendant obtained the goods
 from another manufacturer, but denied that he had passed off or attempted to
 pass off other goods as those of the Plaintiff’s, and denied that he had ever
 suggested that the goods supplied were of the Plaintiff’s manufacture. The
 further facts sufficiently appear from the Judgment. 40

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Eve, K.C., and *E. Clayton* (instructed by *J. Bartlett*) appeared for the Plaintiff; *D. M. Kerly* (instructed by *Crowders, Vizard, and Oldham*, agents for *Brownells*, Coventry) appeared for the Defendant.

SWINFEN-EADY, *J.*—In my judgment, the Plaintiffs are clearly entitled to
5 the injunctions which they seek both as regards the infringement of the Patent, and as regards passing off. Although Mr. *Kerly* has pressed upon me that this is a small case, I do not at all look upon it as an unimportant case, and I am satisfied that it is not an accidental infringement. It appears that in the Specification of the work which the Corporation required, it was said that
10 the fire brick blocks and flue covers were to be obtained from “an approved “manufacturer,” and with regard to the special seating blocks and flue covers, they were to be of Messrs. *Poulton's* pattern; and it appears from the evidence that the Defendant, who obtained the contract, was told where to obtain them. He was given Messrs. *Poulton and Son's* address, and he communicated with
15 them. His first letter was on the 27th of August, his tender having been accepted on the 1st of August. There was further correspondence in October, and on the 12th of November is the Plaintiffs' last letter. The note-paper upon which the Plaintiffs write (I have here the original letters) contains numerous diagrams in colours, showing the shape and configuration of the fire blocks that they use, and their seating blocks and the manner of applying the seating blocks; and
20 the letter paper also contains the statement that they are “Patentees of the “Improved Curvilinear Boiler Seating Blocks and Flue Covers.” That appears prominently on their note-paper. So that the Defendant knew of their Patent; he knew of the shape of their blocks; he knew where to obtain them, and he knew that Messrs. *Poulton* were manufacturers of them; and, apparently because he thought he could get them a trifle cheaper, he chose to pass by the Patentees, the manufacturers; he addressed no further communication to them; and the next thing that they hear of it apparently is that he had got them made by some other manufacturer, the name of whom up to this moment he has not
30 disclosed, and whose name, according to the evidence, he refused to disclose at the time, although now, at the close of the case, his Counsel offers to disclose the name of the manufacturer. Then the next the Plaintiffs heard of it was that they received a letter from the manager of the Electricity Works of the Corporation. He wrote to the Plaintiffs on the assumption that they were supplying these seating blocks. He said to them, “You are supplying some “blocks here for the boilers, and it seems to me the blocks are not the right “design,” and he complained. Upon that the Plaintiffs were put upon enquiry as to what had taken place. Then, owing to the illness of the manager, that was not followed up rapidly, and then there was another complaint. The next complaint
40 came from the *National Boiler and General Insurance Company*. They, on the 1st of February, wrote directly to Messrs. *Poulton* on the assumption that they were doing the work. That led to the discovery, and then the Defendant complains that he has been sued without notice, and alleges that he is an innocent infringer, and that it is a small matter. Having regard to the
45 correspondence, and to the attitude which the Defendant has since taken up, I feel myself quite unable to take the view which his Counsel has submitted to me. It appears to me to be a deliberate infringement.

Then he urged that, even if the Patent was infringed, there was no case of passing off; but the inference which I draw from the evidence before me is
50 that there was no other manufacturer of the *Poulton* blocks than Messrs. *Poulton and Son* themselves, and that merely supplying blocks of the *Poulton* pattern is a representation that they were made by Messrs. *Poulton*. There was no other manufacturer; certainly the Boiler Insurance people thought so; and certainly the manager of the Electricity Works thought so. The contract
55 requires them to be the blocks of an approved manufacturer, and no other manufacturer's name was ever submitted. First of all, Mr. *Swindlehurst* was not informed until afterwards that the seating blocks had not been manufactured or

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supplied by Messrs. *Poulton*; and Mr. *Tomlinson*, his assistant, said that he was not aware until after the seating blocks had been delivered on the site that they were not being obtained from Messrs. *Poulton's*. I think the whole course of the Defendant's conduct has been to represent that these are seating blocks manufactured by Messrs. *Poulton*, and according to Messrs. *Poulton's* Patent. 5

Under these circumstances, I am of opinion that an Injunction ought to be granted until trial or further Order. I do not now treat this as the trial. It may be that out of Court the Plaintiffs may consent to do so on being supplied by the Defendant with the particulars of the name and address of the manufacturer who delivered the goods complained of in this action. If the Defendant should 10 supply that, the parties are at liberty to take steps to treat this as the trial and a perpetual Injunction will be drawn up; but unless they agree out of Court, the only Order I make now is to grant an Injunction until further Order in the terms of the Notice of Motion. Of course, if this Motion is treated as the trial, 15 the Defendant must pay the costs of the action.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE KEKEWICH.

March 29th, 1904.

RICKETT, COCKERELL & CO., LD. v. NEVILL.

Action to restrain passing-off.—Use by widow in carrying on her late 20 husband's business of the name of her late husband's former employer.—Motion for interim injunction.—Injunction refused.

N. was for several years in the employ of C. & Co., as assistant in and manager of their coal business. Leaving their employ, he set up business on his own account as a coal merchant, under the style of "N. from C. & Co.," 25 which he habitually used in advertisements, letter-paper and coal waggons. Upon his death, within a year, his widow continued the business under the same style. C. & Co. commenced an action for an injunction to restrain her from so doing, but were refused such injunction, and the action was dismissed with costs.

Rickett, Cockerell, & Co., Ltd. v. Nevill.

The Plaintiffs, *Rickett, Cockerell and Co., Ltd.*, were coal merchants, being a Company formed in 1899, for the purpose of amalgamating the business of *Rickett, Smith and Co.*, and the retail portion of the business of *William Cory and Son, Ltd.*, which had been carried on under the style of

5 *G. J. Cockerell and Co.*

The Defendant, *Margaret Louisa Nevill*, was the widow and sole executrix and universal legatee of *Sydney Nevill*, who at the time of his death on the 24th February 1904, was carrying on business as a coal merchant under the style of "Sydney Nevill, from *G. J. Cockerell & Co., Ltd.*"

10 *Sydney Nevill* was for several years in the employ of *G. J. Cockerell and Co., Ltd.*, as assistant to the manager, and after the business of that firm was acquired by *William Cory and Son, Ltd.*, he was employed as assistant manager. In March 1903, he left the employment of the Plaintiff Company into which he had entered when they took over the business, and set up

15 business on his own account as a coal merchant in the Strand. He used the style of "Sydney Nevill, from *G. J. Cockerell & Co., Ltd.*," habitually in advertisements in the daily papers, upon his bill heads, letter-paper and circulars, and on his waggons and carts. After his death, the Defendant carried on the business in the same style, and the Plaintiffs brought an action for

20 an injunction to restrain her and her servants and agents, "from printing, or affixing, or causing, or permitting the name, *G. J. Cockerell and Co., Ltd.*, or any name of which the name '*Cockerell*,' forms part to be, or remain printed, or affixed on any billheads, letter-paper, circulars or advertisements, vans,

25 waggons or carts, used for the purpose of, or in connection with the business of a coal merchant carried on by the Defendant, and from otherwise using or causing or permitting the names, '*G. J. Cockerell and Co., Ltd.*,' or '*Cockerell*,' to be used in such a manner as to lead the public or purchasers, to believe that the Defendant's business is in any way connected with the

30 business that was formerly carried on by *G. J. Cockerell and Co., Ltd.*, and is now carried on by the Plaintiffs, or that the Plaintiffs are the successors of *G. J. Cockerell and Co., Ltd.*, are in any way interested in the Defendant's said business."

On the 29th March 1904, a motion by the Plaintiffs for an interim injunction came on before Mr. Justice KEKEWICH.

35 *Warrington, K.C.*, and *Austen Cartmell* (instructed by *Deacon, Gibson, Medcalf and Marriott*) appeared for the Plaintiffs.

P. O. Lawrence, K.C., and *R. J. Parker* (instructed by *Sewell, Edwards and Nevill*) appeared for the Defendant.

Warrington, K.C. for the Plaintiffs.—The Defendant does not say that she is

40 "Cockerell & Co." but she holds out that she has been connected with them, which is not the fact. She is not an old servant of that firm but a stranger, and what she is doing is as much calculated to mislead customers as what was done by the Defendants who were restrained in *Glenny v. Smith* (2 Dr. & Sm. 476), and in *Hookham v. Pottage* (L.R. 8 Ch. App. 91). The Plaintiffs are

45 entitled to an injunction.

P. O. Lawrence, K.C. for the Defendant.—The Defendant is entitled to avail herself of the goodwill of her late husband's business, including the style under which he traded for nearly a year. The Plaintiffs have failed to prove that they have been damnified or that the style held out by the

50 Defendant amounts to a trade libel, and are therefore not entitled to relief *Clark v. Freeman* (11 Beav. 112). The cases relied on by the Plaintiffs were cases of dishonesty.

KEKEWICH, J.—When a defendant has innocently done something wrong and comes into Court and supports the right to do what is wrong, that may by

55 itself establish a case of fraud and dishonesty. For instance, if any one takes a trade name ignorantly, as has often been done, and then when he is challenged, insists upon continuing to use it, by insisting he turns that which was innocent

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into a wrongful act. In that sense, if this lady is wrong at all, and if she has been doing what is wrongful, it is a continuing wrongful act to resist the injunction; but in no other sense can it be possibly said that there is the slightest dishonesty in this case. It is not denied that her husband, whom she represents, was entitled to use his own name with the affix "From Cockerell & Co."—using the name of his employers, not in a prominent manner, but merely as indicating that *Sydney Nevill* looked for custom in this particular trade and looked for it with more confidence because he had been formerly in the employ of a well-known firm. It is not denied that he did that, and he did it with perfect propriety for something like nine months. Then he died and left his widow in possession of his effects, including his trade, and she continues to use his name. She, of course, was not "From Cockerell & Co."; but he who established the business was. She has not altered the billheads and she has not altered the letters on her vans.

I think there are other points on which the case might be decided, but no one has suggested that a widow succeeding to and carrying on a business in the way in which her husband was entitled to carry it on has ever been restrained, or has ever been found fault with for doing that which he could not be found fault with for doing. I am not prepared to take that further step which, so far as I am aware, no Court has ever yet taken, or has ever been asked to take; and, without going further into the case I decide it on that ground and refuse the Motion.

Warrington, K.C.—I am willing to treat the Motion as the trial and to have the action dismissed with costs.

KEKEWICH, J.—Very well.

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IN THE COURT OF APPEAL—IRELAND.

Before LORDS JUSTICES FITZGIBBON, WALKER, AND HOLMES.

January 25th and 26th, 1904.

THWAITES & CO. v. M'EVILLY.

5 CANTRELL AND COCHRANE v. MURPHY AND BRADSHAW.

Trade Mark.—Selling mineral waters not of Plaintiffs' manufacture, in bottles embossed with Plaintiffs' name, registered as a Trade Mark, but bearing labels with Defendants' name and address as manufacturers.—No actual fraud or deception proved or alleged.—Meaning of "innocently" in Section 2, sub-
 10 section 2, of Merchandise Marks Act, 1887.—Injunction granted.—Appeal dismissed.

The Plaintiffs were manufacturers of mineral and aerated waters in Dublin, which they sold to the trade in bottles embossed with their names, registered as Trade Marks. The Defendants, who were manufacturers in Limerick, had become
 15 possessed of a number of the Plaintiffs' bottles so embossed, which they refilled with waters of their own manufacture, and sold to retailers, but with labels affixed bearing their own name and address as manufacturers. It was not proved or alleged that fraud was intended, or that any person had been actually misled. The Defendants gave evidence that the public were guided, not by the name
 20 embossed on the bottle, but by the label; but the Plaintiffs contended that the label was liable to fall off, or might be removed by a fraudulent retailer, who could then sell the contents as of Plaintiffs' manufacture. No evidence was given that this had in fact been done; but the Plaintiffs had served notices on the Defendants cautioning them against using bottles so embossed, notwithstanding
 25 which they persisted in using them, and claimed a right to do so. An injunction was granted by the Master of the Rolls with costs. The Defendants appealed.

Held, by the Court of Appeal, that the Defendants, by putting mineral water of their own manufacture into bottles bearing the Plaintiffs' Trade Marks,

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committed an offence against the Merchandise Marks Act; that "innocently," in Section 2, sub-section 2, (c) of that Act means innocence of intention to infringe the Act, and that placing labels bearing their own names on the bottles did not exonerate the Defendants. Appeal dismissed, and the decision of Master of Rolls affirmed, with costs.

5

Allen v. Richards (26 S.J. 658), approved.

These were appeals from a judgment of the *Master of the Rolls* in Ireland granting injunctions in two test actions, brought to try the question whether the Plaintiffs, who were manufacturers of mineral and aerated waters in Dublin, which they sold to retailers in bottles embossed with their names, registered as Trade Marks, were entitled to injunctions restraining the Defendants, who were manufacturers in Limerick, from re-filling such bottles with waters of their own manufacture, though with labels affixed bearing their own name and address as manufacturers. It was not proved or alleged that there had been any actual fraud or passing-off. The Defendants alleged that the Plaintiffs had parted with the property in the bottles, that they had received them from retailers in the ordinary course of trade in exchange for bottles of their own, and that by affixing labels bearing their own name and address all chance of fraud or passing-off, or mistake by the public, was prevented and rendered impossible, as the labels on the bottles were the only indication of the contents. Witnesses gave evidence that the public were guided, not by the embossment on the bottles, but by the labels. It was pointed out, however, for the Plaintiffs, that the labels were liable to come off, or might be removed by a fraudulent retailer, who could then pass off the contents as of the Plaintiffs' manufacture; and they relied upon the fact that they had served notices on the Defendants cautioning them against using their embossed bottles, and that if they continued doing so proceedings would be taken against them. The Defendants submitted that they were within their right in using the bottles in the manner stated, and they relied upon Section 2, sub-section 2 (c) of the Merchandise Marks Act, 1887, which they contended exonerated them, as having acted innocently. The *Master of the Rolls* granted injunctions, holding that the sale of goods of Defendants' manufacture in bottles bearing the Plaintiffs' Trade Mark was, in itself, an infringement of that Statute; that each bottle when sold, bore two trade descriptions, one true, and the other not true; and that where a man knew that another was the owner of a Trade Mark, and he intentionally used it by applying it to his own goods, from motives of personal convenience or profit, he could not under the Statute claim immunity on the ground of innocence (20 R.P.C. 663).

The Defendants appealed. The Pleadings and the facts of the cases are more fully stated in the Report of the trial before the *Master of the Rolls*. *Ignatius O'Brien*, K.C., and *Doyle* (instructed by *James Doyle*) appeared for the Appellants; *O'Shaughnessy*, K.C., *Blood*, K.C., and *Day* (instructed by *Gerald Byrne*) appeared for the Respondents.

O'Brien, K.C., and *Doyle*, for the Appellants.—What the Act was intended to prevent was the affixing of a false trade name, trade mark, or trade description to goods for the purpose of passing them off as the manufacture of another. In the present case no such intention is alleged or proved, and in fact it would be impossible; for until the label, which bore the true name of the manufacturer and a description of the kind of mineral water in the bottle was affixed, it would have been impossible to sell the goods, as the label was the only indication of what the contents of the bottle were. The gist of the offence is the application of a false trade mark or trade description, with

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the intention of selling the goods of one person as the manufacture of another. Here there was no intention to sell, nor would it be possible to sell, until the label, bearing the true name of the manufacturer and the description of the contents, was affixed to the bottle. What the Court has to look to is the joint
 5 effect of the embossment and the label, and, putting the two together, whether they were calculated to lead persons to the conclusion that the contents were manufactured by the Plaintiffs, *per Palles*, Lord Chief Baron, in *Findlater v. Quirke* (3 New Irish Jurist 165). In *R. v. M'Evilly* (2 New I.J. 116) relied on by the Plaintiffs in the argument before the *Master of the*
 10 *Rolls*, it was admitted that a false trade description had been used. That case, therefore, is no authority on the present question.

O'Shaughnessy, K.C., and *Blood, K.C.*, for the Respondents.—Proof of actual fraud, or intention to pass off, is of course, not necessary; nor even is it necessary to show that the use of the bottle bearing the embossed Trade Mark
 15 was calculated to deceive or mislead. The sale of mineral water of the Defendants' manufacture in bottles bearing the Plaintiffs' Trade Mark, is in itself an offence against the Act; and the use of the label is no excuse. *Findlater v. Quirke* has no bearing on the present case. That was a case of false trade description. This is the case of a registered Trade Mark.
 20 In *Allen v. Richards*, (26 S.J. 658), a case similar in its facts to the present, *North, J.*, granted an injunction, holding that if the defendant chose to buy second-hand bottles bearing a trade name, and filled them with the same liquid as the owner of the name was in the habit of filling them with, he was not in a position to resist an injunction; and that the affixing of the
 25 defendant's own label did not affect the question. The present is a stronger case, for it is that of falsely applying a registered Trade Mark.

The following, among other cases, were also referred to: *Powell v. Birmingham Vinegar Brewery Company*, (13 R.P.C. 235; 14 R.P.C. 720; L.R. (1896) 2 Ch. 54; L.R. (1897) App. Cas. 710); *Singer v. Loog* (L.R. 8 App. Cas. 15).
 30 *FITZGIBBON, L.J.*—It is difficult to keep the portions of the Merchandise Marks Act, 1887, which deal with Trade Marks separate from those which deal with "trade descriptions"; and the difficulty is increased by the citation of cases dealing with false trade descriptions, which have no application to the present case, in which the cause of action is the illegal use of a registered
 35 Trade Mark. In my opinion, the objects of the legislation, as regards Trade Marks, are two: First, the protection of persons who have the exclusive right to use Trade Marks, and who have a monopoly of them; and secondly, the protection of the public against being deceived into purchasing goods made by people other than the proprietors of the Trade Marks on the
 40 faith of which the goods are bought. These objects are distinct, and we have to determine, upon the words of the Act, what the protection is which the legislature has deemed it necessary to give, for the purpose of securing each of them. Having ascertained what the legislature has defined to be an illegal use of a Trade Mark, the Court is not at liberty to cut the protection down to cases
 45 in which fraud, or "passing off" has been proved or intended, or in which acts have been done which were calculated to deceive, further or otherwise than by coming within the prohibitive words of the Statute. There may be cases where, in ninety-nine out of a hundred instances, no mischief would result, yet in the hundredth case it might occur, even unintentionally; and all that the
 50 Court has to do is to ascertain whether, in order to give the desired protection, the legislature has declared that the thing done shall be an offence against the Act.

In the present case, we must ascertain first, whether the Defendant has done an act which, *prima facie*, comes within the definition of an offence against
 55 the Act; and secondly, if so, whether he has proved anything sufficient to

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bring him within the statutory exemption. Leaving out immaterial and alternative words, but adding or altering nothing, and omitting nothing material, the Act, Section 2, defines the alleged offence as follows:—

"(2) Every person who sells, or has in his possession for any purpose of trade, any goods to which any Trade Mark is falsely applied, shall be guilty of an offence against this Act." 5

This definition says nothing about *mens rea* or intent; nothing about deceit or fraud. The condition of exemption is as follows:—"Unless he proves (a) that having taken all reasonable precautions against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the Trade Mark; and (b) that on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods; or (c) that otherwise he had acted innocently." 10

Beyond question, what the Defendant did in the present case came within the definition of the offence, and was *prima facie* an infringement of the Act. That he sold mineral waters made by himself, to which the Trade Mark, in some cases of *Thwaites*, and in other cases of *Cantrell and Cochran*, was falsely (*i.e.*, contrary to the fact) applied, was proved and admitted. In fact the Defendant contended that he was entitled to have in his possession, and to use for the purpose of trading in mineral water made by himself, bottles to which the Trade Marks of other makers were applied. His defence was that he could not carry on his trade profitably unless he did this. 15 20

Again omitting what is for present purposes immaterial, Section 5 says:—
 "(1) A person shall be deemed to apply a Trade Mark to goods who places any goods which are sold or had in possession for any purpose of trade, in any covering to which a Trade Mark has been applied. (2) The expression 'covering' includes any bottle. A Trade Mark shall be deemed to be applied whether it is impressed or otherwise affixed to the goods, or to any covering. (3) A person shall be deemed to falsely apply to goods a Trade Mark, who, without the assent of the proprietor of a Trade Mark, applies such Trade Mark, but the burden of proving the assent of the proprietor shall lie on the Defendant." 25 30

The Defendant here cannot escape from these express and definite enactments unless he proves (a) and (b), or (c), under Section 2 (2). In my opinion the observation of *Palles*, C.B., in *Findlater v. Quirke* (3 New Irish Jurist, 165), that what the Court had to look to was the joint effect of the embossment and the label—even if it be law as to a trade description—is not applicable to the present case. The marks embossed on the bottles which the Defendant used were the registered Trade Marks of proprietors who did not assent to their being affixed to the goods of the Defendant. This is not a case in which a mark so nearly resembling a Trade Mark as to be calculated to deceive has been used or applied; the actual Trade Mark of one maker has been applied to bottles containing the goods of another. It is not a case of "trade description," true or false. Had it been so, the question might have arisen whether the combined effect of the two things—the embossed Trade Mark and the paper label—was or was not an indication, direct or indirect, as to the place in which the goods were made, or as to the mode of manufacturing them. But there are no qualifying words in the provisions against applying a Trade Mark. An argument was founded on the fact that the provisions of Sec. 3 relating to "false trade description" are extended to cases where such a description "is a Trade Mark or part or a Trade Mark"; and to cases of the application to goods of any "figures, words, or marks, or arrangement or combination thereof, whether including a Trade Mark or not." In these provisions, deceit, or the risk of misleading, may be material, but they relate to 35 40 45 50 55

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cases of false trade description, and not to the false application of a Trade Mark. In my opinion where a registered Trade Mark is "falsely applied," deceit and the risk of misleading are assumed, or become immaterial, and the offence is *prima facie* completed; and the condition or burden is thrown
 5 on the Defendant of proving that he comes within (a) and (b), or (c), of Section 2 (2). These defined exemptions cannot help the Defendant here. Clauses (a) and (b) have no application to the facts; "reasonable precautions," "the genuineness of the Trade Mark," "the information in his power," have
 10 nothing to do with the present case. There remains only the alternative (c), viz., "that otherwise he had acted innocently." This cannot mean that, having knowingly and wilfully applied the Trade Mark of another manufacturer to his own goods, the Defendant can exonerate himself by adding to the Trade Mark a label bearing his own name, and saying that he has no intention to deceive. In my opinion, the words "otherwise acted innocently" apply to cases similar to
 15 those described in (a) and (b), where a defendant can prove that he was innocent of any intention to infringe the Act: for instance, that he was unaware that the mark applied to the goods was the Trade Mark of another manufacturer, or that the act was done by some other person for whom he was not responsible; but they cannot apply to a case like the present, where the
 20 Defendant admittedly knew that the embossments on the bottles were registered Trade Marks, which he wilfully applied to goods not manufactured by the proprietors of those marks.

It has been urged that an injunction would cause great inconvenience to the Defendant's trade. But no inconvenience could have arisen, if the Defendant
 25 had insisted that his customers should return him his own bottles, or if he had refused to accept—or to give credit for—bottles bearing the Trade Marks of other manufacturers. Allowing customers to mix the bottles, or the practice of some manufacturers of accepting bottles indiscriminately, cannot excuse infringing the Act by filling bottles bearing the Plaintiffs Trade Marks with goods not
 30 manufactured by them.

It was said that the Plaintiffs had parted with the property in the bottles by selling them to customers from whom the Defendant had acquired the property in them. But the object of the Act—namely, to stop a practice which the legislature considered to be injurious, that of applying the Trade Mark of one
 35 manufacturer to the goods of another, in the course of trade—has nothing to do with the ownership of the thing which falsely bears the mark. Fraud, or intention to deceive, is not a necessary ingredient in the offence of applying a Trade Mark contrary to the fact, which is what the Act means by "falsely" applying it. That has been done by the Defendant; and it is no answer or
 40 defence that he did not intend to deceive, or that he put on the goods—besides the Trade Mark—a label bearing his own name. The decision of *North, J.*, in *Allen v. Richards* (26 S.J. 658), is an authority in favour of our decision, which is that the appeal must be dismissed, and the Order of the *Master of the Rolls* affirmed with costs.

45 WALKER, *L.J.*—I concur. There are only two questions in the case: First, has the Defendant violated the Act of Parliament? Secondly, if so, has he brought himself within either of the exempting clauses by putting the label on the bottles? This is the case of a registered Trade Mark, which stands upon a higher plane than that of a trade description, and is governed by
 50 different considerations. Under the Act of 1887, an offence is committed by affixing a Trade Mark to any goods to which it does not belong, unless the defendant proves that he "acted innocently." How could the Defendant prove that he acted innocently when he admitted that he knew that the mark on the bottles was the Trade Mark of another person, that he filled them
 55 with goods of his own manufacture, that he did so for the purposes of sale, and

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had actually sold them, that he was aware of the Act of Parliament, that he knew that the Act declared that that should not be done, but put his own construction on it, and contended he was entitled to do it, because he put on the bottles labels bearing his own name? The Act of Parliament distinctly declares that that should not be done; and I cannot conceive how the Defendant could say that he had acted innocently. By Section 5, "A person shall 5
"be deemed to apply a Trade Mark to goods who applies it to the goods themselves, or to any covering, label, reel, or other thing in or with which the goods
"are sold or exposed, or had in possession for any purpose of sale, trade, or
"manufacture"; and "the expression 'covering' includes any stopper, cask, 10
"bottle, vessel, box, cover, capsule, frame, or wrapper." Reading those definitions into the second section, the Defendant has plainly been guilty of an offence against the Act, and he could not show that he had acted innocently, because he knew that he had done so. The decision of the *Master of the Rolls* must be affirmed. 15

HOLMES, *L.J.*.—I concur. The case, in my opinion, does not admit of question. The Defendant had in his possession for the purposes of sale, and had actually sold, bottles containing mineral water of his own manufacture, to which the Trade Marks of other manufacturers had been falsely applied, and it is admitted that he was aware of the existence of those Trade Marks on the bottles. Under 20 those circumstances the Plaintiffs were clearly entitled to an injunction, unless the Defendant was able to show that he was exempted by the Statute. What the Defendant suggested, as entitling him to exemption, was that he had put on the bottles labels bearing his own name as the manufacturer, and that this showed that he had no intention to deceive, and he was entitled to exemption as 25 having acted innocently. What is the meaning of having "acted innocently?" Is the Court to hold that it means the absence of intention to deceive? I think not. "Innocently," in my opinion, means that the Defendant was innocent of any intention to infringe the Act. He did not act innocently if he knew, as he did know, that he had applied to goods of his own manufacture the Trade Mark 30 of another, and if he endeavoured to avoid the consequences by attaching a label bearing his own name.

The appeal was dismissed with costs.

Ackroyd and Best, Ltd. v. Thomas and Williams.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE JOYCE.

March 11th, 14th, 15th, and 19th, and May 10th, 1904.

ACKROYD AND BEST, LD. v. THOMAS AND WILLIAMS.

- 5 *Patent.—Action for Infringement—Construction of Specification—Infringement denied.—Judgment for Defendants.—Solicitors' undertaking to refund costs.*

The owners of a Patent for improvements in miners' safety lamps, having brought an action for infringement, the Defendants denied infringement, and
 10 alleged the invalidity of the Patent, but at the trial relied principally on the contention that the Patent was for a particular combination, which they had not taken. The first claim of the Specification was as follows :—"In a miner's
 "safety lamp, the employment of a spring catch for locking the bonnet, the said
 "spring catch being brought into an acting position on the closing of the lamp,
 15 "substantially as set forth." The Plaintiffs alleged that the feature of the invention was an arrangement by which, when the bonnet was screwed on, it locked automatically, and could not be removed until the main lock of the lamp was undone, and that the Defendants had in substance taken the combination.

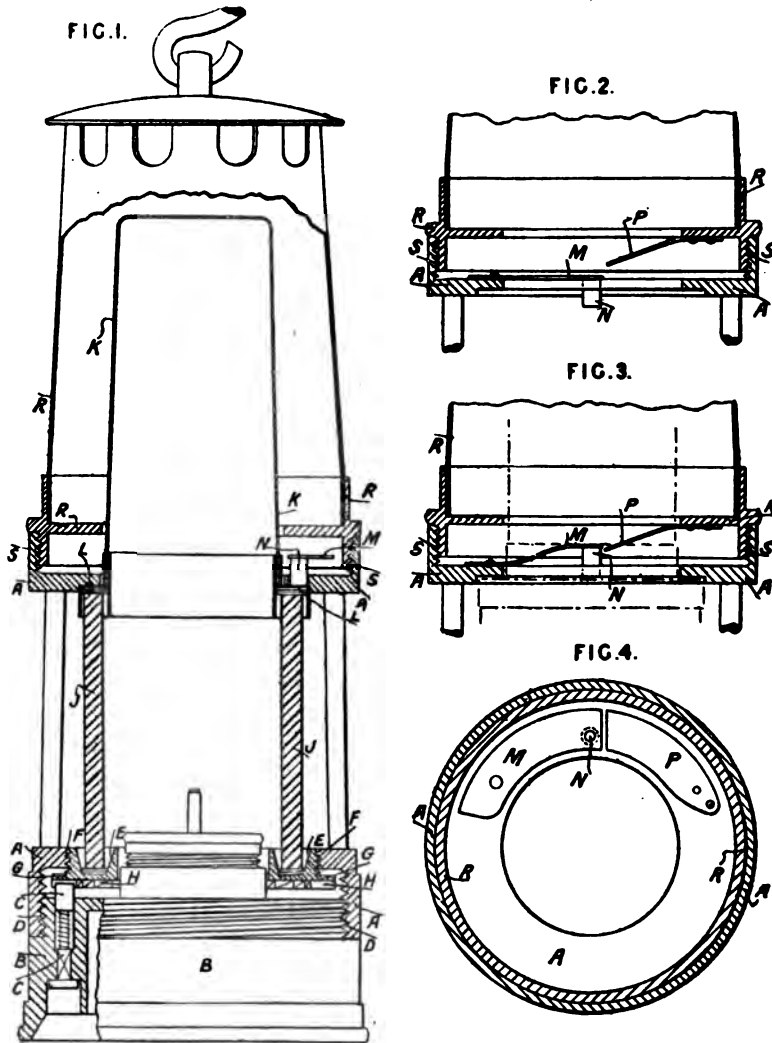
Held, that the Patent did not involve any new principle, but was for the
 20 particular combination, and that the Defendants had not taken the patented spring catch or the substance of the invention. The action was dismissed with costs.

On the 12th of March 1898, Letters Patent (No. 6128 of 1898) were granted to William Ackroyd and William Best for an invention of "Improvements in or
 25 "connected with Miners' Safety Lamps."

The Complete Specification was as follows :—"It is the custom for all miners' lamps to be delivered into the lamp room for cleaning purposes after they have been employed in the mine, but when the lamp is again returned to the miner ready lighted and locked, he has no guarantee that the lamp has been
 30 "properly attended to. If the lamp cleaner is negligent in his duty, he may simply remove the lamp bottom and clean the interior of the lamp without taking out the gauze, or the lamp may be closed after cleaning without having a gauze in at all. Faults of this description cannot be detected by the miner, and this negligence has often been the cause of disastrous explosions.
 35 "Now the object of this invention is to prevent explosions being caused in mines through the negligence of the lamp cleaner or other person cleaning

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“the lamps, or through any attempt on the part of the miner to loosen the
 “glass, and with this object we construct our lamp as shown in the accompany-
 “ing drawing where Figure 1 is a sectional elevation of the same, and Figures
 “2, 3, 4 and 5 are detail views.



“The general structure of the lower part of the lamp is as follows :—A is the 5
 “lamp frame, and B is the lamp bottom or oil container which is provided
 “with a spring bolt C only capable of being withdrawn by means of a powerful
 “magnet. The lamp bottom B screws into the lamp frame A by means of a
 “right hand screw thread D. E is a ring for receiving the base of the glass J.
 “This ring E screws into the lamp frame by means of a left hand thread F, and 10
 “the base of the ring E is provided with a flange on the under side of which
 “are situated rack teeth H (see inverted plan view Figure 5) for engaging with
 “the locking bolt C.

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- "The particular arrangement of the upper part of the lamp, characterizing the invention, and whereby the screw off outer cover or 'bonnet' R may be fastened after the base of the lamp is locked and whereby the 'bonnet' R cannot be unfastened until the base of the lamp is unlocked, is as follows:—
- 5 "The upper edge of the lamp glass J bears against a shoulder L formed upon the lower edge of the gauze cover K. M is a spring which is attached to the lamp frame A, and N is a stud which is attached to the end of the spring M and passes through a hole in the lamp frame A. P is a spring which is fastened to the under side of the bonnet R, which latter is connected to the
- 10 "lamp frame A by means of the screw thread S.
- "When the ring E is screwed tightly home, the glass J holds the shoulder L of the gauze K firmly up against its seat in the lamp frame A, the said shoulder in its turn holding up the stud N as shown at Figure 3 and plan view Figure 4 and so keeping the spring M in a position to engage with the
- 15 "spring P, as seen at Figure 3. The lamp bottom B can now be screwed into position, the bolt C running round over the rack teeth H, until the said lamp bottom B is screwed securely home. Any attempt to unscrew the lamp bottom B without first withdrawing the bolt only tends to tighten the parts more firmly into position owing to the reverse direction of the screw threads F and D.
- 20 "When the lamp is handed to the miner in this condition, viz., with the lamp base locked but with the bonnet R. removed, the miner or inspector can only examine the gauze and they cannot tamper with the lamp. When the examination of the gauze K has been made, the bonnet R is secured firmly home, until the spring P takes behind the spring M, and the bonnet is
- 25 "thus firmly locked until the spring M resumes the position shown at Figure 2, which cannot take place until the lamp is taken to pieces in the lamp room.
- "Thus according to our invention the lamp bonnet R may be screwed on and off from the lamp frame, to which it can be locked by the spring catch M the said spring catch M only being brought into action when the glass J and the
- 30 "gauze K are pressed firmly in position by means of the ring E. This enables the lamp to be handed to the miner with the gauze, glass, and glass holding ring fastened into position, and with the lamp base already locked whilst the bonnet can be handed separately to the miner, or it can be screwed loosely on the frame but not far enough for the spring catch M to engage and lock the
- 35 "said bonnet R. The miner can thus take off the said bonnet R and see that the gauze K is in position and clean, and the inspector can repeat the examination and then screw the bonnet up until the spring lock P engages with the spring catch M in the lamp frame, thus firmly locking the bonnet R which cannot be again opened until the lamp bottom B is unlocked in the
- 40 "lamp room. The lamp cleaner is obliged to remove the gauze K and glass J in order to remove the bonnet R, thus preventing the possibility of his simply cleaning the interior of the gauze K with a brush so as to save himself the trouble of removing the glass holding ring E. If the gauze is not properly cleaned, or if it has been omitted, the neglect is at once detected by the miner
- 45 "or the inspector."
- The Patentee claimed:—"(1.) In a miner's safety lamp having a screw off bonnet, the employment of a spring catch for locking the bonnet, the said spring catch being brought into an acting position on the closing of the lamp, substantially as set forth. (2.) In a miner's safety lamp having a screw off
- 50 "bonnet, the spring stop M brought into the acting position by the flange L of the gauze K on the raising of the glass J when locking the lamp, in combination with the spring catch P on the bonnet R substantially as set forth. (3.) In a miner's safety lamp having a screw off bonnet, a spring catch P situated on the under side of the bonnet R, in combination with a spring stop M having
- 55 "a stud N the latter being actuated by the raising of the glass J on the lamp being closed substantially as set forth."

Ackroyd and Best, Ld. v. Thomas and Williams.

On the 22nd of November 1902 *Ackroyd and Best, Ld., Charles Topham Naylor and John Proudfoot Humble*, commenced an action against *Thomas and Williams* for infringement of the Patent, claiming the usual relief.

The Plaintiffs, by their Statement of Claim, alleged:— (1) That they were, and had been since the 12th March 1898, the owners of the Patent; (2) That the Patent was valid; and (3) That the Defendants had infringed the same. By their Particulars of Breaches they alleged that the Defendants had infringed the Patent by manufacturing lamps according to the invention, as claimed in all the three claiming clauses of the Specification, and delivering them to the persons or companies named at or about the dates stated (four instances were given, all in the year 1902, prior to the date of the writ). A letter of January the 12th 1904 to the Plaintiffs' Solicitors by the Defendants' Solicitors, stated that the Defendant was prepared to admit that he had manufactured and delivered lamps as alleged in the Particulars of Claim, and that such lamps were constructed according to the drawings of *L. N. Williams*' Specification, No. 25,334 of 1901.

The Complete Specification of this Patent, so far as material for the purposes of this Report, was as follows:—“This invention, which relates to miners' safety lamps, consists in an improved method of and means for locking the bonnet to the lamp body and unlocking it therefrom. Within a chamber provided on the step-top ring, that is to say, the ring above the glass, is a cup adapted to slide upwards and downwards. In the cup is a spiral spring in compression, the lower end of which spring bears against the inner face of the cup bottom. The other end of the spring bears against the underside of a bolt. The said spring tends constantly to force the bolt up and cause it to project at top above the top of the cup. A piston of larger diameter than the aperture through which the bolt projects prevents the bolt from being forced out of the cup upwards by the thrust of the spring. The cup is flanged at bottom. Between the upper face of the flange of the cup and a shoulder provided in the chamber is a spiral spring tending constantly to depress the cup. To the underside of the cup is screwed or otherwise attached one end of a pillar which extends down and is passed through the lower ring of the lamp body. A shoulder on the pillar limits the downward travel of the pillar by contact with the upper face of the lower ring of the lamp body. As the oil-pot is screwed into the lamp, the cup is raised by the consequent pushing up of the pillar connected to it. The spiral spring encircling the cup is further compressed in the chamber. The bolt carried in the cup is elevated to project above the top of the chamber. In the bonnet ring is a circular row of ventilation apertures, a provision made in some forms of safety lamps. The ribs between the apertures are specially shaped under this invention, that is to say, each rib is knife-edged and has an inclined face at one side. The ring of ribs and apertures constitutes a circular rack.

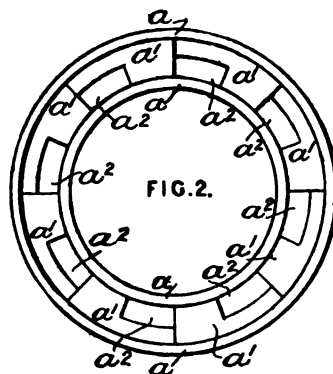
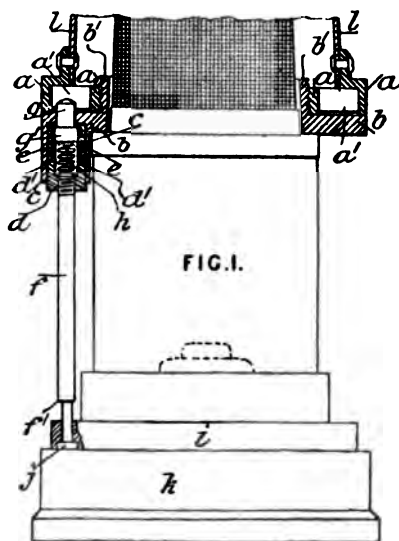
“In screwing the bonnet on to the lamp body, which is done subsequently to locking the oil-pot in place in the lamp, the bolt for locking the bonnet to the lamp is depressed against the resistance of the spring under it, and rebounds into a ventilating aperture in the bonnet ring, and thus the bonnet becomes locked on the lamp.

“Unlocking takes place as the oil-pot is being unscrewed. The spiral spring encircling the cup depresses the cup, and thus the bolt is drawn down clear of the bonnet and frees it.

“Referring to the accompanying drawings, Fig. 1 represents part of a miners' safety lamp fitted with my improvements for locking the bonnet to the lamp body and unlocking it therefrom. The view is partly in vertical section; the section being taken through the chamber in which the locking bolt is situated. Fig. 2 is a plan of the bonnet ring *a* as inverted. Fig. 3 is a vertical section through one of the wedge-like ribs *a*¹ intervening between the ventilation

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- "apertures a^2 —Fig. 2—of the bonnet ring a . Fig. 4 is a similar section at the opposite side of the lamp. Cast with the step-top ring b is a chamber c in which is a cup d which is adapted to slide vertically in the chamber c . Coiled about the cup d is a spiral spring e , the lower end of which bears on a shoulder d^1 provided on the cup. The upper end of the spring e bears against the inner face of the top of the chamber c . The spring e tends constantly to depress the cup d and with it the pillar f which is screwed or otherwise rigidly connected to the cup. A bolt g adapted to slide vertically in the cup d is acted upon from below by a spring h , the upper end of which bears against the under face of the piston g^1 of the bolt g . The lower end of the spring h bears against the inner face of the bottom of the cup d . The spring h tends constantly to force the bolt g upwards to the full extent of its upward travel, projecting out of the cup d as shown in the drawing. The piston g^1 , by contact with the inner face of the top of the chamber c , limits the upward travel of the bolt g . The pillar f is reduced in diameter towards the lower end. The part thus reduced loosely fits a passage provided for it in the bottom ring i of the lamp body. The extent of downward movement of the pillar f is limited by contact of the shoulder f^1 with the upper face of the bottom ring i . At foot the pillar f has attached to it a disc j which prevents the pillar from entering the aperture made in the oil-pot k for receiving the bolt by which, as ordinarily, the oil-pot is locked to the lamp body.



- "In the bonnet ring a is a circular row of ventilation apertures a^2 , as is the practice to provide in some types of miners' safety lamps. The ribs a^1 between the apertures are, under this invention, specially shaped. They are, as seen at Figs. 3 and 4 of the drawings, wedge-shaped. They are knife-edged teeth, and they are so made in the bonnet ring a that in screwing the ring on to the lamp body, the knife-edge of each wedge leads in the direction of rotation, and the deeper part of each wedge follows as a tail.
- "The act of screwing on the oil-pot k to the bottom body ring i causes the pot to come into contact with the bottom of the disc j fixed on the pillar f . The

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"latter is pushed up against the resistance of the spring *e*, which is further compressed. The pillar *f* carries up the cup *d* and the bolt *g*, which latter is thus made to project above the top of the step-top ring *b* into the bonnet ring *a*. When the oil-pot has been screwed fully home, it locks to the body, as ordinarily.

"The bonnet *l* is next screwed on to the extension *b*¹ of the step-top ring *b*. As, in screwing on the bonnet *l*, the ribs *a*¹ bear on the bolt *g*, the latter is depressed during the forward passage of each rib, but is, by the rebound of the spring *h*, shot up again into the succeeding aperture *a*² behind the deep face of the rib when the latter has passed, thus locking the bonnet to the lamp body by preventing the bonnet from being unscrewed. The bonnet cannot be unscrewed until the oil-pot *k* has been unlocked and unscrewed to allow the cup *d* with the bolt *g* to be depressed by the spring *e*."

The Defendants, by their Defence :—(1) Did not admit that the Plaintiffs were the owners of the Patent; (2) Denied infringement; and (3) Alleged that the Patent was invalid. By their Particulars of Objections they alleged : (1) That the said alleged invention, forming the subject matter of the Patent, was not new, but had been published in this Realm prior to the date of the Patent, in the Specifications of the following Patents : *A. Yates*, No. 2677 of 1871, *B. Patterson & Shupe*, No. 2697 of 1887, *C. Thorne*, No. 2779 of 1889, *D. Thomas*, No. 8136 of 1889, and *E. Hughes*, No. 27,150 of 1896. The Defendants relied upon the whole of each of these Specifications as anticipating all the claims in the Specification of the Plaintiffs' Patent; (2) That there was no subject matter; the Defendants relied thereunder upon common knowledge concerning the construction of miners' safety lamps, and of the various methods of locking the different parts of same, and upon the matters set out in paragraph 1; (3) That the alleged invention was not useful; lamps constructed as described in the Complete Specification could have their bonnets removed without unlocking the lamp; (4) That the Complete Specification of the Patent did not sufficiently describe the nature of the invention and the manner in which the same was to be performed, and was misleading in that the spring catch was not brought into operation by the closing of the lamp as alleged, or at all; (5) That the alleged invention was not new; but as to all the claims in the Complete Specification of the Patent, had been anticipated by the prior user of each of the lamps marked "A" to "H," which were in the possession of the Defendants' Solicitors, and could be inspected by the Plaintiffs.

The Particulars specified eight lamps, marked "A" to "H," the lamp "D" being called "Improved Cambrian," and the earliest date of user being given as 1887; the lamp "G" being called "Thomas' Patent, No. 8136 of 1889," the earliest date of user being given as 1889; and the lamp "H" being alleged to be manufactured by *Fredk. Griffin*, in October 1897, at the Defendants' works, and used at the Defendants' works, and at the *Lewis Merthyr Colliery Company*, in October and the following months of the year 1897.

The action came on for trial on the 11th March 1904, before JOYCE, J.

T. Terrell, K.C., and *J. C. Graham* (instructed by *Walker and Rowe*, agents for *Wooler, Burrows, and Burton*, Leeds) appeared for the Plaintiffs; *A. J. Walter* (instructed by *Purkis and Co.*, agents for *T. Phillips and Son*, Aberdare) appeared for the Defendants.

Terrell, K.C., opened the Plaintiffs' case :—This invention relates to improvements in miners' safety lamps. In such lamps the flame is protected by a wire gauze; but miners sometimes seek to avoid the protection, for instance, by sucking the flame through the wire gauze to light their pipes; and to prevent this bonnets are fixed on the bodies of the lamps. But the miner has to have the lamp given to him open, that he may be satisfied that the gauze is in and that it is not dirty. On the other hand, the colliery proprietor (by

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the mine inspector) has to insist on the bonnet being afterwards screwed home, and the patented device is for the purpose of preventing the bonnet being undone again. In the lamp there is a safety lock, only operated in unlocking by a powerful magnet or other means, and this is locked before the bonnet is put on ; it locks the bottom of the lamp, and it puts into operation what will lock the top as well when the bonnet is screwed home, so that the miner cannot then open either the bottom or the top ; and the bonnet cannot be removed until the bottom of the lamp is unlocked. [The patented lamp was shown and the Specification read.] Owing to the right-handed and left-handed screws any attempt to unscrew the bottom of the lamp only tends to tighten the parts, unless the bolt is withdrawn, in which case the whole of the parts of the lamp can be unscrewed. The bonnet remains locked until M can resume the position shown in Figure 2, that is until N can drop, which cannot happen until the bottom of the lamp is unscrewed. The point of the invention is that on screwing home the bonnet the benefit of the security of the main lock of the lamp is obtained for the bonnet. In Claim 1, the expression spring catch means M and N together. This is the most important claim, although all the three claims are really infringed, but the infringement is within the actual words of Claim 1. It has the screw-off bonnet and the spring catch, and that catch is brought into an acting position on the closing of the lamp. [Walter, in reply to a question by the Court, stated that the Defence was non-infringement, or, if the Defendants' apparatus was covered, then that the Patent was invalid.] "Substantially as set forth" must be read with each part named in the Claims. The new feature of this invention is bringing the spring catch into an acting position, that is, ready to operate, by screwing up the lamp ; for the first time it was made impossible to get at the gauze without undoing the bottom of the lamp. There had been many previous attempts to solve the problem.

The witnesses called for the Plaintiffs were *W. Best*, one of the Patentees, *P. M. Justice*, and *G. Brewer*.

Walter opened the Defendants' case, and referred to *Easterbrook v. Great Western Railway Company* (2 R.P.C. 201).

The witnesses called for the Defendants were *M. A. Adams*, *F. Griffin* (who stated that he made the lamp H at the latter end of 1897) and *L. N. Williams*.

Walter summed up the Defendants' case :—The Patent is for a particular combination, and the Defendants have not infringed. According to the Specification, the lamp cleaner is obliged to remove the gauze K and glass J in order to remove the bonnet R ; no combination which enables a lamp cleaner to get off the bonnet without removing the gauze is an infringement. In the Defendants' lamp, it is not necessary to take away the gauze in order to get off the bonnet. The Patentees state in the Specification what the particular arrangement characterizing the invention is. As to Claim 1, it is now said that the "spring catch" is, M, N and P, but, if so, it is not brought into acting position on the closing of the lamp, nor even on screwing in the ring E. Therefore, M, N and P do not make up the "spring catch." The Patent is bad if there is no description of what is claimed, or if the Patentees have insufficiently described the manner in which the invention is to be performed. If the construction contended for by the Plaintiffs is right then the Patent is bad, because there is no sufficient description of what is claimed, but the true construction is that M and N form the "spring catch," and Claim 1 means that they are brought into an acting position on screwing up of the ring E. Everything in the Specification points to this being of the essence of the invention. If the construction for which I contend is right, the Defendants do not take the combination and do not infringe. In their apparatus, they do not remove the gauze when taking off the bonnet ; they do not release the bonnet by unscrewing a ring ; they do not use any glass : and they do not put a ratchet into an operative

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position by screwing up any ring corresponding to E; they adopt an old method of raising a pillar by screwing in the oil container. If the Plaintiffs attempt to put their claim wider, then they are endeavouring to claim every miner's safety lamp having a screw-off bonnet automatically locked, and *Thomas'* Specification covers that. In the state of the art there was no scope for an invention having 5 such a broad claim as is set up, but only for an invention for special details. Moreover, the Patent purports to be for a lamp which cannot be tampered with, and can only be taken to pieces in the lamp room, but it has been shown that the lamp can be opened with a pin, and the invention does not accomplish the purpose which the Specification states that it accomplishes, and the Patent 10 is bad.

Terrell, K.C., in reply:—The first question is what is the true meaning of the Specification having regard to the state of knowledge of the time. At the date of the Patent there was no lamp which would do what the Plaintiffs' lamp does, none had accomplished, *quâ* function, its object. One must not take 15 one point from one alleged anticipation and another point from another anticipation, and so on. The last paragraph of the Specification is very important. The Patentees in the Specification state the known defect and how they are going to obviate it. They also state another advantage, that the gauze and glass must be removed before the bonnet is removed; but if the Defendants take the combination, it is immaterial that their lamp has not 20 all the advantages. In the Specification the Patentees admittedly describe in a clear manner what they intend to do; and the claims must be construed with the rest of the Specification. Even if inaccurate language is used in the claims, when it is obvious what the Patentees meant, the Court will give 25 effect to the claims. In Claim 1 "spring catch" means what is clearly shown in Figures 2, 3 and 4. It is true that the Patentees sometimes call M, N, and P the "spring catch," and sometimes only M and N, and that in one place they call P a "spring lock," but in Claim 1, "spring catch" means the combination of M, N and P. M and N do not lock the bonnet by themselves. "Being brought 30 "into an acting position" means that M and N are brought into such a position that they are capable of acting with P. The Patentees cannot be claiming M and N without P, for they would be useless; and each claim must be for a new and useful invention, otherwise the Patent is bad, *Deeley v. Perkes* (12 R.P.C. 192, and 13 R.P.C. 581). That case and *Tubes, Ltd.* 35 *v. Perfecta Seamless Steel Tube Company, Ltd.* (17 R.P.C. 569, 18 R.P.C. 339, and 20 R.P.C. 77), are cases just on opposite sides of a line. In the former case Claim 1 included no selective action, and in consequence it claimed what without that was useless, and the claim was bad, and that case shows that each claim stands by itself. As to infringement, the Specification states 40 the problems to be solved. The lamp has the capacity to perform three different functions; first that the lamp can be closed with the main lock fastened and the bonnet off, and so handed to the miner; secondly, that the bonnet is automatically locked when it is screwed on by the miner; thirdly, that the bonnet cannot then be taken off without undoing the main lock of the 45 lamp. There is another point as to the removal of the gauze, which the Defendants have not taken. The question is whether the omission of that part excuses them from infringement. The three classes of infringements are stated in *Clarke v. Adie* (L.R. 2 App. Cas. 315), and that case shows that a Patent may be infringed by the substance of the invention being taken, 50 although a Defendant does not take what is described in the express words of the claim. The judgment of *Lindley, L.J.*, in *Benno Jaffé und Darmstaedter Lanolin Fabrik v. John Richardson & Co. (Leicester), Ltd.* (11 R.P.C. 261, at p. 271), is to the same effect; one must look at the substance of the matter and not merely the words. The cases on the construction of claims show that, 55 although a claim read by itself might seem to mean one thing, yet if one finds

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on reading the whole Specification that it cannot bear that meaning, then one must put on it the construction that the whole Specification demands (*Tubes, Ld. v. Perfecta Seamless Steel Tube Company Ld.*, 20 R.P.C. 77). In that case the first claim was in words limited to "compressing and shaping," in which case
 5 it was anticipated, but it was held that the water cooling and expelling apparatus was intended to be included in it. In this case as in that, the wording may be bad and inaccurate and the terms used inappropriate, yet the Court will look at the substance of the matter. Although Section 5 of the Patents, &c., Act, 1883, requires that a Specification shall end with a distinct
 10 claim, yet in *Vickers, Sons & Co., Ld., v. Siddell* (7 R.P.C. 292), that section was held to be directory only. A combination Patent may be infringed, although some only of the parts are taken (*Nordenfelt v. Gardner*, 1 R.P.C. 61; *Dudgeon v. Thomson*, L.R. 3 App. Cas. 34, at p. 44). The question is no doubt, according to the case last-mentioned, whether the Defendants have taken the things
 15 specified, but one must regard the ideas and not the language. It is noticeable that in Claim 2, P is called the "spring catch." The particular form of the main lock of the lamp is not part of the invention. Claim 1 means in a miner's safety lamp the employment of those parts which produce the results described in the Specification. It is the only claim for the whole invention, and is thus
 20 different from the first claim in the case of *Deeley v. Perkes*, where the first and second claims would have been identical on one construction of Claim 1. "A spring catch" is claimed, not "the spring catch," and it means a pawl and rack so that there is sliding in one direction and stopping in the other. Also it is to be brought into acting position "on" not "by" the closing of the lamp;
 25 when the lamp is closed M and N are ready to work, they form the tooth of a rack and the pawl is screwed down on to it. The Defendants bring a spring pawl into an "acting position" on closing their lamp and have a different form of pawl and rack, but substantially there is no difference in their device. The patented combination is one having new functions by reason of the combination.
 30 The invention is claimed "substantially as set forth," and the substance is giving to the miner the advantage stated in the Specification.

Walter.—As to the cases last cited, I agree that the claim is to be read with the rest of the Specification, and that one must find out what is the substance of the invention, and whether, even in a combination Patent, the substance is taken
 35 by the Defendant. Then the Plaintiffs say that Claim 1 would be bad if not construed as they allege, and quote *Deeley v. Perkes* on that point; but I say that Claim 1 is drawn so as not to make P an essential element and might be good, although it is for M and N without P. It is in every case a question whether the substance of the invention is taken, but one must see whether the
 40 invention consists only in the special combination or whether a new principle is involved, as in *Proctor v. Bennis* (4 R.P.C. 333). This Patent is only for a particular combination, which the Defendants have not taken.

JOYCE, J.—The invention, or alleged invention, in question in this case, has reference to a miner's safety lamp with a screw off bonnet. It is the first
 45 claim, and that alone, which is alleged to have been infringed. It is in these terms: "In a miner's safety lamp having a screw off bonnet, the employment of a spring catch for locking the bonnet, the said spring catch being brought into an acting position on the closing of the lamp, substantially as set forth," by which I understand the employment in miners' safety lamps, for locking
 50 the bonnet, of a spring catch—whatever that may be—that is brought into an acting position on or by the closing of the lamp.

The Specification appears to me to be very loosely drawn, but that, I believe, is no uncommon case. It is asserted by the Plaintiffs, and assented to by the Defendants, that the Patent is for a combination; in fact, for a particular
 55 arrangement elaborately described in the Specification. It is not for carrying into effect a principle, as it is termed, in which case other modes of doing the

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same thing might possibly be protected; but it is, I think, for a particular mechanical mode of attaining certain results.

As to the spring catch referred to in the first claim, which is brought into an acting position on the closing of the lamp, it appears to me upon carefully reading the Specification, and construing it just as I should any other document, that what is referred to as the spring catch in the first claim is the device or catch (if that be a correct term) formed by the stud N furnished with the spring M, which presses it down so that it no longer acts as soon as all pressure or resistance on the lower end of the stud is removed by the withdrawal, not of the lamp bottom B, but of the ring E, which allows the glass chimney and the flange of the gauze above it to fall, and thus allows the spring M to depress the stud N. As a matter of fact, the Plaintiffs' spring catch is not brought into acting position by the closing of the lamp, but, at an earlier stage, by the insertion of the chimney in its proper position, if not by the previous resistance of the flange of the gauze, but at latest by the screwing in of the ring E. The closing of the lamp is a separate and subsequent operation.

The Plaintiffs' Counsel protested strongly against the interpretation which I place upon the first claim on the ground that, if this be the true construction, the Patent is hopelessly bad according to the decision of the Court of Appeal and the House of Lords in the case of *Deeley's Patent*, which will be found reported in the 12th and 13th volumes of the Patent Office Reports. If this result follows, I cannot help it, but for my part I have no doubt about the construction.

Whatever be the true construction, however, I think the action fails. The Defendants have not, in my opinion, taken any spring catch of the Plaintiffs, but have made a totally different one. They have not taken the Plaintiffs' particular combination or mechanical arrangement; nor, having regard to the previous state of knowledge, have the Defendants, in my opinion, taken the substance of the Plaintiffs' invention, if, indeed, there be anything in it that could be properly so called, which I doubt. The Defendants' lamp has not the same combination in substance or effect, but a substantially new or different combination. In other words, I hold that there is no infringement, and the action must be dismissed with costs.

A Certificate was given as to 1, 2 and 5 of the Particulars of Objections.

Counsel for the Plaintiffs applied for a stay of the taxation of costs in the event of an appeal. JOYCE, J., refused the application, stating that all the Plaintiffs were entitled to was an undertaking to refund.

On the 10th of May 1904 Counsel for the Plaintiffs stated that they had appealed, but the solicitors for the Defendants refused to give the undertaking to refund. JOYCE, J., intimated that if they refused he would stay the payment of the costs but not the taxation. Counsel for the Defendants then stated that if that was his Lordship's view the undertaking would be given.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE KEKEWICH.

April 21st, 1904.

HICKS v. SIMMONS.

5 *Patent.—Action for Infringement.—Construction of Specification.—Infringement found.—Judgment for the Plaintiff.*

The Specification of Letters Patent claimed "a Clinical Thermometer
 "having two or more chambers formed within the bore of the tube and a
 "comparatively open contraction within each chamber substantially as herein
 10 "shown and described, and for the purpose stated." The owner of the Patent brought an action for infringement of the same, in which the Defendant relied on non-infringement. In the Defendant's thermometer there were two contractions, but, at all events in its final state, only one chamber. The object of the two contractions was to overcome the difficulty which existed with
 15 one contraction only, in obtaining the return of the mercury after the temperature has been read; the chambers were necessary in manufacture for the purpose of obtaining the contractions.

Held, that the two contractions formed the pith and marrow of the invention; and that, notwithstanding the reference in the claim to two chambers, the
 20 Defendant had infringed. Judgment was given for the Plaintiff with costs; a stay was granted as to destruction of infringing articles, but refused as to the injunction.

On the 25th of February 1897, Letters Patent (No. 5120 of 1897) were granted to James Joseph Hicks for an invention of "Improvements in Clinical
 25 Thermometers."

The Complete Specification was as follows:—"The invention has for its object an improved construction of clinical thermometer with a view to render the re-setting of the same more easy than is the case with clinical thermometers as heretofore constructed.

30 "Heretofore clinical thermometers have been made with what is known as an "indestructible index," which is obtained by making a single knife-edge contraction in a chamber in the bore at a position more or less near the bulb, such

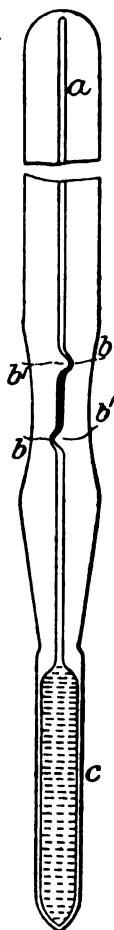
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"contraction acting, on the cooling of the mercury in the bulb, to separate the portion of mercury above the contraction from that below the same.

"With this construction of clinical thermometer it was necessary to make the said knife edge contraction so acute as almost to close the bore at that part, as otherwise the separation of the mercury above the contraction from that below would not take place on the cooling of the same, but the entire column of mercury would pass below the said contraction. 5

"The above-named construction of clinical thermometer renders it very difficult to re-set the same on account of the violent shaking or swinging necessary to cause the mercury in the tube to pass below the said contraction. 10

FIG. 2.



"My present invention is illustrated in the accompanying drawings, in which :—

"Fig. 1 is a longitudinal sectional diagram of a clinical thermometer showing my invention applied to that class of clinical thermometer known as the 'Non plus ultra,' in which the contraction for producing the 'indestructible index' is very near the bulb. Fig. 2 is a longitudinal sectional diagram showing my invention applied to an ordinary clinical thermometer in which the contraction for producing the 'indestructible index' is at a greater distance from the bulb, and Fig. 3 is a similar section showing a modification. 15

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"According to my present invention I obviate the difficulty hitherto experienced in re-setting clinical thermometers provided with an 'indestructible index' by the following improved construction.

"I make two chambers *b b* within the bore of the tube *a* at a short distance
5 "from each other, and within each of such chambers *b b* I make a contraction
" *b'*. By making two chambers within the bore of the tube, each provided with
"a contraction, instead of only one chamber and one contraction, I am enabled
"to make the two contractions employed by me less acute than is necessary
"with the single knife-edge contraction heretofore used.

10 "With my improved construction of clinical thermometer, by reason of the
"contractions employed to produce the 'indestructible index' being less acute
"than the single contraction heretofore used for such purpose, the mercury is
"enabled, when the thermometer is swung or shaken, to pass such contractions
"much more readily than heretofore, thereby greatly facilitating the re-setting
15 "of the thermometer.

"It may be remarked that with the present improved construction of thermometer, the chambers *b b* containing the contractions *b' b'* and the portion of the
"bore of the tube *a* between them, will always remain filled or nearly so with
"mercury, and although the contractions *b' b'* will allow the mercury to pass
20 "more freely than the single contraction heretofore used, they do not in any
"way interfere with the separation of the 'indestructible index' from the
"column of mercury on the cooling of the latter in the bulb *c*.

"These chambers *b* with contractions *b'* may be made more or less near to the
"bulb *c*, as shown in the drawings.

25 "In the modification represented at Fig. 3, in lieu of making two contractions
"in a single bore, I insert between the bulb *c* and the tube *a*, a short length of
"double-bore tube *a'*, the two bores of which communicate with the bulb *c* and
"also with the bore of the tube *a*, and I make a chamber *b* and a contraction *b'*
"within each of such bores of a similar character to those shown at Figs.
30 "1 and 2.

"It will be evident that more than two chambers with such contractions may
"be provided, but it is unnecessary to employ more than two."

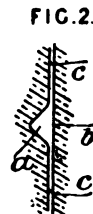
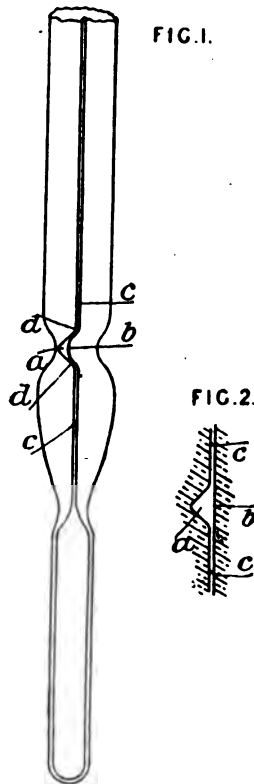
The Patentee claimed:—"1. A clinical thermometer having two or more
"chambers formed within the bore of the tube and a comparatively open
35 "contraction within each chamber, substantially as herein shown and described
"and for the purpose stated. 2. In clinical thermometers, the combination
"with a thermometric bulb and a tube having a bore communicating with said
"bulb, of two or more chambers interposed between the indicating part of the
"tube and the bulb, and a comparatively open contraction within each of such
40 "chambers, substantially as herein set forth and for the purpose stated. 3. The
"improvements in clinical thermometers substantially as herein shown and
"described and for the purpose stated."

On the 22nd of September 1903, the Patentee commenced an action against
George Alexander Simmons for infringement of the Patent, claiming the usual
45 relief. The Statement of Claim alleged the grant and validity of the Patent,
and that the Defendant had infringed. The Plaintiff by his Particulars of
Breaches alleged that the Defendant had continuously from the beginning of
the month of August 1903 and down to the date of the writ in the action,
manufactured and openly sold and offered for sale clinical thermometers of a
50 particular construction under the trade name of "Duo in Uno," and which
thermometers were made in accordance with the Plaintiff's patented invention,
and had been so made, sold, and offered for sale without any licence or
authority from the Plaintiff, and were complained of in this action; and that
on or about the 7th August 1903, the Defendant manufactured several
55 such thermometers and supplied them in the course of business to
Joseph Levi and Co., of 97, Hatton Garden, in the County of London; that

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the Defendant by an advertisement inserted in the "Optician" newspaper of the 7th August 1903, threatened to infringe the Plaintiff's said Patent by the manufacture and sale of clinical thermometers constructed as aforesaid.

The Defendant by his Defence denied infringement as alleged or at all, and that he threatened or intended to infringe the Patent. On the 27th of February 1902, the Defendant had taken out Letters Patent (No. 4998 of 1902) for "Improvement in Clinical Thermometers." The letterpress and Figures of this Specification which are set out below, sufficiently show and explain the infringement complained of, although the Plaintiff alleged that the two constrictions could not be made at one operation; evidence was, however, given on behalf of the Defendant that the two constrictions in the Defendant's thermometers were made at one operation.



The Defendant's Specification was as follows:—"My invention relates to clinical thermometers in which one or two constrictions are formed in the bore for the purpose of obtaining what is known as an 'indestructible index.' In the case of one constriction the objection obtains that it is difficult to reset even with violent shaking, and in the case of two separate constrictions in two separate chambers, this objection is overcome, but the formation of the double set of chambers and constrictions necessitates two operations, thereby increasing the cost of production.

"The object of my invention is, by an improved formation of the chamber in which the constriction is made, to enable two constrictions to be formed in the

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"same chamber, thereby securing the efficiency in one chamber of the two
 "separate less-acute constrictions, an arrangement or construction not hitherto
 "attained, and enabling a thicker column of mercury to be used while retaining
 "the desired speed of indication.

- 5 "In the accompanying drawings, Fig. 1 illustrates in section the lower portion
 "of a clinical thermometer with two constrictions in one chamber constructed
 "in accordance with my invention; Fig. 2 is a section of the chamber before
 "subjection to heat, and Fig. 3 is a modification of the shape of the chamber
 "also before subjection to heat. According to my invention, instead of forming
 10 "the chamber elliptical or eye-shaped as heretofore, I form the chamber *a*
 "triangular or conical as shown in Figs. 1 and 2, or other shape which has at
 "least one straight side *b* (e.g., semi-circular as shown in Fig. 3, rectangular or
 "semi-elliptical) all hereinafter referred to and included in the term 'triangular,'
 "said straight side or base *b* of the triangular chamber *a* being coincident with
 15 "the bore *c* and communicating therewith. On subjecting the base *b* of the
 "triangular chamber *a* to heat in the usual manner, the base is sucked inwards
 "by the partial vacuum in the chamber and bore towards the two walls of the
 "triangular chamber, leaving a triangular portion of small dimensions with a
 "constriction *d* at both sides or ends thereof communicating one with the
 20 "indicating column and the other with (or towards) the bulb.
 "This double constriction is caused by the fact that the base or straight side
 "of the chamber is of insufficient length to more than bridge across from side
 "to side of the chamber, thereby forming the constrictions, whereas in the usual
 "elliptical or eye-shaped chamber the side under the influence of the heat,
 25 "being of the same length as the opposite side, follows the contour of the
 "opposite side, and it is not possible to form more than a single constriction in
 "such chambers."

Moulton, K.C., and *J. W. Gordon* (instructed by *James and James*) appeared
 for the Plaintiff; *E. F. Lever* and *A. M. Wilshire* (instructed by *H. R. Newson*)
 30 appeared for the Defendant.

- Moulton, K.C.*, opened the Plaintiffs' case.—The only issue in this case is
 infringement and the facts as to the Defendant's sales alleged are admitted. The
 invention relates to clinical thermometers; the essence of such thermometers is
 that the bulb containing the mercury should be large and the tube small in com-
 35 parison; so that small changes of temperature give substantial indications in the
 tube. They can be read to one-fifth of a degree. On taking the thermometer from
 the body the mercury would draw back rapidly and thus the temperature would
 be registered as lower than it really is, but a contraction in the tube prevents the
 mercury from going back, although not from going on when rising. The result
 40 is that at the moment of cooling, the mercury breaks off at the contraction, and
 the part above the contraction does not follow the cooling part, and thus an
 indestructible index is obtained. There was a difficulty in getting the mercury
 to go back when required after reading the temperature, and it necessitated
 violent shaking; the object of the invention was to get over that difficulty;
 45 and it in fact enables one to get the mercury back easily, although it is difficult
 to understand the reason. The Patentee introduced two constrictions or
 contractions instead of one, and the invention has been a great success, 30,000
 of the patented thermometers have been sold without any complaints of difficulty
 in getting the mercury back. The method of making the constrictions is,
 50 after making the bulb and tube and before sealing, to blow a small enlargement,
 then after filling with mercury and sealing the glass is softened at a point
 of the enlargement and the pressure of the air forces the softened part in
 until it almost touches the other side of the tube. The invention was
 making two constrictions. [The Claims were referred to.] The Defendant
 55 blows one chamber and gets two constrictions by heating it at two points.
 In the course of manufacture there are two chambers formed, and the result

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produced by his instrument is the same. The result is the same and also the method of getting it. The chambers are in fact merely a means towards getting the constrictions. [*Lever*.—The Defendant makes the two constrictions by the one operation, he has one triangular chamber having two constrictions; and they are not knife-edge constrictions.] The Plaintiff says that the thermometers complained of are not made by the method described in the Defendants' Specification; and that the contractions are knife-edge contractions. It does not matter whether the chambers are left in the final state of the thermometer or not.

The evidence for the Plaintiff was then heard, Professor *Boys* being called as an expert witness.

Lever opened the Defendant's case, referring to the points mentioned above, and also relying on *Heath v. Unwin* (5 H.L.C. 505) as an authority that, even if what the Defendant did was an equivalent, it was not an infringement, not being a known equivalent at the date of the Patent.

The evidence for the Defendant was then called, including an employé of the Defendant, who had made substantially all the Defendant's thermometers of the kind complained of, and who stated that the constrictions were made at one operation by applying the needle-point flame to the centre of the base of the triangular chamber; he also alleged that the contractions were, in his view, not knife-edge contractions.

Professor *Boys*, recalled, in answer to questions put by KEKEWICH, J., said that the Defendant's thermometer had only one chamber finally, but during the falling in of the glass there were for the moment more chambers than one; that for the Plaintiff's result knife-edge contractions were not necessary, but he should call the contractions in the Defendant's thermometer knife-edge contractions.

Lever summed up the Defendant's case. Only a particular form of thermometer is claimed, and there are several differences between the Plaintiff's and Defendant's thermometers, and the mercury is more easily shaken down in the Defendant's than in the Plaintiff's. The differences in the instruments are as follows:—The Plaintiff has and claims two chambers, the Defendant has only one; the Plaintiff has eye-shaped chambers, the Defendant a triangular chamber; the Plaintiff has knife-edge contractions in each of his chambers, and claims for those particular contractions; the Defendant has two compressions made in one operation; the Plaintiff destroys the chambers finally, but the Defendant is unable to do this. It is submitted, therefore, that no infringement has been established.

No reply was called for.

KEKEWICH, J.—The question which I have to decide is whether, in making the clinical thermometers which he has made, and of which a sample has been produced, the Defendant takes the pith and marrow, to use a stereotyped phrase, of the Plaintiff's invention. In order to decide that, I must, of course, ascertain what the Plaintiff's invention is. I understand that the object of a clinical thermometer is this—By bringing the bulb in which the mercury is placed into contact with the patient, either by putting it into his mouth or otherwise, you make the heat of the body expand the mercury and you ascertain what is the extent of that expansion; but it is difficult to ascertain that with accuracy, because directly the thermometer is withdrawn from the heat, the mercury falls in the tube, and in that loss of time there may be a great loss of accuracy. That, as I understand the explanation which was given to me, was got over before the Plaintiff's Patent in 1897, by making what is called in his Specification a contraction, what is called in the Defendant's Specification a constriction, and what has been called in the witness box a compression, in the tube in which the mercury rises. I understand that really the effect of this contraction, constriction, or compression is not merely to narrow the tube, which is circular,

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or something approaching to circular, but to bring the walls of it together, more or less flattening them, so as to give a very narrow passage for the mercury and making it extremely difficult for the mercury to return, though by force of the heat it will rise up without real difficulty. That, as I understand the Plaintiff's

5 Specification and the evidence given in the witness box, was the state of knowledge at the date of the Plaintiff's Patent. There was one objection to the clinical thermometer so constructed. It answered admirably as regards accuracy in ascertaining the heat of the patient, but it was not of such great practical use as was expected or desired, because it was difficult to get the mercury back, which

10 was done by, using the words of the Plaintiff's Specification, "violently shaking" or swinging," which was necessary to cause the mercury in the tube to pass below the contraction. The Plaintiff invented this—it occurred to him that if you had two contractions, you might have the same result as regards accuracy, that is to say, you would have what is called the indestructible index or

15 registered maximum, and you might make those contractions—I use that term now—smaller, that is to say, not so complete in their obstruction to the passage of the mercury, with the result that you would get the mercury through each of them, and therefore through both of them on its return journey much easier, that is to say, with less violent shaking or swinging. That was his notion.

20 That is described in the Specification with reasonable clearness. I understand from the evidence that the result has been thoroughly satisfactory, and that there is no question that he has achieved that which he proposed to achieve. In his Specification he describes how that is to be done. I have not had much criticism of the Specification, and I am construing it rather without that

25 advantage, which one generally gets in Patent cases, of a critical examination of the language, but I think he describes what he intends to do with reasonable clearness. In the first place, he speaks of the knife-edge construction in the former clinical thermometers as so acute as almost to close the bore at that part; and it has been argued from that, that therefore the contraction which he

30 himself adopts is necessarily a knife-edge contraction; that is to say, it is argued that when, in the description of his invention, he talks about a contraction, which he does in line 20 on page 2,* he necessarily means a knife-edge contraction, and it is said that the Defendant's thermometer has no knife-edge contraction. I do not consider the Plaintiff as meaning that. I do not

35 consider him as meaning that necessarily he is bound to adopt a knife-edge contraction, whatever that may be; he, it seems to me, is content with contraction, and whether it is a knife-edge contraction or not, as long as it is a contraction which produces the result, it is immaterial to his invention. But without pretending to understand exactly what a knife-edge contraction is,

40 I think I have sufficient evidence before me that the Defendant's contraction is of that character. I think it is immaterial, but if it comes in question whether, as a matter of fact, it is a knife-edge contraction or not, or a contraction of that character, it seems to me that the evidence goes to show that it is a knife-edge contraction. But my judgment proceeds on the basis of the knife-edge

45 contraction not being essential.

A great difficulty in the way of the Plaintiff is this—He certainly describes and claims a clinical thermometer having two or more chambers formed within the bore of the tube; he speaks of two contractions, and in Claim No. 1 of a comparatively open contraction with each chamber. His claim is for a specific

50 instrument, substantially, of course, as described, but as his claim is for a specific instrument, it becomes important to see whether his specific instrument necessarily involves two or more chambers as co-existing in the clinical thermometer when it is produced in the market and used. He has put himself

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into considerable difficulty by the way in which he has accentuated "two or more chambers." I think there can be no doubt on the evidence that the Defendant has not got in the clinical thermometer put on the market two or more chambers. I think it is clear that he has only one chamber. I think it is equally clear that the Plaintiff has two or more chambers, each contraction being in a chamber 5 of its own, but I think it is also reasonably clear on the evidence, that the Defendant, who has two contractions, and claims two contractions, though he has only one chamber in the thermometer put on the market, necessarily constructs his thermometer by going through the process of making more than one chamber. There may be no appreciable interval of time in which you can 10 say that two chambers exist, but the chambers in the sense in which the chambers have been described, do come into existence for the purpose of making the contraction. But, apart from that, and notwithstanding the way in which "two or more chambers" are accentuated, I do not think that that is the pith and marrow of the Plaintiff's invention. The pith and marrow 15 of the Plaintiff's invention are the two contractions which he only saw his way to introduce into the thermometer by having two chambers and leaving them there as he does. Assuming that the Defendant never had two chambers, and assuming, as I think is the fact—the other being an assumption only—that there are not two chambers now, the Defendant has the two contractions, and two 20 contractions introduced for the express purpose of making the return of the mercury easier, and avoiding the violent shaking or swinging. Therefore it seems to me that, on a reasonable interpretation of the Plaintiff's Specification, the Defendant has taken the pith and marrow of the Plaintiff's invention, and that therefore the Plaintiff is entitled to the relief he asks. 25.

Gordon.—There will be Judgment for the Plaintiff for an Injunction and an Account of Profits; an Order for destruction of infringing articles, and costs?

KEKEWICH, J.—Yes.

Wilshere.—Will your Lordship grant a stay of execution for fourteen days?

KEKEWICH, J.—Fourteen days will not do for you. Do you mean, to give 30 you a chance of appealing within fourteen days and a further stay if you appeal?

Wilshere.—If your Lordship pleases.

KEKEWICH, J.—Yes, that is reasonable. That is to say, as far as the destruction is concerned. I do not suspend the Injunction. If you want the Injunction suspended against making and vending these articles, which I have held to 35 be infringements, you must ask for that elsewhere. I decline to allow a man to continue to do what is wrong because he is going to say elsewhere, that it is right.

Gordon.—With regard to the costs, they will be paid on the ordinary undertaking. 40

KEKEWICH, J.—That is the ordinary rule. I never allow that to be discussed. I hope there will be no difficulty between the Solicitors in giving the usual undertaking to return if the Court of Appeal decides adversely to my view.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE KEKEWICH.

April 14th, 15th, 16th, 18th and 19th, 1904.

PETER PILKINGTON, LD. v. B. AND S. MASSEY.

5 *Patent.—Action for Infringement.—Issue of Infringement.—Judgment for Plaintiffs.—Stay of Injunction refused.—Solicitor and client costs.*

The Specification of Letters Patent for "Improvements in atmospheric or power hammers" ended with 5 claims, the first of which was as follows:—
"In an atmospheric hammer, arranging the closed ends of the hammer and air
 10 *pump cylinders in proximity to each other, and directly connecting them*
"through short passages of small capacity controlled by one or more valves, the
"arrangement being such that air can be drawn direct from the hammer-head
"into the air pump cylinder, at each suction stroke of the pump, to cause the
"hammer-head to rise, and air can be forced direct from the said pump into the
 15 *"hammer cylinder at each compression stroke of the pump, to cause the hammer-*
"head to descend, so that the hammer-head will work in unison with and will
"promptly respond to the movements of the pump piston substantially as herein
"described." Claims 2, 3 and 4 commenced with the words "an atmospheric
"hammer of the kind specified in Claim 1"; Claim 5 was for the particular
 20 *hammer described and shown. The hammer described in the Specification had*
the capacity of regulating the force of the blow, and of the hammer-head being
held up or down whilst the air pump continued to work. The owners of the
Patent, having commenced an action for infringement, the Defendants relied
mainly on non-infringement, although they also contended that the hammer
 25 *described and shown would not work practically. The Defendants' hammer had*
both ends of the cylinders closed, and a by-pass between the ends of the air
cylinder, and the upper passage was free, and they contended that the Claims
in the Specification only extended to hammers in which the pressure of the
atmosphere was employed in raising them; also that Claim 1 did not include
 30 *the holding up and down actions, and the parts relating thereto, or, if it did, it*

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was for the specific hammer described, and that they had not got the patented devices; and that Claims 2, 3 and 4 were appendant claims, so that unless the alleged infringement was covered by Claim 1, there was no infringement.

Held, that the objection to validity failed; that the claims were not limited to hammers in which atmospheric pressure was used; that Claim 1 included the 5 parts for holding up and holding down, and was for a specific hammer; that Claims 2, 3 and 4 were appendant claims; that the Defendants' by-pass was a convenient way of making the invention workable where both ends of the cylinders were closed; and that the Defendants had infringed. Judgment was given for the Plaintiffs, with costs, a stay being granted as to delivery up in the 10 event of an appeal, but a stay of the injunction granted was refused. A Certificate that the validity of the Patent came in question having been granted in *Pilkington v. Yeakley Vacuum Hammer Company* (18 R.P.C. 459), a Certificate depriving the Plaintiffs of solicitor and client costs was refused.

On the 9th of August 1894, Letters Patent (No. 15,212 of 1894) were granted 15 to *Thomas Jameson*, on a communication from abroad by *R. M. Reay*, for an invention of "Improvements in atmospheric or power hammers." The Complete Specification was as follows:—

"This invention has reference to an improved construction of atmospheric or "power hammer designed to combine the advantages of steam, drop and 20 "atmospheric hammers, and which, while simple in construction, is completely under the control of the operator and so as to render it applicable "to all kinds of forging, welding, stamping, drawing, tapering, embossing and "like operations.

"And in order that this invention may be fully understood I will proceed 25 "to describe the same with reference to the accompanying drawings, in which "Figs. 1, 2, and 3 are respectively front, side, and rear elevations, and Fig. 4 "a plan, showing an atmospheric hammer constructed according to this "invention. Fig. 5 is a central vertical section thereof, partly in elevation. "Fig 6 is a section on the line *xx* of Fig. 5, looking in the direction indicated 30 "by the arrows in that figure. Fig. 7 is a section on the line *yy* of Fig. 6, "looking in the direction of the arrows in that figure. Figs. 8 to 13 inclusive "are detail-views hereinafter referred to.

"The improved power hammer comprises a hammer cylinder 1 and "an air pump cylinder 2 inclined to each other, and provided respectively 35 "with a hammer head 3 and a piston 4, the upper ends of the "cylinders being directly connected by a short passage controlled by a "valve as hereinafter more particularly described. The hammer head is "arranged to fit the cylinder 1 in which it works after the manner of a "plunger, the said cylinder being of uniform bore throughout. The piston 4 40 "which serves to exhaust air from and compress air into the cylinder 1, for "the purpose of reciprocating the hammer head, is connected by a rod 5, and a "crank-pin 6 to two discs 7 which act as fly wheels. One of the discs 7 is "secured on a shaft 8 provided with fast and loose pulleys 9 and 10 respectively "and carried in a bearing 8". The other disc is carried by a pin 8" supported in 45 "the frame at 8". The cylinders 1 and 2 are adapted to communicate with each "other by means of two sets of ports 11 and 12. The ports 11 are forked and "open into the cylinder 1 at two places 11^a and 11^b in the length thereof. The "ends of the ports 11 and 12 remote from the cylinders 1 and 2 open into a "cylindrical valve-chamber 13, in which are arranged two rotary slide valves 50 "14 and 15 (see Figs. 12 and 13) adapted to close the ports 11 and 12 respectively.

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- "The valve 14 is operated by means of a spindle 16 which is connected by means of a crank 17 and a rod 18 to a treadle 19. The valve 15 is operated by means of a sleeve 20 which is situate on the spindle 16, and has secured on its outer end a hand regulating-lever 21. The valve 14 is a flap valve of arc-shape in end view, as shown in Figs. 5 and 13, and is adapted to fit the internal cylindrical surface of the valve-chamber 13. Near one of its edges is a hole 22 (Figs. 12 and 13) with which engages one of the prongs of a bifurcated part 23 carried by an extension 24 of a boss 25 fast on the spindle 16 (Figs. 10 and 11), the arrangement being such that the valve can be rocked by the spindle 16, but is free to lift to a small extent from its circular seat when not forced thereon by compressed air, the extent of lift being limited by the curved edge 24^a of the projection 24. The valve 15 is similar to the valve 14, and is similarly attached to and operated by the sleeve 20. The spindle 16 and its sleeve 20 are supported in a bearing block 26 screwed into the body of the hammer in which the inner end of the spindle 16 has a bearing as shown. 27 and 28 are leather-washers for making airtight joints between the spindle 16 and sleeve, and between the sleeve and block respectively. 30 is a set-screw by which the spindle 16 can be forced endways in a direction to compress the said washers. 31 is a leather flap-valve adapted to permit air under pressure to issue from the cylinder 2 through a hole 32 but to prevent air from entering therethrough. 31^a is a cover or guard plate for the said flap-valve. 33 is a spring bar arranged normally to keep the treadle 19 in the position shown in the drawings. The piston 4 is provided with a packing ring 34 that may be of cast iron as usual. The hammer-head 3 is also furnished with packing-rings 35 that may be of metal, but are preferably of leather as this material makes a very good joint, is not affected by shocks, wears well, and is very easily renewed. For the latter purpose the hammer-head 3 may be lifted out of the cylinder 1 in the case of small hammers the top of the cylinder being for this purpose made removable; or in the case of large hammers it will be sufficient to remove the hammer-face 36 and, possibly, also the anvil-block 37—which should then be made detachable—to allow the hammer-head to descend sufficiently far to expose the packing-grooves therein. A single oil-hole 38 may be provided for the two cylinders and the valve, the oil being distributed therefrom by means of the pressure and vacuum produced in the machine. The lubricant will be prevented from dripping upon the work by reason of the vacuum set up in the cylinder 1 at each upstroke of the hammer-head.
- "When it is desired to use the hammer, the driving-belt is shifted from the loose pulley 10 to the fast pulley 9. Assuming the valves 14 and 15 to be in the positions shown in Fig. 5, the descent of the piston 4 in the cylinder 2 will cause air to be exhausted from the cylinder 1 through the ports 11^a and will thus cause the hammer-head 3 to be raised by the pressure thereon of the external atmosphere. A leather flap-valve 39 serves to prevent air being sucked from through the upper ports 11^b thereby ensuring that there shall be a cushion of air at the top of the cylinder 1 to prevent the hammer-head 3 when rising from striking against the cover end of the cylinder. The ascent of the piston 4 will have no effect on the position of the hammer-head 3, as the valve 14 will, when in the position shown, be forced on its seat and prevent air passing into the cylinder 1. In its descent the piston 4 will pass the hole 32 and on ascending will expel therethrough a portion of the air in the cylinder 2; by this means the partial vacuum in the cylinder 1 will be maintained and too great a pressure prevented from being produced in the cylinder 2. In order, now, to produce a succession of blows, the treadle 19 is pressed down, causing the valve 14 to rise and clear the ports 11; when the treadle is released the valve will be returned to its closed position and the blows will cease, the hammer-head remaining in a raised position.

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"If it is desired merely to press down some article on the anvil, as in a vice
"the valve 15 is lowered over the ports 12 by means of the hand lever 21 and
"the valve 14 is slightly raised by means of the treadle 19 and when the
"hammer-head reaches the article, the valve 14 is opened to the extent
"requisite to produce the desired pressure. 5

"The hammer-head can in the manner just described be lowered into any
"desired position and then retained there by closing the valve 14; this
"operation is often useful to level a tool to the work to be operated on before
"commencing to strike.

"To strike a blow and prevent the hammer-head from subsequently 10
"rising, the ports 12 are closed by the valve 15 and the treadle 19 is depressed
"—gradually or suddenly according to the severity desired for the blow.
"When it is desired to strike a blow of as great force as possible, the
"treadle is pressed down quickly and allowed to rise at about the same time
"as the blow is delivered so as to resume its initial position before the piston 15
"4 rises again and produces another blow.

"Light blows and short strokes of the hammer-head are produced by
"slightly depressing the treadle 19; and the severity of the blows and the
"length of the strokes are increased as the depression of the treadle
"continues. 20

"It will be seen that the hand lever 21 is rarely used and that consequently 20
"one man is usually sufficient to hold the article to be treated and to operate
"the hammer. When, however, the work required to be done is of such a
"nature that one man is required to hold the article, and another to operate
"the hammer, it is preferable to substitute a lever for the treadle-arrangement 25
"for operating the valve 14. In some cases the valve 15 may be omitted.
"Instead of constructing the hammer-head as a piston, a separate piston may
"be employed and the hammer-head be suitably secured thereto, but the former
"arrangement is preferred, as being simpler.

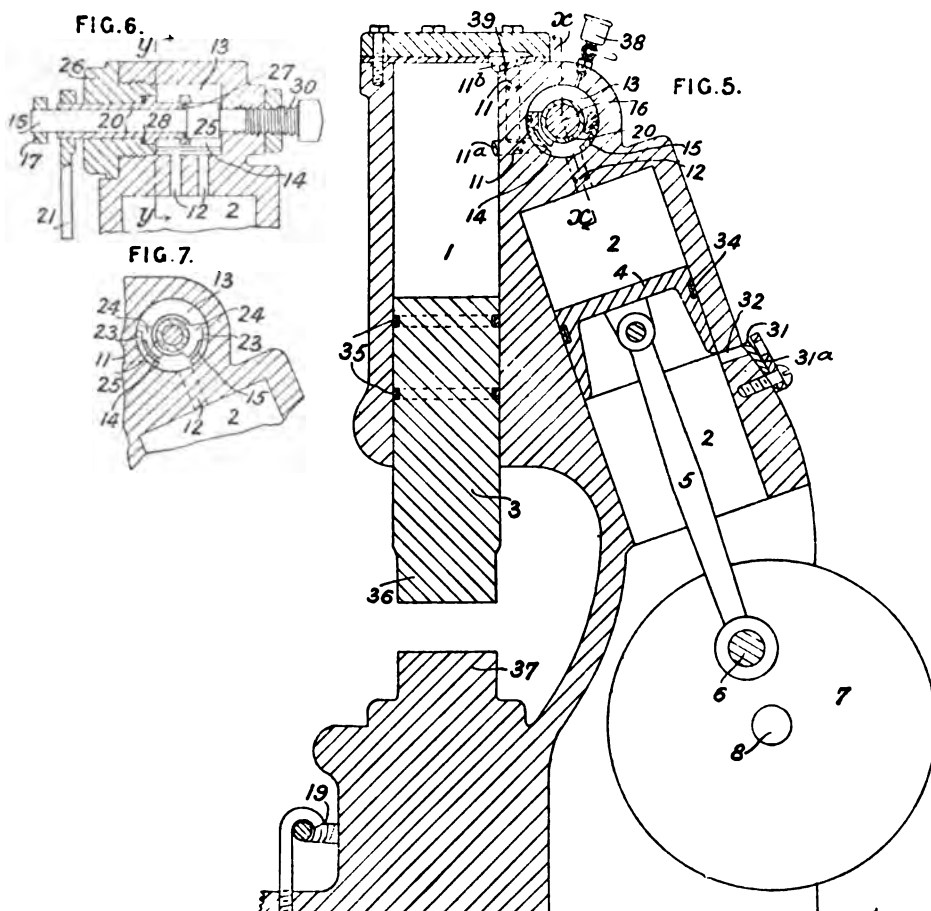
"A power hammer constructed as described will be found to be particularly 30
"adapted for architectural ironwork, bridge-building, locomotive-work, ship-
"building, the manufacture of hardware and axes, blacksmith-work, tool-
"dressing of all descriptions and general forge-work."

The Patentee claimed:—

"1. In an atmospheric hammer, arranging the closed ends of the hammer 35
"and air-pump cylinders in proximity to each other and directly connecting
"them through short passages of small capacity controlled by one or more
"valves, the arrangement being such that air can be drawn direct from the
"hammer head into the air pump cylinder at each suction stroke of the
"pump to cause the hammer head to rise, and air can be forced direct from said 40
"pump cylinder into the hammer cylinder at each compression stroke of the
"pump, to cause the hammer head to descend, so that the hammer head will
"work in unison with and will promptly respond to the movements of the
"pump piston substantially as herein described. 2. An atmospheric hammer
"of the kind specified in Claim 1, in which the passage between the hammer 45
"and air pump cylinders is controlled by a valve adapted to automatically
"lift or open to a small extent after being moved into its closed position,
"so as to allow of the passage of air from the hammer cylinder to the air
"pump cylinder at each suction stroke of the latter, irrespective of the position
"of the valve operating mechanism, substantially as hereinbefore described. 50
"3. An atmospheric hammer of the kind specified in Claims 1 and 2, in
"which the passage of air from the air pump cylinder to the hammer cylinder
"is controlled by a second valve adapted to automatically lift or open to a small
"extent when subjected on its underside to the action of compressed air,
"substantially as hereinbefore described. 4. An atmospheric hammer of the 55
"kind specified in Claim 1, in which the air pump cylinder is provided with an

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- “outlet-valve through which excess of air will be expelled by the air pump piston
 “in order that the necessary vacuum will be produced in the hammer cylinder
 “at each suction stroke of the pump substantially as herein described. 5. The
 “improved atmospheric hammer, constructed, arranged and operating
 5 “substantially as described and shown.”



In 1902, *Peter Pilkington, Ltd.*, the owners of the Patent, commenced an action against *B. & S. Massey* for infringement of the same, claiming the usual relief with costs as between solicitor and client.

By their Statement of Claim the Plaintiffs alleged (1) that they were the legal owners of the Patent; (2) that the Defendants had infringed; and (3) that a certificate that the validity of the Patent had come into question was granted on the 25th day of July 1901 by Mr. Justice *Kekewich*.*

The Particulars of Breaches alleged:—(1) That the Defendants, prior to the issue of the Writ in this action, had manufactured at their works at Openshaw, Manchester, and had used, sold, and advertised for sale, pneumatic

* See *Pilkington v. Yeakley Vacuum Hammer Company* 18 R.P.C. 459.

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hammers constructed in accordance with the Complete Specification of the Patent, and as claimed in the first, second, and fifth claims thereof; (2) In particular the Plaintiffs complained of the sale by the Defendants to one *G. T. Grey*, marine engineer, of Parr Bank, West Holborn, South Shields, of a pneumatic hammer constructed as aforesaid; (3) The Plaintiffs also complained of an advertisement on page xvii. of "The Engineer," of the 18th of July 1902, in which advertisement the Defendants advertised and offered for sale pneumatic hammers constructed as aforesaid; and (4) The Plaintiffs reserved the right to recover in respect of all infringements."

The Defendants by their Defence:—(1) Denied infringement, and (2) Alleged that the Patent was contrary to law, void and of none effect, having been granted for an alleged invention which was not new and useful. Particulars of Objections to the validity of the Patent were delivered therewith.

The Particulars of Objections alleged:—(1) That the alleged invention in respect of which the Patent was granted, was not new, but was matter of common knowledge within this realm at and before the granting of the Patent; (2) That the alleged invention had, before the grant of the Patent, been published in various ways within the realm, and particularly in certain Specifications published at the Patent Office at the dates thereafter mentioned. [Particulars of these Specifications were then given, including that of *Manson* (No. 1603 of 1874), which was the one chiefly relied on at the trial. Other publications were alleged in paragraphs 3 to 6 inclusive.] (7) That *Thomas Jameson*, to whom the Patent was granted, was not the true and first inventor of the alleged invention in respect of which the Patent was granted; (8) That the alleged invention as described was not useful; (9) That the Specification by the Patentee lodged at the Patent Office of the alleged invention contained no sufficient description thereof, and no description at all of any useful or practical invention; in support of this contention the Defendants would produce evidence to prove that a machine constructed as shown in the drawings and as described in the letterpress of the Specification could not be made to work by reason of its being wholly unfit to produce the necessary changes of air pressure in the hammer cylinder, and by reason of the excessive pressures which would be generated in the air pump, and by reason of the want of suitable appliances for making good the loss of air from the interior of the machine by leakage.

Further Particulars of Objections were delivered, which alleged, in respect of the Objection, that the said alleged invention was not new at the date of the Patent, that the alleged invention was used and published within the realm by the manufacture by Messrs. *John Hands & Sons*, of Cardigan Works, Belmont Row, Birmingham, and the delivery by them to Messrs. *A. and F. Parkes*, of Coldfield Works, Dartmouth Street, Birmingham, in the end of the year 1882 or the early part of the year 1883, of a pneumatic hammer constructed in accordance with a working drawing marked "Double Cylinder Pneumatic Hammer scale 3 in. to a foot A. & F. P. & Co.," and bearing the date 9th November 1882, which said drawing could be inspected by the Plaintiffs at the offices of Messrs. *C. Robinson Walker & Sons* and by the user of the said hammer by the said Messrs. *A. & F. Parkes* at their works as aforesaid continuously from the year 1883 down to the present time.

The Defendants, on an application for leave to deliver interrogatories, admitted the sale alleged in paragraph 2 of the Particulars of Breaches and the insertion of the advertisement complained of by paragraph 3 and made certain admissions relating to paragraph 5 of the Particulars of Objections. On the 20th of October 1903, the Defendants made an affidavit on an application by the Plaintiffs for inspection, stating that the construction of the hammer complained of in the action was to the best of their knowledge and belief in exact accordance with the lines upon which the hammer or parts of a hammer

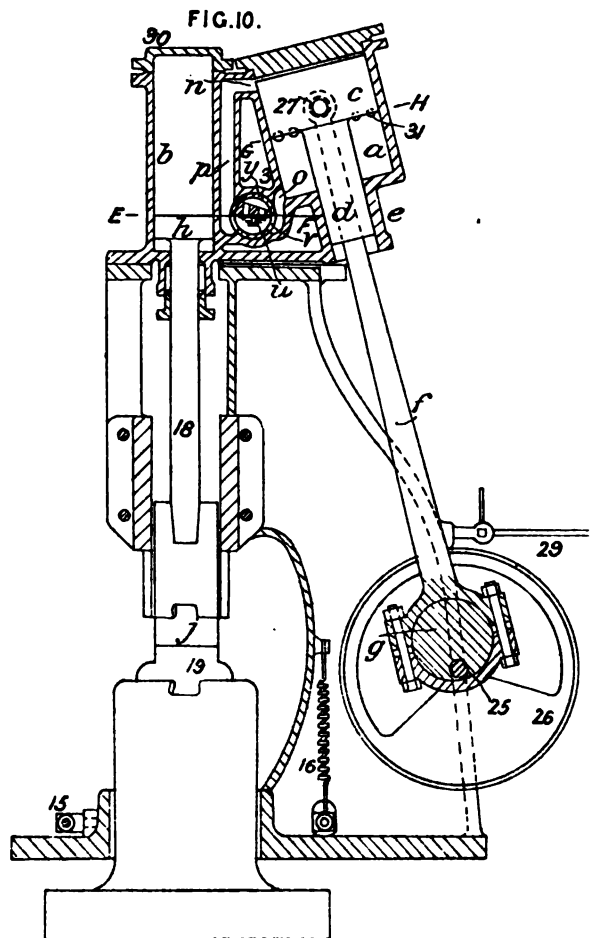
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illustrated by Figures 7 to 18 of *H. F. Massey's* Specification 14,022 of 1900 (Improvements in Pneumatic Power-Hammers) were designed.

- Figs. 10 and 15 to 18 of the last-mentioned Specification are shown on the next two pages hereof. The parts of the Specification referring to them and
- 5 material for the purpose of this report are as follows:—"This invention consists
 "in improvements in pneumatic power-hammers and its principal object is the
 "provision of power-hammers, which shall be more efficient and convenient
 "in use than those hitherto constructed and may be arranged to permit any
 "desirable length of stroke to the tups or hammer-heads or other corresponding
 10 "parts used therein and be capable of striking blows of any desirable force and
 "be readily controlled in action so, that the tups or hammer-heads or other
 "corresponding parts of such hammers may be made to strike single blows,
 "be made to make strokes of the full length permitted by the construction
 "of such hammers or of any less length, be made to strike blow after
 15 "blow for any desirable period, be held away from the anvils or other
 "objects with which they are used or be used to hold articles or materials
 "fast upon the said anvils or other objects. Power-hammers may also be
 "constructed according to this invention to accomplish the said object in
 "part only."
- 20 The Specification subsequently described (*inter alia*) a form of the invention
 in which, in addition to the passage *p* being controlled by a valve *t*, the passage
k was open and the passage *m* was controlled by a back-pressure-valve *w*, and
 another form in which both the passages *k* and *m* were controlled by valves,
 and continued:—
- 25 "It is possible to provide a back-pressure-valve or back-pressure-valves to be
 "inserted at times in either one or both of the passages *k m* for the same
 "purpose as in the arrangement described with reference to Figs. 5 and 6 with-
 "out providing a back-pressure-valve or back-pressure-valves to be inserted at
 "times in the passage *p* or without employing the passage *p*. Thus for instance
 30 "a back-pressure-valve may be provided to be inserted at times in either or
 "each of the passages *k m* employed in the arrangement herein described with
 "reference to Fig. 3 and Fig. 4. In cases in which two or more valves are
 "used they may be either completely separated and be worked by separate
 "devices of any suitable kind, or they may be connected so as to be controlled
 35 "together as is illustrated for example in Fig. 4, or they may be arranged so as
 "to be carried by one piece which being moved moves them both or all as
 "illustrated by way of example in Figs. 7 to 18 of the accompanying
 "drawings. In the power-hammer illustrated by Figs. 7 to 18 the passage *k*
 "from the top of the pump-cylinder *a* to the top of the hammer-cylinder *b* is
 40 "arranged to be always open while the passage *m* from the bottom of the
 "pump-cylinder *a* to the bottom of the hammer-cylinder *b* is arranged so that
 "it may be left open or have a back-pressure valve *w* inserted into it so that
 "it may be closed against the passage of air in either direction while remaining
 "open to the passage of air in the opposite direction. The back-pressure-
 45 "valve *w* is carried by a plug *x* which itself forms a valve *t* and is arranged
 "so as to be capable of being made to partly or entirely close the passage *p*
 "connecting the top and bottom of the pump-cylinder *a*. The plug *x* is also
 "made to carry a back-pressure-valve *v* which may be inserted in the passage
 "p so as to close it against the passage of air in either direction while allowing
 50 "air to pass in the opposite direction.
 "Each of the back-pressure-valves *v w* illustrated in the accompanying
 "drawings is formed of a plate with a central hole embracing a stud secured
 "in the plug *x* and is arranged to be pressed against a face on the plug *x*
 "so as to cover holes therein by means of a spiral spring which may con-
 55 "veniently be formed out of wire or steel plate and is made to bear against the
 "plate and against the head of the stud.

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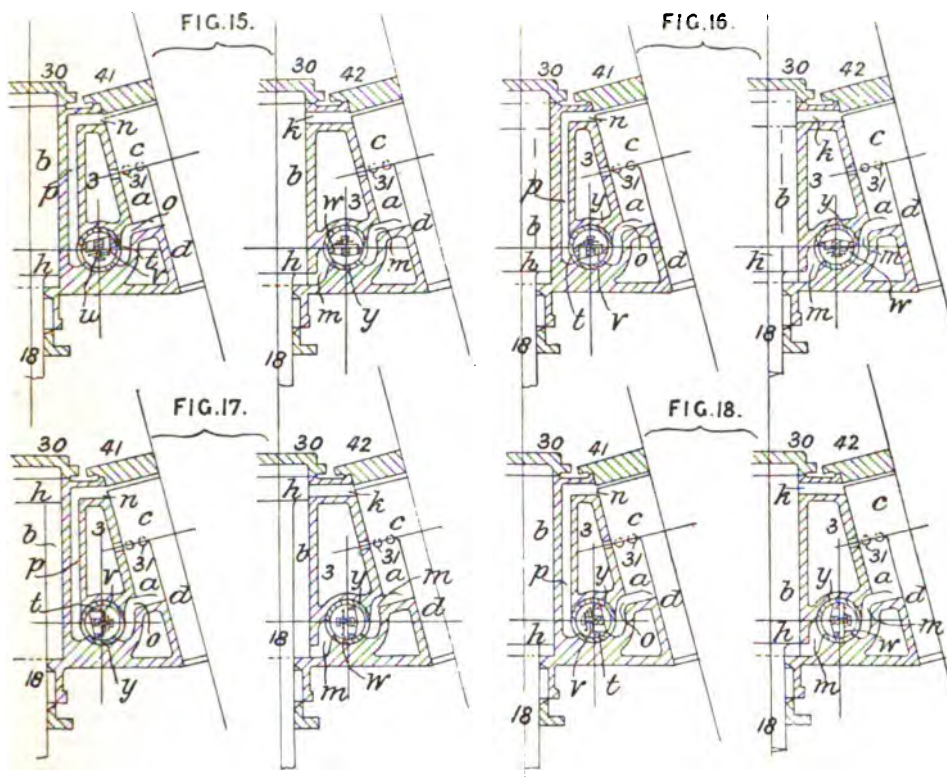
" Fig. 13 shows separated from each other the parts forming one of the
 " back-pressure-valves *v w*. The plug *x* is arranged to be turned within a
 " tube *y* and provided with collars *z 1 2* to fit therein. The tube *y* is inserted
 " tightly in the casting *3* in which the cylinders *a b* are formed and is provided
 " with ports communicating with the parts into which the passage *p* is divided 5
 " and with ports communicating with the parts into which the passage *m* is
 " divided. The plug *x* which is shown detached with the back-pressure-
 " valves *v w* carried by it in Fig. 14 is secured against longitudinal movement
 " in the casting *3* by being provided at one end with a flange *4* and at the
 " other end with a nut *5* which by means of a washer *6* presses a collar *7* 10
 " against the said casting *3*.



" The collar *7* also serves as a guide for the upper end of a rod *8* which is
 " provided with teeth so as to engage with a pinion *9* formed upon the plug *x* so
 " that the rod *8* forms a means of turning the plug *x*. The rod *8* is connected to
 " a hand-lever *10* capable of being turned upon a suitable pivot *11* secured in the 15
 " hammer-framework. The hand-lever *10* is provided with a catch or detent *12*

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- “capable of being placed in engagement with or disengaged from notches in a
 “sector 13 capable of being turned about the pivot 11 and connected
 “by means of a rod 14 with a treadle 15 raised after depression by
 “means of a spring 16 and secured at its ends to a rod 17 capable
 5 “of being oscillated in bearings provided upon the bed-plate of the power-
 “hammer. When the catch or detent 12 is disengaged from the sector 13
 “the hand-lever 10 may be moved independently of the treadle 15 and spring 16.
 “The back-pressure-valves *v w* and the channel *u* in the portion of the plug *x*
 “forming the valve *t* employed to partially or entirely close the passage *p* when
 10 “the top or hammer-head *j* connected to the piston *h* by the rod 18 is required
 “to work are disposed in relation to one another in the manner indicated by
 “Figs. 10, 12, 14, 15, 16, 17, and 18.



- “When the plug *x* is in the position in which it is indicated in Figs. 10 and 15
 “the passage *p* is fully open, the top or hammer-head *j* or other corresponding
 15 “part then remaining unmoved by the movement of the piston *c*. When the
 “valve *t* is in position to completely close the passage *p* as is indicated in Fig. 16
 “the passage *m* is fully open and the top or hammer-head *j* or other
 “corresponding part is moved to the fullest extent possible by the movement of
 “the piston *c*. When the plug *x* is in the position in which it is indicated in Fig. 17
 20 “the back-pressure-valve *w* allows air to pass from the lower part of the pump-
 “cylinder *a* to the lower part of the hammer-cylinder *b* but prevents air from
 “passing from the lower part of the hammer-cylinder *b* to the lower part of the

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"pump-cylinder *a* while the back-pressure-valve *v* allows air to pass from the
 "upper part of the pump-cylinder *a* or the upper part of the hammer-cylinder *b*
 "to the lower part of the pump-cylinder *a* but prevents air from passing to the
 "upper part of the pump-cylinder *a* or the upper part of the hammer-cylinder *b*
 "and consequently the downward movements of the piston *c* force air into the 5
 "lower part of the hammer-cylinder *b* while the upward movements of the
 "piston *c* will chiefly force air from the upper part of the pump-cylinder *a* into
 "the lower part thereof, so that the tup or hammer-head *j* or other corresponding
 "part will be raised and held away from the anvil 19. When the plug *x* is in
 "the position in which it is indicated in Fig. 18 the back-pressure valve *w* 10
 "allows air to pass from the lower part of the hammer-cylinder *b* to the lower
 "part of the pump-cylinder *a* but prevents air from being forced from the lower
 "part of the pump-cylinder *a* into the lower part of the hammer-cylinder *b*
 "while the back-pressure-valve *v* allows air to pass from the lower part of the
 "pump-cylinder *a* to the upper part thereof but prevents air from passing from 15
 "the upper part of the pump-cylinder *a* to the lower part thereof, and con-
 "sequently the air below the piston *h* in the hammer-cylinder *b* is rarefied so
 "that there is always an excess of pressure on the upper side of the piston *h*
 "holding the tup or hammer-head *j* or other corresponding part down upon
 "the anvil 19 or any object which may be placed thereon. . . . 20

"If at any time it is requisite to cause the tup or hammer-head or other
 "corresponding part which may be used in the hammer illustrated in Figs. 7 to
 "18 to strike a single blow and then remain at rest this may be done by removing
 "the plug *x* quickly from the position in which it is indicated in Fig. 17 more
 "or less towards or into the position in which it is indicated in Fig. 16 accord- 25
 "ing to the force of the blow intended to be struck and allowing it to remain in
 "such position during one complete to and fro movement of the piston *c* and
 "then quickly returning it to the position in which it is indicated in Fig. 17.
 "It is obvious that these movements of the plug *x* must be accomplished with
 "some precision in relation to the movements of the piston *c*." 30

The action came on for trial before KEKEWICH, J., on the 14th of April 1904,
T. Terrell, K.C., P. O. Lawrence, K.C., and A. J. Walter (instructed by
Pritchard, Englefield, & Co., agents for *D. L. Sprake*, of Accrington) appeared
 for the Plaintiffs; *Moulton, K.C., Cripps, K.C., and J. W. Gordon* (instructed
 by *Rowcliffes, Rawle & Co.*, agents for *E. Robinson, Walker & Son*, of 35
 Manchester) appeared for the Defendants.

Lawrence, K.C., opened the Plaintiffs' case:—At the date of *Jameson's*
 Patent there were what are known as pneumatic or atmospheric or compressed
 air hammers, as distinguished from steam hammers, but they could not be 40
 controlled by keeping them down at the bottom of the stroke or up at the top
 of the stroke, or by stopping half-way, or in giving light and hard blows. These
 things could be done only by steam hammers. Some hammers were pressed up
 by compressed air and then allowed to fall by withdrawing the air, but the
 blow could not be regulated. There had been no really practicable pneumatic
 hammer. Light blows could only be given by a slight raising of the hammer. 45
Jameson's Patent put pneumatic hammers on the same footing as steam
 hammers. The issue will be whether *Massey's* hammer infringes; it acts
 exactly as the Plaintiffs' hammer and by the same means. Both have two
 cylinders, one for the air and the other for the hammer, and air passages
 between the cylinders controlled by movable valves having the same effect in 50
 each. The Plaintiffs' Patent came before the Court in *Pilkington v. Yeakley*
Vacuum Hammer Company (18 R.P.C. 459), and there was an appeal, but it was
 not proceeded with. A certificate of validity was granted in that case, the main
 question then being that of communication from abroad. The validity of the
 Patent came also before *Farwell, J.*, in *Jameson's Patent* (19 R.P.C. 246), on a 55
 Petition for its Revocation in which the main question was again that of first

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and true inventor. [KEKEWICH, J.—Is it proposed to try the question of validity again?] [Cripps, K.C.—Yes. The parties are different; it is one of the issues, although not the principal issue.]

The only witness called for the Plaintiffs was Mr. *Dugald Clerk*. During the course of his cross-examination certain models of the Defendants' actual hammer were put to him, and *Lawrence*, K.C., referred to the Defendants' affidavit containing their admission, and said that the Plaintiffs had in consequence of it been refused inspection. It was then arranged that Mr. *Dugald Clerk* should have an opportunity of examining the models. After he had done this, he stated that they differed in certain respects from the Drawings in the Defendants' Specification. *Lawrence*, K.C., then said that if there were any material difference he should ask that the Plaintiffs should be held to the Drawings in the Specification. At the end of the Plaintiffs' case the matter came up again for discussion, when KEKEWICH, J., said that the issue of infringement he had to try was whether a hammer made according to *Massey's* Specification would be an infringement of *Jameson's* Patent. Subsequently *Terrell*, K.C., said that the Plaintiffs would accept the working drawings of the machine complained of in the action subject to proof. *Dugald Clerk* was then recalled, and gave evidence that the hammer shown in those drawings operated for holding up and down as in the Defendants' Specification, but that the position of the parts was changed from what it was in the Drawings to that Specification, and that in a hammer according to the working drawings *Jameson's* invention was used; that the hammer was held down by suction—by drawing the air from under the hammer piston by the pump cylinder, with a non-return valve preventing the return of the air; that the hammer was held up by air being forced in beneath it with a similar non-return valve reversed in position, and that there was a vacuum above the hammer when striking light blows.

Moulton, K.C., opened the Defendants' case.—There was no judicial decision in the previous action that the *Yeakley* hammer was an infringement. The first thing is to ascertain the scope of the grant. *Jameson* first claims a particular class of hammer. He has also certain devices for obtaining desirable results, but these are not very novel, so he wisely claims them only as applied to that which is claimed in the first claim, avoiding the danger of claiming them in gross. *Jameson* made appendant claims only for those devices. Such a claim does not extend the grant, because to be an infringement a thing must be within the primary claim. In *British Dynamite Company v. Krebs* (13 R.P.C. 190) the nature of an appendant claim is pointed out. In *Jameson's* Specification, Claims 2, 3, and 4 are limited, so as to be appendant claims, and Claim 5 is for the particular hammer. So that really the question to be considered is whether what the Defendants do is within Claim 1; if so, the question of validity arises. There were obvious reasons why Claims 2, 3, and 4 were limited—for instance, the valve used for holding down is the ordinary non-return compression valve, and that used for holding up is the ordinary valve used for exhaustion. The class of hammer specified in Claim 1 cannot, on any ordinary construction, be held to include the Defendants' hammer. An atmospheric hammer is one in which the hammer is lifted by the pressure of the atmosphere, the pressure from above being, of course, removed. It is of a different class from hammers worked by steam or compressed air. The essentials are the hammer-head fastened to a piston moving in a closed cylinder and, communicating with that cylinder, a suction cylinder where the air is drawn off; there being less pressure, therefore, above the hammer, it is raised. The hammer cylinder and pump cylinder must have closed ends, which are connected. Claim 1 speaks of "the closed ends," for in an atmospheric hammer, one end is effectively an open one. [Claim 1 was read.] There is nothing in that claim except for the words "controlled by one or more valves" and "substantially as herein described,"

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which does not apply to the ordinary atmospheric hammer. Claim 1 includes all that operates in hammering, all that makes unison, but not what makes disunison, between the pump-head and the hammer-head; it does not include the holding up or the holding down. Claims 2, 3, and 4 claim the hammer with the additions enabling the hammer to move in disunison. It was very important 5 that the Patentee should limit himself in his claims to a particular class of hammer, for he has shown no way of applying his devices except to hammers of that class; it might require considerable invention to apply them to compression hammers—such, for instance, as *Manson's* hammer. I shall call evidence to show that further invention was required to make the Plaintiffs' hammer 10 work practically. It has never been made except as a model. The Defendants' hammer is not an atmospheric hammer. It is not sufficient for the Plaintiffs to say that the Defendants have the same results, even if they were secured by the Plaintiffs' methods, for *Jameson* restricted himself to a particular kind of hammer, and only faced that problem. To construe Claim 1 one 15 must look to see what are the valves described in the Specification. In Claim 1 the valve 39 is included; and perhaps a valve which throttles the passage to a certain extent and gives a gentle blow. Then Claim 2 is for a hammer in which there is normal unison, but in which there is a valve which can be moved into a closed position and stop the unison by letting the air come 20 out but not go in, thus holding the hammer up. Claim 3 adds the holding down arrangement. Claim 4 adds a lifting valve arrangement to Claim 1. The Patentee had only a simple problem to deal with, for there was only one passage, and he arranged so that he could introduce into it either a compression or exhaustion valve. The Defendants have something more difficult to deal 25 with. There are two passages, one connecting the upper, and one the lower ends of the hammer and pump cylinders, and also the by-pass connecting the two ends of the pump cylinder. For a light blow the by-pass is opened somewhat, and thus makes a leak from one side of the piston to the other. That was what *Manson* did also. The Defendants improved on *Manson*. 30 Except with regard to Claim 4, the alleged anticipations are only used for the purpose of the usual dilemma. The Defendants hold the hammer up by the pressure of air underneath, not by suction. Claim 2 of *Jameson's* Specification specifies the holding up, but on the broadest interpretation of that claim the Defendants are not within it; in their arrangement the air passes, not from the hammer cylinder to the pump cylinder, but from the pump cylinder to the 35 hammer cylinder for the purpose of holding up. Also the passage at the top is left free, without any valve to control it. The Plaintiffs and the Defendants get the same results, that is, both can hold up and hold down, but by a different application of the elastic fluid and by different mechanism. The Plaintiffs 40 hammer is an atmospheric one, having one-end cylinders connected by one passage, in which the controlling mechanism is placed. The Defendants' is a compression hammer, and the cylinders have closed ends, with one passage controlled and the other not, and a by-pass which has to be controlled. Besides the Patent is invalid for inutility. Further invention was necessary. 45 [*Edison and Swan Electric Light Company v. Holland*, 5 R.P.C. 459, was referred to.] Except for a mere model, the patented invention is not practicable for the hammer which is shown. The large clearances shown are fatal to its working on a practical scale, and invention was required to get rid of them. No hammer has been made according to the Specification, except- 50 ing as a model. Then as to Claim 4. If all pneumatic hammers are included, it was old to put a lifting valve to let out the excess of air, that is, on the assumption that Claim 1 is not limited to the particular class of hammer. If Claim 1 is for the particular hammer controlled by the valves substantially as specified, then Claims 2, 3 and 4 merely emphasise particular parts, and that 55 construction is equally in the Defendants' favour with the other construction.

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The witnesses called on behalf of the Defendants were *J. Swinburne, A. C. Hands*, and Professor *C. V. Boys*.

Moulton, K.C., summed up the Defendants' case.—The real question is the scope of the Patent. In every Claim a particular hammer is claimed; there is
 5 nowhere any claim for a subordinate integer. Claim 1 is only applicable to the simple case the Patentee solved; it is for a specific hammer. "One or more
 "valves" includes 39, which cannot in working be left out in the Plaintiffs' hammer. The specific hammer is characterised by being open-ended, by the
 10 two closed ends being close together, by passages substantially as described, controlled by the valves described, which are well-known valves. There was little invention. As to the state of knowledge, *Manson* was a known hammer, but the Patentee did not deal with that. He did not show how to make that
 hammer hold up or hold down; that would have been a more complicated
 15 problem. The Patentee dealt with a simpler one, but now wants to extend the interpretation of this Claim so that it would cover the problem of applying his invention to *Manson*. The Defendants' hammer does not come within the description in the Specification. A hammer with a by-pass was a known
 hammer. The Plaintiffs are in a dilemma: if *Manson* was within their class of
 20 hammer, no directions were given in the Specification for the necessary change in that hammer; but, if not, then the Defendants are also outside the Patentee's class of hammer. The Defendants do not raise their hammer by suction, but by compression. The Defendants do not use the valve so as to allow the
 passage of air, as stated in Claim 2. As to Claim 5, that is for the whole
 25 particular hammer, and the Defendants have not taken that. Graduation of the blow of the hammer by throttling was old; it was in the *Manson* and the
Parkes hammers. The only new point was making a single-ended hammer hold up or down. As to validity, the Specification, at all events, only gives
 sufficient information to make hammers of the precise type; but a hammer
 30 made according to the Drawings would not work, and none has been made. The *Yeakley* hammer has further special devices.

No reply was called for.

KEKEWICH, J.—There is one question only which really falls for decision, and that is the question whether the Defendants in making and vending
 hammers made according to *Massey's* Specification of 1900, have infringed
 35 *Jameson's* Patent of 1894, the proprietors of which are the Plaintiffs *Peter Pilkington, Ld.* Of course validity is pleaded, and so is novelty, and so is utility, and before going to the other question, it may be right to say a word or two on each of those heads.

As regards validity, as Mr. *Moulton* has put it, the only possible issue
 40 can be whether hammers have been or can be manufactured so as to be of commercial value—so as to work—under this Patent. If, however good it may be on paper, the Patentee has not described a workable instrument—one that may be used for the purposes of trade—then the Patent is useless and must be pronounced invalid. I have Mr. *Dugald Clerk's* statement that he
 45 has seen hammers in work made according to the Specification, and if it is to be said, according to the cross-examination, that all he saw were really hammers made according to *Yeakley's* Specification, then as matters at present stand, there is an injunction against the use of *Yeakley's* Specification, because it is an infringement of the Plaintiffs', and therefore, it is impossible, to say
 50 that hammers made according to *Yeakley* are not also according to *Jameson*. But every one of the exceedingly experienced and useful witnesses, to whom I desire to tender my thanks for assistance in a very troublesome case, Mr. *Dugald Clerk*, Mr. *James Swinburne*, and Professor *Boys*, admits—I am not quite sure that I put it to Professor *Boys*—that a competent workman
 55 could make a hammer with *Jameson's* Specification before him, and the most, as I read their evidence, that they say in detraction, is that it would

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be only a small one. Of course the utility would not be so great if the hammer must needs be small, but it does not prevent its being an article of commerce, and therefore, that objection to the Patent fails.

As regards novelty, though it is pleaded, I have heard no evidence at all. Nobody suggests that the application of air to hammers, which were formerly driven by steam, was not, not long ago, new, and if this particular application by *Jameson* is in itself new, then the question of novelty does not enter into the case at all.

As regards non-utility, that is also pleaded, but I have heard nothing of it. The Defendants themselves are keen to have on the market air-hammers, and all they are fighting is the construction of this particular hammer.

Therefore, we come back to the question of infringement, which necessarily depends—as the other questions might have too—on the construction of the Specification. I have often been puzzled by reading a Specification, I have not only required all the assistance that Counsel could give me to understand it, but I have often failed to understand it at the end. I have had no difficulty with this. This is a Specification drawn, it seems to me, with exemplary precision and clearness. I am speaking of the letterpress more than the Drawings, which of course form part of the Specification, and are somewhat complicated to a layman. But as regards the letterpress, the description is precise, and full, and clear, and leaves to my mind after reading it—though certainly I read it after I knew something about the case—no doubt whatever as to what the Patentee intended. He intended to substitute air as the motive power for steam, which had been found extremely successful in the matter of hammers, and having substituted air for steam as the motive power, he desired to attain those results which had already been attained in steam hammers, and about this he encountered some difficulty. In the first place he could not get rid of steam altogether, because he was obliged to provide a cylinder with a piston which had to be driven, and driven constantly, and he was obliged to provide therefore, steam or other power—naturally in the first place steam power—to drive that piston, and that piston had to be driven constantly so that, whatever was going on, whether the hammer was being used for a strong blow or a light blow, or was not being used at all, it was intended to be used, that is to say that during working hours the piston must be constantly going. That of course was an easy matter enough by connecting the piston with steam power. But with that he had considerable difficulties to encounter. The first was that he did not desire—of course he did not if he was going to construct a working hammer—to have a hammer which constantly and regularly gave severe blows. He wished to be able to moderate his blows, and he aimed at that. Then there was something else he required. He might wish to hold the hammer up entirely, so that it should not work at all while some object was being prepared for use, and again he wished at times to secure that the hammer might be held down. All that he had before him, as I understand it, in the use of the steam hammer. The results, which were very well known, he wished to achieve by means of the use of air instead of steam. He tells us all that in his Specification, clearly noticing everything that required to be done, and referring to the Figures to show how he proposed to do it, that is to say referring to them in illustration of the letterpress. Having described how he effects those objects, having referred to the Figures, to show how the workman is to construct those objects, he then comes to his Claims.

Before otherwise criticising the Claims I think it would be convenient to get rid of one or two points of which a good deal has been made. In the first place the Patentee calls the hammer in the Claims an atmospheric hammer. Earlier in the Specification he calls it an atmospheric or power hammer, and it has been urged that what the Patentee meant was an instrument worked by means of the atmosphere—by the power of the atmosphere—so that he might gain some

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results irrespective of any motive power introduced by himself. I do not so read the Specification. To read it so would be inconsistent with the other Specifications which have been referred to; but that matters not; I think it would be inconsistent with the language of the Specification itself. He has certainly used the word "atmospheric." He has used it in conjunction with "power," but to my mind it is perfectly clear that what he is thinking of from first to last is the substitution of air as a motive power for steam, and that he is not thinking in the least of any natural operation of the atmosphere, though possibly he avails himself of that natural force in one part of his invention.

10 It is an air hammer, however, but I cannot think that by calling it an "atmospheric hammer" he has in the slightest degree damaged his case.

The next point that I want to get rid of is the reference to closed ends. He says in the beginning of Claim 1:—"In an atmospheric hammer arranging the "closed ends." It does not seem to me that the closed ends are a necessary part of his invention, or even of the description of his machine. He assumes that at any rate one end of each cylinder will be closed. Throughout the Specification, as far as I have been able to detect it, he never refers to closed ends at all, or to the fact that any end is closed. I suppose that anyone can find out from the Figures that the higher end in each case was intended to be closed.

20 But he does not bring it forward as a necessary part of his invention. He assumes that the higher end both of the air cylinder and of the hammer cylinder will be closed.

Then there is a much more important point in Claim 1, in which, after referring to the use of the air cylinder and the hammer cylinder, he

25 says:—"So that the hammer-head will work in unison with and will "promptly respond to the movements of the pump piston substantially "as herein described." Mr. *Moulton* made a great deal of that, and he said that in these useful operations of this machine, when the hammer-head is held up or held down by reason of the operation of return valves, the pump piston and the hammer piston are not working in unison at all; they are working in disunion. I am not by any means sure that the difficulty in his position is not illustrated by the words he used. Unison and disunion are not antithetical. Something else is wanted, but I am not supposed to get rid of a point by a mere verbal criticism. Mr. *Moulton* said they are not then working

30 in unison. They are working in unison when the air piston works up and down at a certain pace, and, consequently, by means of the air transmitted or drawn from the pump cylinder, the hammer also works up and down, and so regularity of stroke ensues. That, he said, is in unison. But directly you introduce the valves, and so prevent the return of the air one way or the other, and produce

40 either the holding up or the holding down, then you have what you may call disunion. Now, to my mind, that is entirely fallacious criticism. In the first place, I think the Patentee used the words "in unison" without, perhaps, thinking exactly what they meant. In the ordinary sense "unison" refers to a number of voices all singing the same note, but, of course, we are not now

45 dealing with anything of that kind. When voices do not sing in unison—that is to say, when they do not all sing the same note—they sing different notes so arranged according to musical science that they produce harmony, and it seems to me that that is what the Patentee here intended—not that they were doing the same thing, which they never were, but that they were doing different

50 things which produced harmony, and that is exactly what, though perhaps by a inapt word, he has here described. By introducing the valves you check the action of one side or the other; you introduce a new form of action, with the result that the movement in the air cylinder and the movement in the pump cylinder are harmonious, though with that check which I have referred to;

55 and to say that they are in disunion, when one is really working upon the other with the intervention of a third instrument, seems to me to be false criticism.

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Having disposed of that, I will take the Claims. I will say very little about Claim 1 by itself because it refers, of course, to the preceding letterpress and the Figures, and it directly claims a hammer such as is there described—a hammer which is worked by air through the two cylinders, the pump cylinder and the hammer cylinder with the assistance of one or more valves to regulate the action, a hammer which will secure light blows or heavy blows as desired, and which will enable the operator to hold up or hold down the hammer at will. He ends up by saying that this hammer, which he claims, is “substantially as herein described.” It seems to me that that is a Claim for a specific hammer. I do not see how the Patentee could possibly get out of that. Mr. Moulton has again and again said that the other hammers to which he has referred—*Manson’s*, for instance—do not come within the class. There is no class within which any other hammer can fall. *Jameson* has invented, described, and patented a particular hammer, not a hammer of a class, not a class of hammer, but a particular hammer; and on the construction of the Specification it seems to me he must stand or fall by that. If anyone else has made another hammer substantially like his, then that other person must be restrained. If there is some other hammer it is no excuse to say it is not of the class; the proper excuse is that it is not that hammer. Then we come on to Claims 2, 3, and 4. As regards those I expressed an opinion earlier in the case which was practically adopted by both sides that they really add nothing, and I venture to adopt a passage from Lord Cairns’ Judgment in the *British Dynamite Company v. Krebs*, which was read to me by Mr. Moulton. There the Patentee invented dynamite by means of the special use of nitro-glycerine, and then he went on in his Claim to claim means of ignition, and the great advantage of dynamite was that it could be ignited in a particular way. Lord Cairns said of that:—“He does not, as it seems to me, claim the means of explosion in gross, but only as appendant to dynamite, and he would not be allowed under this Patent to claim them for any other purpose. In other words, he claims in the first Claim the dynamite, the substance itself; and in the second Claim the only mode of using the dynamite with which he was at the time acquainted. It is possible that having stated the means by which the dynamite could be exploded, he might have omitted his second Claim, and contented himself with the first; but the second being, as it seems to me, merely a Claim to the user of that which is included in the first, I cannot think that the Patent should be avoided by the introduction of that which is merely useless.” That it seems to me may be applied here. It is not my duty now to consider whether these other Claims are useless or not, or what precautions influenced the Patentee or his agent in putting in these extra claims; but it is to be observed that each of them begins with an allusion to the atmospheric hammer described in Claim 1 with something else which is also to be found in Claim 1 as I read it at present. But at any rate, it is the atmospheric hammer specified in Claim 1. He says so in Claim 2, in Claim 3, and in Claim 4. Therefore, what I have to consider is Claim 1, and I will reject all the others as useless. They cannot invalidate the Patent. The Patentee might have perhaps wisely left them out; but I am not deciding that. At any rate he has done himself no mischief, because in each case he has claimed the atmospheric hammer specified in Claim 1, and it is that with which I have to deal.

As regards the infringement of that Claim, I have been very much puzzled throughout to understand exactly where *Massey* came in. There is not the slightest doubt that *Massey* produces the same result, but nothing is better settled than that a man cannot come here and say that because another man produces the same result, therefore he has infringed a Patent. Far from it. It is quite open to any other man to attain the same result by different means. The question therefore is has *Massey* attained the same result by different means or not. He has got the air cylinder. He has got the

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hammer cylinder—the hammer piston; they work in the same way. The hammer is held up or is held down and the blow can be moderated at will by the operator. He has two valves. *Jameson* said one or more, and I think it is clear on the evidence that one might have been made to
5 act for the purpose of the two, though two have been found convenient. *Massey* has two. Possibly they may really be included in one, but they are used for the same purpose, that is to say, to prevent air returning one way or the other as is desired. The arrangement of the parts is somewhat different, but that is quite immaterial. He has both ends closed, but,
10 if I am right in my construction of *Jameson's* Specification, that is immaterial so long as you have otherwise the same means producing the same results.

But there is one difference which requires distinct notice, and that is the by-pass. That has given one a great deal of difficulty, because the by-pass
15 did seem to me to be introduced as a different and distinct means of attaining the results which were attained by *Jameson*, and to attain them in a different way. But all difficulty to my mind has been removed this afternoon by the exhibition by Mr. *Walter* of a new model, and by the exceedingly candid evidence of Professor *Boys*. Of course Mr. *Walter* knew, as I did, that
20 Professor *Boys* would not go one jot beyond what he was bound to say if the case was put plainly to him, and this confidence was not misplaced. The result is this. The by-pass is a convenient way of making *Jameson's* invention workable where you have both ends of the cylinders closed. You can work it without, but not so well. The by-pass is introduced only for that purpose.
25 Being introduced for that purpose you have *Jameson's* Patent *plus* the by-pass, and the by-pass makes *Jameson's* Patent useful in that particular connection. That is the result of the evidence, and it seems to me to be conclusive. It is impossible, if that is the right view, to say that *Massey* has invented anything new within the meaning of novelty according to Patent Law.
30 Let me use a hypothetical illustration which has just occurred to me off-hand and I am not capable of putting into more detailed form. A man invents a hammerless gun. I am taking a case of course which is perfectly impossible; hammerless guns are very well known. A man invents a hammerless gun. Another man conceives the notion that the hammerless gun would be very
35 much better if it had a single trigger instead of two triggers, so he works that out and he perfects the invention for a single trigger. I am talking of course of things which are very well known. But in order to perfect his single trigger gun he takes the former Patentee's hammerless gun and he says, perhaps with some indignation: "I am not to be prevented from using
40 "my invention, a very valuable one of a single trigger, because, in order to "make that useful, I apply it to my rival's hammerless gun." He may be indignant, but he is wrong. He cannot take the former invention and apply it to his own, however great the improvement may be, however great the merit may be; and that is the case here. It seems to me that *Massey*
45 cannot be allowed to take *Jameson's* invention, put to it the by-pass and say, "Now I can work that with closed ends and I can work it very much better "by means of the by-pass than *Jameson* could in his manner." If that is the right view, as it seems to me it is, *Massey* must be held to have infringed, and there is an end of the case.
50 This is a case, no doubt, of very great importance, and I have no doubt it will be heard of elsewhere. I think I ought, therefore, to say that, if the Court of Appeal should differ from me on the question of infringement, and should refuse the Plaintiffs relief, I desire to express my opinion that in no event ought any of the Particulars of Objection to be allowed, because
55 non-infringement is pleaded, and in my view all the Particulars of Objection are perfectly useless.

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Terrell, K.C.—Then there will be an Injunction with an inquiry as to damages, a Certificate that the Particulars of Breaches have been proved, and delivery up, and costs as between solicitor and client.

KEKEWICH, J.—Yes.

Moulton, K.C.—I ask for a stay. We shall, of course, Appeal promptly. 5

KEKEWICH, J.—You must not manufacture or sell. I will stay the delivery up, but—I have held it before and I do not know that anybody has differed from me—I cannot see that a man who is doing what is wrong is entitled to say that he should be allowed to continue to do what is wrong because he proposes hereafter to show that he is not doing wrong. There will be payment of the costs 10 and the usual undertaking.

Moulton, K.C.—With regard to costs; this issue has never come up before.

KEKEWICH, J.—There is a Certificate. Though the Certificate was granted by myself, I am not going to enquire why I gave it; I am not going behind it.

Moulton, K.C.—In the case of *Otto v. Steel* (3 R.C.P., p. 120) Mr. Justice 15 *Pearson* refused to give solicitor and client costs, because the particular issue with which he had to deal had not come up in the previous case.

KEKEWICH, J.—As far as I am concerned, I really cannot allow this to be argued. There is a Certificate on the question of validity, and it has to be applied. If I am wrong, you must get it put right elsewhere. 20

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE WARRINGTON.

May 4th and 5th, 1904.

E. M. BOWDEN'S PATENTS SYNDICATE, LD. v. HERBERT SMITH & CO.

Patent.—*Action for Infringement.*—*Plaintiffs held not to be the legal owners 25 of the Patent at the commencement of the Action.*—*Equitable owners of Patent not entitled to sue alone.*—*Leave to amend.*—*Patents, &c. Act, 1883, section 13.*

B., having made an application for Letters Patent, and obtained provisional protection for his invention, before the grant of the Patent assigned the protection and the sole and exclusive benefit of it to a Company. After the Patent had 30

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been granted to B., the Company commenced an action for infringement, alleging the sale of infringing articles by the Defendants prior to the date of the writ. The Company subsequently obtained an assignment of the Patent, and were registered as assignees. On the action coming on for trial, the
 5 Defendants objected that the legal owners of the Patent at the date of the writ, namely B.'s executors, ought to be joined. The Company alleged that they were such owners, and, in the alternative, that it was not necessary to make such owners parties.

Held, that the assignment before the grant of the Patent did not pass the
 10 legal interest in the Patent, and that the legal owners at the date of the writ were necessary parties. Leave to amend was given on terms.

On the 14th of June 1897, *Ernest Monnington Bowden* made an Application for Letters Patent (No. 14,402 of 1897) for an invention of "Improvements in " and relating to brakes for velocipedes and other road vehicles."

15 By a Deed dated the 17th of December 1897, and made between *E. M. Bowden* of the one part and *E. M. Bowden's Patents Syndicate, Ltd.*, of the other part, after recitals referring to certain Patents and to the above-mentioned Application *Bowden* assigned to the Company absolutely (*inter alia*) all that and those said Letters Patent and other protection, described, mentioned or referred to, in the
 20 first schedule for the sole and exclusive benefit thereof and of all extensions and improvements thereof, and also all rights, powers, emoluments and advantages whatsoever under or in respect of the said Letters Patent and other the premises or any part thereof subject nevertheless to the royalty and percentage therein mentioned.

25 The Complete Specification was accepted on the 14th of May 1898, and on the 26th of July 1898 Letters Patent were granted as of the 14th of June 1897, the date of the application for the Patent.

On the 2nd of July 1903, *E. M. Bowden's Patents Syndicate, Ltd.* and the *Bowden Brake Company, Ltd.*, commenced an action against *Herbert Smith &*
 30 *Company* for infringement of the Patent and also of Letters Patent, No. 16,819 of 1899, granted to *John Dring* and *Thomas Leigh Mitchelmore* which were also for improvements in brakes, in which action the usual relief was claimed. At the trial, however, the Plaintiffs gave no evidence in respect to the second Patent, and consented to judgment for the Defendants as regards that Patent.

35 The Plaintiffs by their Statement of Claim, delivered on the 24th of November 1903, alleged:—(1) That the Plaintiffs *E. M. Bowden's Patents Syndicate, Ltd.*, were the registered assignees of both the Patents, and that the Plaintiffs the *Bowden Brake Company, Ltd.*, were licensees under the said Letters Patent;
 40 (2) That the Defendants were cycle factors carrying on business at Finsbury Pavement, London, E.C.; (3) That the Patents were valid; (4) That the Defendants had infringed the Patents in the manner and at the time mentioned in the Particulars of Breaches delivered therewith. The Particulars of Breaches alleged:—that in the month of June 1903 the Defendants sold to
 45 *Thomas E. Kilfoy* twenty-four *Bowden* brakes or bicycles which formed the subject-matters of the Patents and thereby infringed each of the claiming clauses of the Specifications of the Patents.

The Defendants by their Defence:—(1) Did not admit that the Plaintiffs *E. M. Bowden's Patents Syndicate, Ltd.*, were the registered assignees of the Patents or either of them, nor did they admit that the Plaintiffs, the *Bowden*
 50 *Brake Company, Ltd.*, were licensees under the Patents or either of them; (2) alleged that they had not infringed the Patents or either of them as alleged, or at all; (3) alleged that the brakes sold to *T. E. Kilfoy* as alleged in the

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Particulars of Breaches were purchased by the Defendants from *Calcott Brothers, Ltd.*, of Coventry, that *Calcott Brothers, Ltd.*, were licensed by the Plaintiffs to manufacture and sell the said brakes, and the Plaintiffs had received royalties from *Calcott Brothers, Ltd.*, in respect of the said brakes ; (4) That both the Patents were invalid upon the grounds set out in the 5 Particulars of Objections delivered therewith. Particulars of Objections to both Patents were delivered, but are not material for the purpose of this report.

The Plaintiffs by their reply :—(1) Joined issue as to Paragraphs 1, 2, and 4 of the Defence, and (2) As to Paragraph 3 the Plaintiffs said that *Calcott Brothers* were not licensed by the Plaintiffs to manufacture and sell brakes 10 made under their Letters Patent, No. 16,819 of 1899, that by an Indenture made the 21st of May 1900, *Calcott Brothers, Ltd.*, were licensed by the Plaintiffs to manufacture and sell brakes under their Letters Patent, 14,402 of 1897, subject to the terms of the said indenture, but it was an express term thereof that the said brakes should only be manufactured or sold by the licensees for or 15 on machines of their own manufacture, and the Defendants were well aware of, and bought the said brakes subject to that condition ; (3) That the brakes sold by the Defendants as set forth in the Particulars of Breaches were sold in breach of the said condition and without any restriction and not for or on machines manufactured by the licensees : (4) Further as to Paragraph 3, the 20 Plaintiffs did not admit that they received any royalties from *Calcott Brothers* in respect of the said brakes ; alternatively, if they did receive any such royalties it was without knowledge that the said brakes had been dealt with otherwise than under the terms of the said Indenture ; the Plaintiffs would refer to the said indenture at the trial for its exact terms ; under the circumstances 25 set forth in Paragraph 2 thereof the Plaintiffs would contend that the Defendants were estopped from denying the validity of the Patent, No. 14,402 of 1897.

By a Deed of the 15th of October 1903, made between the Patentee, *E. M. Bowden* of the one part, and the Plaintiffs, *E. M. Bowden's Patents Syndicate, Ltd.*, of the other part, after reciting the grant of Letters Patent, No. 14,402 of 1897, and of another Patent, and that by virtue of the agreement of the 17th of December 1897 the Plaintiffs were entitled to such inventions and Letters Patent, and had called upon the Patentee to assign the same accordingly, the Patentee assigned the thereinbefore recited 35 inventions and Patents to the Plaintiffs, *E. M. Bowden's Patents Syndicate, Ltd.* The Plaintiffs, *E. M. Bowden's Patents Syndicate, Ltd.*, were on the 11th of November 1903, registered as assignees of the Patent. A certified copy of the Register dated the 6th of April 1904, after stating the grant of the Patent, No. 14,402 of 1897, dated the 14th of June 1897, on the 26th of July 1898, and the payment of renewal fees contained the following 40 entry :—"11th November 1903 :—By request received and filed, *E. M. Bowden's Patents Syndicate, Ltd.* of 24, Holborn, London, registered as assignees, "assignment *Bowden* to the said assignees produced and copy thereof filed." The action came on for trial before WARRINGTON, J., on the 4th of May 45 1904.

Moulton, K.C., *T. Terrell*, K.C., and *E. F. Lever* (instructed by *A. Withers*) appeared for the Plaintiffs ; *A. J. Walter* and *Sinclair* (instructed by *Phillips and Boyle*) appeared for the Defendants ; *R. Frost* held a watching brief for other persons.

Moulton, K.C., opened the Plaintiffs' case, and in the course of the opening *Walter* stated that the Plaintiffs' title was not admitted, and *T. E. Kilfoy* and another witness were called. On May the 5th, *Terrell*, K.C., proceeded to put in evidence of the title of the Plaintiffs, *E. M. Bowden's Patents Syndicate, Ltd.*, and the Agreement of the 17th of December, 1903, and the Assignment of the 55 15th of October 1903, were produced.

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Walter objected that there was no title shown in the Plaintiffs at the date of the writ, and as to amendment referred to *Nobel's Explosives Company v. Jones* (42 L.T. N.S. 754).

- Terrell, K.C.*, on the point as to title.—The Agreement of the 17th of December, 1897, was an actual assignment of all the rights of *Bowden* given by the Application. The first Plaintiffs are therefore the legal owners of all the rights of the Patentee. The Patent dates back to the date of application, Patents, &c. Act, 1883, section 13. The proviso to that section that no proceedings shall be taken in respect of an infringement committed before the publication of the Complete Specification points to such proceedings being proper except for the proviso. The grant in the Patent is to *Bowden* and his assigns, and the Plaintiffs are such assigns. It is not necessary for the assignee to be registered before suing. The Register is only *prima facie* evidence, Patents, &c. Act, 1883, section 23, subsection 2. [WARRINGTON, J., referred to *Chollet v. Hoffman*, 7 E. & B. p. 686, and *Frost on Patents* Second Edition 365.] The Defendants cannot be liable to two parties; if sued by the Patentee the action would fail on proof of his assignment to the Plaintiffs. If the proper parties are not before the Court, I ask for leave to amend. As to the Patent of 1899, I offer no evidence and consent to judgment for the Defendants on that Patent.
- Walter*, for the Defendants.—The document of the 17th of December 1897 is not an assignment, but only an agreement to assign. The Plaintiffs could not under it be registered as assignees. I produce a certified copy of the Register, showing an assignment of the 15th of October 1903. An equitable assignee of a Patent cannot sue alone for infringement. There is no direct authority on that point, but an exclusive licensee cannot sue (*Heap v. Hartley*, 6 R.P.C. 495). The Patent could only be granted to the inventor, although the Plaintiffs might have been joined with him. There was nothing on the Register at the date of the writ to show that the Patentee could not sue, and if the Patentee had sued the Defendants they would have had no answer as regards title unless they had accidentally heard of the Plaintiffs' rights. *Chollet v Hoffman* was decided on the Act of 1852, which was different from that of 1883. If leave is given to the Plaintiffs to amend, I ask for leave to amend also, and for the costs of yesterday and to-day and those thrown away, and also for the costs of the Particulars of Objections as regards the Patent of 1899 as though certified.
- Terrell, K.C.*, in reply.—In *Action Gesellschaft fur Cartonnagen Industrie v. Temler* (16 R.P.C., 447), an application for an interlocutory injunction, the Plaintiffs only proved an equitable title. Here, however, the Plaintiffs have a legal title, which they could have registered. If the Patent had been actually sealed before the date of the Agreement that document would have made the Plaintiffs legal owners of the Patent, and under the Act the grant dates back. *Renard v. Levinstein* (2 H. & M., 628), was also referred to.

Walter referred to *Morris's Patent Conveyancing*, p. 24.

- WARRINGTON, J.—This question, I confess, has caused me some considerable embarrassment. The facts are these. The Plaintiffs in their Statement of Claim, allege that the Plaintiffs, *E. M. Bowden's Patents Syndicate, Ltd.*, are the registered assignees—I call particular attention to that—of Letters Patent numbered 14,402 of 1897, granted to *Ernest Monnington Bowden*. I need not trouble about the other Patent. At the date when the writ was issued, the 2nd of July 1903, the position of things was this. On the 14th of June 1897, *Ernest Monnington Bowden* had applied for the Letters Patent in question, and by a Deed dated the 17th of December 1897, made between *Bowden* of the one part, and the Plaintiffs, *E. M. Bowden's Patents Syndicate, Ltd.*, of the other part, *Bowden* assigned “unto the Company “all that the said invention”—that is, the invention which has been referred to in the recitals—“and also all that and those the said Letters Patent and other “protection described, mentioned, or referred to in the first schedule, for the

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"sole and exclusive benefit thereof, and of all extensions and improvements thereof, and also all rights, powers, emoluments, and advantages whatsoever, under or in respect of the said Letters Patent, and other premises or any part thereof, subject nevertheless to the royalty and percentage herein mentioned." Then the Deed said: "To hold, use, exercise, and enjoy the said invention, Letters Patent, and premises unto and by the Company, their successors and assigns absolutely." The Patent was subsequently granted to *Bowden*, and in accordance with the provisions of Section 13 of the Act of 1883, it was dated the 14th of June 1897, the date of the Application. This action was commenced, as I have already said, on the 2nd of July 1903. Now at that time the only entry on the Register was the entry of *Bowden* himself as the owner of the Patent. It is certain, therefore, that whatever else may be in doubt, at the date when they issued the writ, the Plaintiffs, *E. M. Bowden's Patents Syndicate, Ltd.*, were not the registered assignees of the Letters Patent. Subsequently to the issue of the writ, namely, on the 13th of October 1903, a Deed was executed, made between *Bowden*, of the one part, and the Plaintiffs of the other part, which, after reciting that the assignor was the inventor of "Certain improvements in and relating to brakes for velocipedes and other road vehicles, and has obtained Letters Patent in respect thereof numbered 14,402"—those are the Letters Patent in question, and dated 14th of June 1897, and also certain other Letters Patent, then goes on to say: "And whereas, by virtue of an agreement, dated the 17th day of December 1897, made between the assignor, of the one part, and the Company of the other part, the Company is entitled to such inventions and Letters Patent, and has called upon the assignor to assign the same accordingly." Then in consideration of the premises: "The assignor, as beneficial owner, hereby assigns unto the Company all those hereinbefore recited inventions, and the Letters Patent granted in respect thereof, and the full benefit thereof, and all rights, powers, privileges, and emoluments connected therewith, including a right to apply for the extensions of the terms granted by the said Letters Patent respectively, to hold the same unto the Company absolutely."

In that state of things the question which arises is, whether at the date of the issue of the writ the present Plaintiffs were entitled to maintain this action against the Defendants, the action being, as I ought to have mentioned, for infringement of the Patent, and whether they were entitled to maintain the action without having *Bowden* as a party either Plaintiff or Defendant? In the first place, were the Plaintiffs, *E. M. Bowden's Patents Syndicate, Ltd.* at the date of the issue of the writ legal assignees of this Patent or not? If they were the legal assignees, then the question which, judging from a passage which I see in Mr. *Frost's* book is at present undecided, would arise, namely, whether they are entitled to sue before registration? If they were not the legal assignees the question does not arise.

The first question I have to decide therefore is, were the Syndicate at the date of the writ legal assignees of the Patent? It has been contended by Mr. *Terrell* that they were, and the way in which he puts it this. He says, that the assignment was an assignment of the rights granted or acquired by the Application for the Patent. Amongst those rights was a right to have the Patent, when granted, dated back to a date anterior to the assignment, and that, when granted, the Patent itself passed by the assignment of the protection. In my opinion that is not the true view of this Deed. In my opinion, although the words of the Assignment are: "An assignment of the protection," whatever that may mean, what the deed really amounts to is an assignment of such beneficial rights as the fact of the protection, when perfected by the granting of the Letters Patent, may confer on the person who has made the Application. I think it is really in law nothing more than a right granted to the assignee to call upon the Patentee when the Patent is granted to assign

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that Patent to the assignee. I cannot satisfy myself, notwithstanding the ingenious way in which Mr. *Terrell* has put the case to me, that this amounts to an assignment of the Patent, or that it would have been competent to the assignee to have it entered on the Register as such an assignment. I hold therefore that the Plaintiffs, *E. M. Bowden's Patents Syndicate, Ltd.*, at the date of the commencement of the action were equitable assignees and not legal assignees of the Patent.

That being so, are they entitled to sue for the protection of that of which they are the equitable assignees, without joining the person in whom, upon the Register, the Patent is vested? No authority, directly in point, has been cited to me on either side. I confess I am rather surprised. I should have thought it would have been a point which would have constantly arisen, and which ought to have been decided, so that there might be no further doubt about it; but no authority has been cited. One case has been referred to in which the Plaintiffs were equitable assignees. I am alluding to the case, in 16 Reports of Patent Cases, before Mr. Justice *Stirling*. But as I understand that case, to begin with it was an application for an interlocutory injunction, and I can quite understand that in such a case as that, even if it had been necessary ultimately to amend the writ, it may have been that the learned Judge would have entertained an application for an interlocutory injunction, because it sometimes happens (in fact, very often happens) that it is necessary to make an Order at once, possibly without waiting for an amendment. But it is enough for me to say that the case is no authority at all upon this point, because the point does not seem to have been raised or discussed. The decision of the learned Judge was on a different point altogether. I think therefore I am right in saying that no authority has been cited to me on this point.

What is the general rule of the Court with regard to an action brought by an equitable owner of property? The common case, with which we are most familiar, is an action relating to a debt in respect of which the provisions of the Judicature Act, which allow an assignee to bring an action in his own name without joining the assignor, have not been complied with; in that case, unless I am much mistaken, the well accepted practice of this Court is that the legal owner of the property in question must be a party to the action, either plaintiff or defendant. He is the proper person to bring the action. If he does not bring the action, then the course which the plaintiff adopts is that of making him a defendant. But the practice of the Court, as I understand it, is that the legal owner of the property must be before the Court somehow in order that he may be bound. Applying that to the present case and holding, as I do, that the Agreement of December 1897 is not a legal, but an equitable assignment of the Patent, the conclusion I come to is, that it is necessary, in order to enable these Plaintiffs to maintain this action, to have the legal owner of the Patent before the Court.

Bowden is dead and I understand that at present his will has not been proved. The present legal owners of the Patent are the assignees under the Deed of October 1903, but the legal owners of the Patent at the date of the issue of the writ would be either *Bowden*, if he was alive, or his executors. Therefore, it will be necessary, in my opinion, to add the executors of *Bowden* as Plaintiffs in the action. For this purpose it is obvious that the case must stand over in order that they may be added.

I have been asked to allow the amendment and I propose to do so, and the question now arises as to the terms on which this ought to be granted. I think I should be right in allowing the Plaintiffs to amend their writ and Statement of Claim by adding the executors of *Bowden* as Plaintiffs and by making the necessary allegations in the Statement of Claim on terms of allowing the Defendants to amend their Statement of Defence. I think with regard to the costs that the costs of yesterday and to-day, and any costs thrown away by

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reason of the necessity of making the amendment, ought to be the Defendants' costs in any event.

There is one other point to which I must refer, and that arises as to the second Patent. With regard to the second Patent, on my suggestion to Mr. Terrell that he should put in such evidence as he had of his title to the second Patent, he elected to consent to judgment for the Defendants in respect of that Patent. With regard to that the result, when the proper time comes, will of course be that there will be judgment for the Defendants in respect of the claim on that Patent, and the Plaintiffs will have to pay the costs of the action in the ordinary way so far as they relate to that Patent. Mr. Terrell, do you want to have any Order drawn up. 10

Terrell, K.C.—My clients may elect to amend and pay the costs rather than be delayed by an appeal.

WARRINGTON, J.—Quite so. But if any Order is drawn up I do not think I can incorporate into it the Judgment in respect of the second Patent. I will put on record what will be done when Judgment is given in the action, but I do not think I can pronounce Judgment in respect of the second Patent by itself now. 15

Terrell, K.C.—I do not think an Order will be drawn up.

WARRINGTON, J.—Then the matter will stand over.

Walter.—As I understand the terms, there is liberty to the Plaintiffs to make the necessary amendments in the Statement of Claim. 20

WARRINGTON, J.—Yes, and for you to amend your Statement of Defence and Particulars of Objections.

Terrell, K.C.—There is a dispute about Bowden's will, and probate may be a matter of a long period. We propose, therefore, to get an administrator pendente lite. 25

WARRINGTON, J.—If you get an administrator *pendente lite* he will be the legal personal representative.

*Andrew Betts Brown and
Brown Brothers & Co., Ltd. v. John Hastie & Co., Ltd.
Same v. Same.*

IN THE COURT OF SESSION IN SCOTLAND.—OUTER HOUSE.

Before LORD STORMONTH DARLING.

June 17th and December 20th, 1902, and 13th January, 1903.

Before LORD KYLLACHY.

5 October 16th and 23rd, and November 7th and 18th, 1903, and February 25th
26th and 27th, and March 3rd, 9th and 25th, 1904.

ANDREW BETTS BROWN and BROWN BROTHERS & CO., LD. v.
JOHN HASTIE & CO., LD.

SAME v. SAME.

- 10 *Pioneer Patent.—Combination of known mechanical appliances for a new
purpose.—Essence and substance of invention.—Construction of Specification.—
Claim.—Infringement.*

*Steam is admitted to steering engines by a controlling valve, which is shut
when the engine is at rest. Means had long been sought to prevent leakage
15 through the controlling valve when shut. In 1897 a Patent was granted to B.,
the object of which he described as follows:—"To prevent or considerably
"diminish the leakage of steam hereinbefore referred to. For this purpose I
"fit in a passage or casing through which the steam enters the controlling
"valve casing a double-beat valve which has formed or fixed on it oppositely
20 "inclined surfaces which are acted upon by counterpart inclines fitted in
"connection with the controlling valve, so that on the movement of the controlling
"valve it acts through the inclined surfaces to open the double-beat valve and
"admits steam." The Patentee added:—"Instead of the equilibrium valve A"
(the double-beat valve) "any equivalent device may be used. For example, the
25 "inclines may be on the stem of a small valve which opening first admits the
"steam under a larger valve opened by the further motion of the small valve."
He claimed:—"In connection with the valves of steering and like engines, fitting
"in a passage or casing, through which the steam enters the controlling valve
"casing, a double-beat or equivalent valve having opposite inclines acted on by
30 "counterpart inclines moving with the controlling valve, the parts being*

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"arranged and operating substantially as and for the purposes hereinbefore described." The double-beat valve used as a cut-off valve was a well-known mechanical device. It had been applied in continuous engines to work automatically with the distributing valve so as to cut off the steam from the distributing valve casing during a part of each stroke. It had never been 5 applied to the controlling valves of steering engines, nor had the leakiness of these valves been successfully remedied in any other way.

Held, that in construing the Specification it must be considered what, having regard to the state of prior knowledge, was the field open to the inventor; that in the circumstances the Patent was a pioneer Patent; that it was not to be 10 construed as claiming only the double-beat valve actuated by inclined planes sliding on counterpart inclines, but as claiming the application to steering and the like engines, for the purpose of preventing leakage of steam while the engine is not working, of a separate stop valve working in unison with the controlling valve. 15

H. & Co. patented a cut-off valve in which, instead of the direct mechanical action of the controlling valve, they used a steam relay. They claimed their invention had advantages over that of B., but did not patent it as being an improvement on his invention. They claimed:—"A controlling valve for steering 20 engines to which the steam supply is through a cut-off valve which is operated "by exhaust of the steam which normally closes it, and wherein the said "exhaust is controlled as described by a slide or equivalent valve operated from "or by the spindle or lever which actuates the controlling valve."

Held, that this was an infringement of B.'s pioneer Patent.

Infringement.—Damages.—Loss of market.

25

The Pursuers averred that through the Defenders supplying cut-off valves in infringement of their Patent they had lost orders, not only for those valves, but for the steering engines of which they formed part.

Held, that this was an element to be taken into consideration in fixing damages. 30

Process.—Record.—Note of Particulars.—Amendment.

When in a Patent action it is desired to refer to prior Patents for the sake of proving the state of prior knowledge these Patents must be specified on record, but amendment of record by the specification of additional Patents will be allowed even during proof in terms of the Court of Session Act (Scotland), 35 1868, section 29.

The Pursuers in these actions were Andrew Betts Brown, of Rosebank Iron Works, Edinburgh, and Brown Brothers & Co., Ltd., carrying on business as engineers at the same works. The Defenders were John Hastie & Co., Ltd., Kilblain Engine Works, Nielson Street, Greenock. The litigation arose 40

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regarding certain Patents for improvements in the controlling valves of steering engines. In large ships the steering is done by an engine, which is only at work when the helm is being moved to port or starboard, while at other times the steam is cut off from this engine. The regulation of the admission of steam to the steering engine is effected by means of a controlling valve. When the controlling valve is in its middle position the steam is cut off from the steering engine. When the steersman moves the wheel to port he moves the controlling valve, which is in connection with the wheel, and opens the ports of the valve, so that steam is admitted, and the steering engine is set working so as to move the helm to port. When the wheel is moved to starboard another set of ports are opened by the controlling valve, the steam passes through the steering engine in the opposite direction, and the helm is moved to starboard.

The object of the Patents, which were the subject of the present dispute, was to prevent leakage through the controlling valve while the engine is at rest. This valve is a very leaky one for two reasons: first, it must be easily moveable by the steersman, and must, therefore, be made slack; and, second, it must be sensitive, so that the engine is set working by the least motion of the wheel, and, therefore, no overlap can be allowed at the ports. This leakiness of the controlling valve has long been known, and a remedy for it desired, but the first successful attempt to cure it was that of the Pursuers, who introduced into the steam-casing of the controlling valve a stop or cut-off valve in the form of a tight equilibrium valve (double beat or equivalent valve) in direct mechanical connection with the controlling valve, and working automatically along with it. This was the subject of the Pursuers' Patent, No. 29,773 of 1897, for improvements applicable in connection with the valves of steering and like engines, granted to the Pursuer, *Andrew Betts Brown*, the Complete Specification of which was as follows:—

"My said invention relates to steering and like engines, the distribution valves of which receive steam and exhaust through passages controlled by a valve the position of which determines the direction and extent of motion, and which after each action is automatically brought to its middle or neutral position in any of various well known ways.

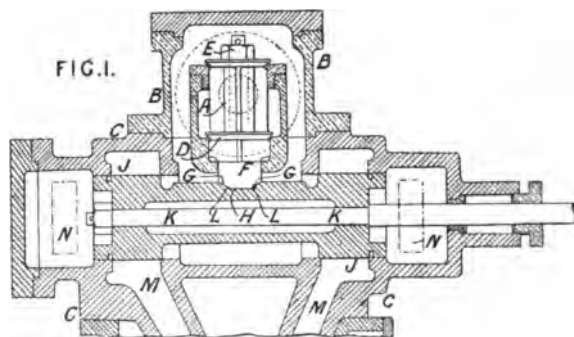
"The controlling valve when of the piston type, is as hitherto arranged constantly subjected to the full steam pressure and considerable leakage is unavoidable when the valve pistons are fitted with sufficient freedom of movement. The object of my invention is to prevent or considerably diminish the leakage of steam hereinbefore referred to; and for this purpose I fit in a passage or casing through which the steam enters the controlling valve casing a double beat valve which has formed or fixed on it oppositely inclined surfaces which are acted on by counterpart inclines fitted in connection with the controlling valve, so that on the movement of the controlling valve it acts through the inclined surfaces to open the double-beat valve and admits steam. My improvements are also applicable to controlling valves of the rotating type. And in order that my said invention and the manner of performing the same may be properly understood I hereunto append three sheets of explanatory drawings to be hereinafter referred to in describing my improvements.

"Figure 1, on Sheet 1, of the drawings is a longitudinal vertical section; and Figure 2, on Sheet 2, a transverse vertical section showing a modification of my improvements as applied to a controlling valve of the piston type. Figure 3, on Sheet 3, is an elevation, and Figure 4 a vertical section showing a modification of my improvements as applied to a controlling valve of the rotating type. In these drawings the same reference letters are used to mark the same or like parts wherever they are repeated.

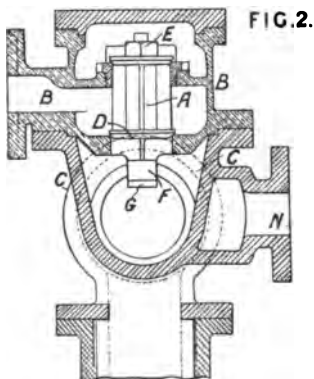
"As shown in Figures 1 and 2, I fit a double-beat valve, A, in a passage or casing, B, through which the steam enters the controlling valve casing, C. The

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“ lower one, D, of the two disks, D, E, of the valve, A, is made a little larger
“ than the other, so that the steam pressure tends to keep the valve closed. The
“ stem or spindle of the double-beat valve, A, has formed or fixed on it a block,
“ F, made with two oppositely inclined surfaces, G; and a part or block, H,
“ moving with the valve pistons, J, fixed on the spindle, K, is made with 5
“ counterpart inclines, L. The parts are arranged with the spindle of the



“ double-beat valve, A, at right angles to the spindle, K, of the controlling valve,
“ J, and when the latter is in its middle position the double-beat valve is closed,
“ as shown, shutting off the steam, and its block, F, is midway between the
“ counterpart inclines, L, of the controlling valve block, H. When the con- 10
“ trolling valve, J, is moved in either direction one or other of the counterpart
“ inclines, L, acts on the block, F, of the double-beat valve, A, and opens that

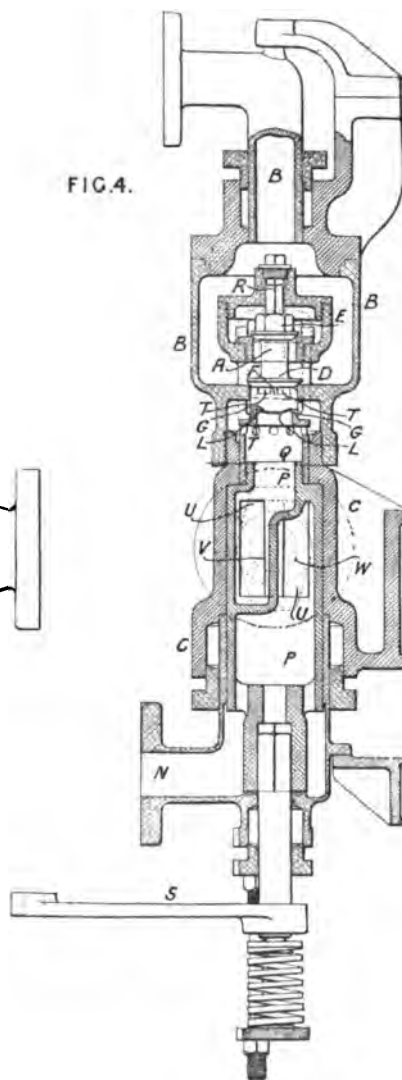
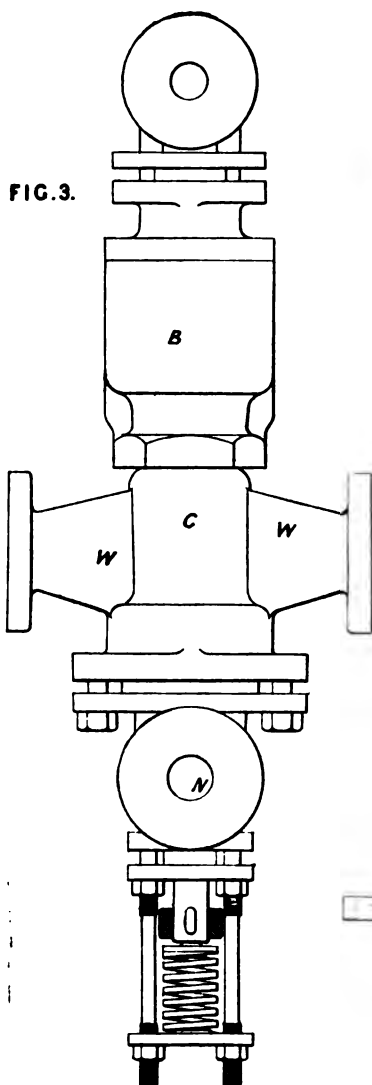


“ valve to admit steam to the controlling valve, which in its turn admits steam
“ to one or other of two passages, M, leading to the distribution valves (not
“ shown). The controlling valve, J, also at the same time puts one or other of 15
“ the passages, M, in communication with the exhaust, N.

“ In the modification shown in Figures 3 and 4, the controlling valve, P, is of
“ the rotating type, and the double-beat valve, A, is fitted in a passage or
“ casing, B, fixed to the top of the controlling valve casing, C. The steam enters

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“ the controlling valve, P, through the casing B. Diametrically opposite pro-
“ jections, F (one of which is shown in Figure 4), each made with two opposite
“ inclines, G, are formed on the underside of the double-beat valve, A, and
“ counterpart inclines, L, are formed on a ring, Q, fixed to the top of the
5 “ controlling valve, P, so as to turn with that valve. The double-beat valve, A,



“ is guided by a squared spindle, R, working in a recess so as not to rotate ; and
“ when the controlling valve, P, is turned in either direction by the lever, S,
“ one or other of each pair of counterpart inclines, L, act on the corresponding
“ inclines, G, on the projections, F, on the double-beat valve, A, thereby opening
10 “ that valve and admitting steam, which passes through holes, T, to the interior

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"of the controlling valve, P. This valve is made in the usual manner with
"two pairs of opposite ports, U, in its circumference and is internally divided
"by a partition, V, one of each pair of ports being shown in Figure 4. The
"turning of the controlling valve, P, puts one or other of either pair of
"ports, U, in communication with one or other of two passages, W, leading 5
"to the distribution valves (not shown), the opposite port of the other pair
"being at the same time put in communication with the exhaust, N. When
"the controlling valve, P, is in its middle position as shown the steam is
"shut off.

"Instead of the equilibrium valve, A, any equivalent device may be used. 10
"For example, the inclines may be on the stem of a small valve which opening
"first admits the steam under a larger valve opened by the further movement
"of the small valve."

The Patentee claimed :—"In connection with the valves of steering and like
"engines, fitting in a passage or casing through which the steam enters the 15
"controlling valve casing, a double-beat or equivalent valve having opposite
"inclines acted on by counterpart inclines moving with the controlling valve,
"the parts being arranged and operating substantially as and for the purposes
"hereinbefore described."

This Patent proved a commercial success, and was fitted to most large steering 20
engines. On the 8th of October 1900, a Patent for "An improvement in controlling
"valves in steering and such like engines" (No. 17,851 of 1900) was granted to
Lewis Boothman and Walter Graham, the former being the draughtsman and
the latter the managing director of the Defenders. In this invention two stop-
valves are used, one of which is opened when the control valve is moved in one 25
direction, and the other when the control valve is moved in the other direction,
while, when it is in its middle position, both are closed. The cut-off valves
used are piston valves, kept in their seats by the pressure of the steam behind
them, and opened mechanically by the motion of the control valve. To render
them easier to open pilot valves were placed on them, which, opening first when 30
the control valve began to move, let the steam through the stop-valves, and
rendered the subsequent opening of the stop-valves themselves easy. The
essential parts for the purpose of this report of the Specification of this Patent
are as follows :—

"A controlling valve for a steering or such like engine is sometimes made of 35
"a partially rotating sometimes of a reciprocating kind, governing two ports by
"the one or other of which steam is admitted to the ordinary slide or other valve
"of the steering engine so as to cause the engine to work in the one direction or
"the other, according as the one or the other port is open. In order to provide
"against constant leakage of steam past such a controlling valve when it is in its 40
"middle position, the steering engine being at rest, we provide a pair of shut-off
"valves which prevent steam from entering the casing of the controlling valve
"when it is in such middle position, the one or other of these valves being
"opened only when the controlling valve is moved to the one side or the other
"of its middle position. We shall describe an arrangement of this kind referring 45
"to the accompanying drawings."

After describing the Drawings, the Patentees claimed :—"1. In combination
"with a partially rotating controlling valve for a steering or such like engine, a
"two-armed lever fixed on the valve spindle, and a pair of shut-off valves so
"arranged that the one or the other valve is open when the controlling valve is 50
"moved from its middle position, substantially as and for the purpose set forth.
"2. In combination with a reciprocating controlling valve a two-armed lever
"fixed on a rocking shaft worked by the controlling valve lever and a pair
"of shut-off valves operated as set forth in the preceding claim, substantially as
"and for the purpose set forth." 55

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On the 24th of April 1900, a Patent for "An improvement in controlling valves for steering and such like engines" (No. 7575 of 1900) was granted to the said *Lewis Boothman* and *Walter Graham*. The invention was identical with that of No. 17,851 of 1900, except that the cut-off valves were actuated somewhat

5 differently from those in that Patent, but still by the mechanical action of the control valve. The nature and object of the invention sufficiently appear from the Provisional Specification, which was as follows:—

"When the controlling valves of steering and such like engines are made in the form of piston slide valves, which, as they are moved, open and close

10 "lateral ports, there is necessarily considerable leakage past their packings unless these are made so tight that the movement of the valve is rendered difficult. It has therefore been proposed to combine with a controlling valve, means of shutting off the steam or other working fluid from the valve case except when the controlling valve is moved so as to open the one or the other

15 "of its ports.

"Our invention relates to an arrangement of this kind, which is as follows: We provide a branch from the steam supply pipe to a cavity at each end of the casing of the controlling valve, these cavities having openings into the middle cavity of the casing closed by check valves. Between the two

20 "oppositely seated check valves, the controlling slide valve, which may be of piston form, closing two sets of lateral ports when it is in middle position, can be moved to and fro. When it is moved in the one direction, say to the right, it unseats the right hand check valve, allowing steam to flow from the right end cavity through ports in the controlling valve to the space left free at

25 "its farther end, whence the steam passes by the left hand lateral port to the engine. When the controlling valve is moved back to its middle position, the check valve that had been opened is closed again by the steam pressure. When the controlling valve is moved to the left a like action takes place, allowing steam to pass through the controlling valve to the right hand port

30 "and thence to the engine.

"In order to facilitate the opening of the check valves at each end of the casing, we prefer to make each of them with a smaller check valve seated in its middle, the stem of this smaller valve projecting a little beyond that of the main check valve. When the controlling valve is moved, it first meets the

35 "stem of the small valve, which it opens, so that steam passes under the main check valve, putting it in equilibrium in respect of pressure, and then the farther movement of the controlling valve opens the main check valve without difficulty."

The Pursuers considered these Patents infringements of their Patent of

40 1897, and on the 14th of May 1902 they raised an action against the Defenders to obtain interdict against such infringement and for damages. This action was defended, one of the grounds of defence being that the Pursuers' Patent was limited to the particular combination which was claimed. "By the Specification and claim of the Pursuers expressly

45 "limiting the invention on which they found to that in which the double-beat or equivalent valve is formed having opposite inclines acted on by counterpart inclines moving with the controlling valve, the inclines form the characteristic feature or the essence of the Pursuers' Patent." The record was closed on the 17th of June 1902 and on the 20th of December 1902 the Lord

50 Ordinary (Lord STORMONTH DARLING) of consent pronounced decree in terms of the conclusion for interdict; and on the 13th of January 1903 interposed authority to minutes of tender and acceptance of the sum of £600 in name of damages.

The next step in the history was the taking out by *Robert Richardson* of a

55 Patent (No. 16,525 of 1902) for "Improvements in or relating to controlling

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"valves of steering engines," which was subsequently acquired by the Defenders. The Provisional and Complete Specifications were lodged on the 25th of July and the 10th of October 1902, and accepted on the 2nd of July 1903. In this Patent the cut-off valve is not directly opened by the control valve. The cut-off valve here is a piston valve kept in its place by the action of a spring. This piston valve is fitted in a small cylindrical casing and is made slightly leaky, so that the steam gets behind it and exerts a pressure on the back of the valve, balancing the pressure on its front. When the control valve is moved, it opens a small slide valve and allows the steam behind the piston valve to escape to exhaust. The steam pressure on the face of the piston valve being now unbalanced overcomes the spring and opens the valve, admitting steam to the casing of the control valve. Put briefly, the principal characteristic of this Patent is that instead of the direct mechanical action of the control valve it uses a steam relay. The essential parts of the Complete Specification are as follows:—

"This invention relates to steam steering engines in which the direction and extent of motion are regulated by a controlling valve which it automatically brought back after each action into its middle or neutral position. The controlling valves in such engines is usually for ease in handling a piston valve which besides being difficult to keep steam tight cannot effectually close the passages to the distributing valves of the steering engines owing to the engines ceasing to operate and therefore ceasing to actuate the controlling valve when these passages are so nearly closed as to supply insufficient steam; and consequently large leakage of steam occurs. For the purpose of overcoming this difficulty a stop valve operated by the controlling valve has been introduced to cut off the steam supply when the controlling valve is in the neutral position, but it also is apt to remain partially open.

"The object of this invention is to ensure that the valve provided for cutting off the steam supply to the controlling valve of steam steering engines shall be opened and kept open when the controlling valve is moved in either direction but shall be effectually closed to prevent leakage of steam when the neutral position of the controlling valve is reached. For that purpose the cut-off valve is so constructed and arranged that it is opened by the steam pressure on exhausting the steam which acts on its opposite face to normally close it such exhaust being effected by the action of the controlling valve on an exhaust valve or valves."

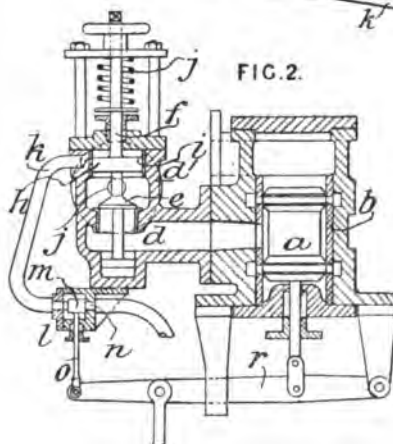
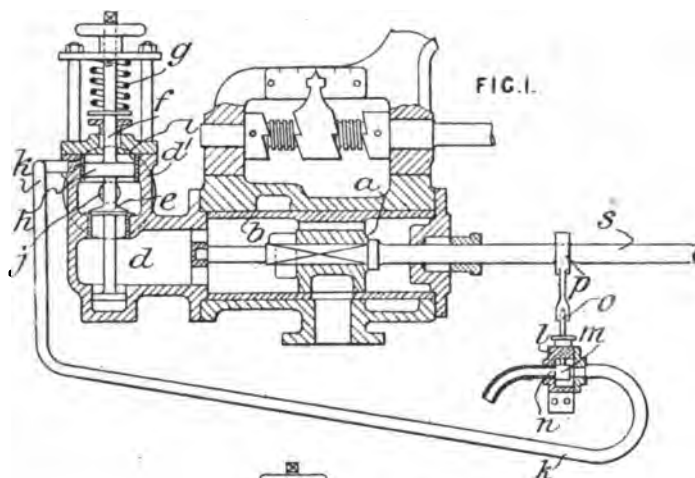
After describing the drawings the Patentee claimed:—"(1) A controlling valve for steering engines wherein a cut-off or stop valve is provided to close off the boiler steam from the casing, and is opened on the movement of the controlling valve from the neutral position by exhaust of steam which normally maintains it in the closed position as described. (2) In a controlling valve for steering engines the combination with a cutting-off or stop valve provided to close off the boiler steam of a piston thereon working in a cylinder having connections to an exhaust valve or valves operated as described by the movement of the controlling valve from the neutral position. (3) A controlling valve for steering engines furnished with a cut-off or stop valve and means for operating it substantially as described with reference to Figure 1 of the annexed drawings. (4) A controlling valve for steering engines furnished with cut-off valves and means for operating them substantially as described with reference to Figure 2 of the annexed drawings."

The last of the Patents in question was No. 10,894 of 1903, granted to the said *Walter Graham* for "Improvements in or relating to controlling valves of steering engines." The Complete Specification was lodged on the 13th of May 1903, and accepted on the 25th of June 1903. In this, as in the last, the cut-off valve used was a piston valve connected with the control valve by a steam relay.

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The Specification was as follows :—

- “ This invention has for its object to simplify and improve the construction
“ and operation of controlling valves of steering engines of the kind described
“ in the Specification of Letters Patent No. 16,525 of 1902, wherein a cut-off
5 “ valve is provided to close off the boiler steam from the casing and is opened
“ on the movement of the controlling valve from the neutral or mid-position by
“ exhaust of the steam which normally maintains it in the closed position. In
“ such controlling valves the exhaust or auxiliary valve which relieves the
“ steam pressure on one side of the cut-off valve is operated mechanically by



- 10 “ the movement of the controlling valve, but according to the present improve-
“ ments the exhaust from the back of the cut-off or stop valve is controlled by a
“ slide valve traversed over an exhaust port and operated from the spindle or
“ lever which actuates the controlling valve, the slide valve being formed with
“ sufficient lap to fully cover the exhaust port and ensure that continuous blow
15 “ of steam cannot occur when the controlling valve after each action fails
“ to reach its neutral position. In the accompanying drawings, which illustrate
“ the invention by way of example, Figure 1 is a longitudinal vertical section of

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"a controlling valve of the Corliss or oscillating type, and Figure 2 is a like
"view of a controlling valve of the piston type as adapted for application with
"vertical steering engines. The controlling valve *a* may be of any ordinary
"type and fitted in the usual casing *b* which is formed with an extension *d*
"containing a seat for the stop or cut-off valve *e*. This valve is fitted on a
"spindle *f* and is maintained on its seat by a spring *g*, while a piston *h* is also
"fitted on the spindle *f* and fits loosely in a liner *i* in the steam casing *d'* formed
"over the extension, the boiler steam inlet being through an opening *j* in the
"casing *d'*. Steam has access to both sides of the piston *h* either through a small
"orifice in it or owing to the piston being a loose fit in the casing; and from
"the upper side of the piston the steam may pass through an outlet pipe *k*
"to a casing *l* fitted with a slide valve *m* which normally covers an outlet
"n therefrom. This slide valve *m* is connected through a rod *o* in the example
"shown at Figure 1 to an eccentric *p* on the rocking spindle *s* of the controlling
"valve *a*, and in that shown at Figure 2 to the controlling valve itself or to the
"lever *r* by which the controlling valve is operated. In the operation of the
"apparatus on actuating the controlling valve spindle or lever the slide valve *m*
"uncovers the outlet *n* so that the boiler steam collected in the casing *d'* above
"the piston *h* escapes and the steam pressure acting on the opposite side of the
"piston raises it and also lifts the cut-off valve *e* thereby admitting steam to the
"controlling valve to operate the steering engines. When the controlling valve,
"owing to the operation of the usual hunting motion, is brought back to the
"neutral position the spindle or lever which operates the said valve also acts to
"move the slide valve *m* over the outlet *n* and shuts off the exhaust whereupon
"the steam enclosed in the casing *d'* closes down the cut-off valve *e*."

The Patentee claimed:—"A controlling valve for steering engines to which
"the steam supply is through a cut-off valve which is operated by exhaust of
"the steam which normally closes it and wherein the said exhaust is controlled
"as described by a slide or equivalent valve operated from or by the spindle or
"lever which actuates the controlling valve."

On the 1st of August 1903, the Pursuers raised an action against the Defenders to
have it declared that these Patents, Nos. 16,525 of 1902, and 10,894 of 1903,
were infringements of their Patent, No. 29,773 of 1897, and to have the
Defenders interdicted from infringing Patent, No. 29,773 of 1897, by making,
selling, or using, during the currency of the said Patent, and without the
consent of the Pursuers, any mechanism constructed in accordance with the
Specifications, Nos. 16,525 of 1902, and 10,894 of 1903, or in a manner substantially
the same; also to have the Defenders ordained to deliver up to the Pursuers all
mechanisms or parts thereof constructed in breach of the Pursuers' Patent; and,
finally, for damages, which were laid at £2,000.

In their condensation the Pursuers set forth the facts above detailed.
They averred:—"The mechanisms described in the Specifications, Nos. 16,525
"of 1902, and 10,894 of 1903, are infringements of the Pursuers' invention.
"They are themselves identical in principle and mode of working, and embody
"the substance of the Pursuers' invention so as to produce the same results, in
"practically the same way, by the substitution of well-known mechanical
"equivalents for certain parts of the Pursuers' mechanism. The substance of
"the Pursuers' invention is the operating of a cut-off valve by the action of the
"controlling valve of the steering engine. Whenever the steersman operates
"the controlling valve to port or starboard the helm, that valve in turn operates
"the cut-off valve, and admits steam to the steering engines. The Pursuers
"achieve the result by the direct action of the spindle of the controlling valve
"upon the end of the cut-off valve, which, for ease of lifting, is made a double-
"beat valve. *Richardson and Graham*, in the said Specification, substitute
"for the double-beat cut-off valve used by the Pursuers a balanced cut-off

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“valve, which is a well-known mechanical equivalent. On the spindle of their cut-off valve there is a piston working on a cylinder. Steam is admitted on both sides of this piston, and so the valve is balanced. This cut-off valve is operated from the controlling valve, through the intervention of a small valve, operated directly by the controlling valve. This small valve, in the case of *Richardson's Patent*, is operated by the thrust of the end of the controlling valve spindle, and, in the case of *Graham's Patent*, by an eccentric or lever working on the spindle of the controlling valve. When this small valve is opened the balance of the cut-off valve is destroyed, and the steam, acting upon the piston, opens the cut-off valve. This method of opening a balanced piston valve is old and well known; the modes of working the small valve from the controlling valve are mechanically the equivalents of those employed by the Pursuers to lift their double-beat valve. The whole combination is a variation of the Pursuers' invention, complicated to produce an appearance of dissimilarity.”

The Defenders answered:—“Denied under reference to the Pursuers' and Defenders' Specifications. The Patent founded on by the Pursuers and the Patent founded on by the Defenders both relate to steering and such like engines, and have the same object in view—viz., to save leakage of steam. This object is aimed at by every designer and maker of steam-engines. The Patent of the Defenders attains this object by different means and upon a different principle from those covered by the Pursuers' Patent. In the mechanism of the Pursuers' Patent the controlling valve of the steering engine is fitted with inclined planes acting directly on corresponding inclines fitted on the stop-valve. When the controlling valve is opened the inclines on it bear upon those of the stop-valve and open it, and when the controlling valve is returned to its neutral position, the inclined planes on it are withdrawn from those on the stop-valve and allow it to close. In the Defenders' construction the stop-valve is placed in the steam-pipe, but instead of being operated by the control valve, it is operated by varying the steam pressure on the top side of the piston attached to the valve spindle. In this way the stop-valve may be absolutely closed when the steering engines are not required to operate, and that independently of the position of the control valve, which may remain more or less open without waste of steam.”

The object of the inventions, the Defenders explained—viz., the prevention of leakage of steam—is a common one in steam engineering, and a steam-saving cut-off valve fitted in the steam way is a well-known device long in use, and is exemplified in the Patent granted to *Davis & Co., Ltd.* and *W. R. G. Hay* (No. 7014 of 1895). They admitted the utility of the Pursuers' invention.

As to damages, the Pursuers averred that machines made by the Defenders in infringement of the Pursuers' Patent had been sold and fitted by them into ships, and in particular into a vessel recently built by Messrs. *Barclay, Curle & Co., Ltd.* The Defenders admitted having sold for certain ships, including this vessel, engines fitted with their Patent. The Pursuers called on them to produce a list of the machines so made or sold by them and of the parties to whom sold. The Pursuers said that, through the Defenders' infringements, they had lost orders for the said patented improvements and for steering engines, which would have been purchased from them had the Defenders not undertaken to fit valves in infringement of the Pursuers' Patent, and that they had thus sustained damage to the extent of £2,000.

The Pursuers pleas were:—“1. The improvements described in the Specifications relative to Letters Patent, Nos. 16,525 of 1902, and 10,894 of 1903, being infringements of the Pursuers' Letters Patent, decree should be pronounced in terms of the declaratory conclusion of the summons. 2. The

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"Defenders, having infringed the said Letters Patent, and being in course of continuing to infringe, interdict should be granted as craved. 3. The said mechanisms, being infringements of the Pursuers' Patent, the Defenders should be ordained to deliver them and all parts thereof to the Pursuers. 4. The Pursuers, having sustained loss and injury through the said infringement, 5 are entitled to damages."

The Defenders pleaded:—"1. No relevant case. 2. The improvements described in the Specifications, relative to Letters Patent, 16,525 of 1902, and 10,894 of 1903, not being infringements of the Pursuers' Letters Patent, decree of declarator ought to be refused. 3. The Defenders, not having infringed the 10 Letters Patent of the Pursuers, interdict ought to be refused. 4. The Pursuers' averments, so far as material, being unfounded in fact, the Defenders ought to be assoilzied with expenses. 5. In any event the damages claimed are excessive."

The case was first put out for adjustment on the 16th of October 1903, and the 15 record was closed on the 23rd of October 1903, when the case was sent to the procedure roll. On the 7th of November 1903, however, this order was discharged, and a proof was appointed to be taken on the 25th of February 1904. On the 18th of November 1903, the LORD ORDINARY granted commission to recover the documents asked for by the Pursuers. The proof was taken on the 25th, 26th, and 20 27th of February 1904. Lord STORMONTH DARLING, before whom the case had been called, being absent, the proof was taken by Lord KYLLACHY.

Counsel for the Pursuers, *Salvesen*, K.C., and *Sandeman* (instructed by *Steedman & Ramage*, W.S.); Counsel for the Defenders, *Ure*, K.C., and *Hunter* (instructed by *Miller & Murray*, S.S.C.). 25

In evidence, the facts above detailed were brought out. The witnesses were substantially in agreement as to the usefulness of the Pursuers' invention, and its novelty when made. In this connection, *Ure*, K.C., produced a number of Specifications, in which mechanism resembling that of the Pursuers had been used to exclude steam from valves at dates prior to that of their invention, and 30 desired to examine the witnesses with regard to these Patents. *Salvesen*, K.C., objected that the Defenders must confine themselves to the Patents specified on record (Patents, &c., Act, 1883, 46 & 47 Vict. c. 57, sec. 29). *Davis'* Patent alone of prior Patents is there mentioned, and this was the only one the Defenders were entitled to bring forward. The object of the Defenders was 35 substantially to prove want of novelty, a plea of which notice should have been given on record.

Ure, K.C., said he was not founding on want of novelty. His object was to show the state of knowledge just before the Pursuers' invention was made, so as to enable the Court to see how small an advance this invention really was. 40 He was willing to amend, if necessary. He had given notice four days previously that these Patents would be produced as provided by Act of Sederunt of 31st May 1902.

Lord KYLLACHY.—*Harrison v. Anderston Foundry Co.* (2 R. 122), and *Neilson v. Househill Co.* (5 D. 1180), decide this point. There must be specification on the record. But there may be amendment under the Court of Session Act. 45

The Defenders then amended their defences by a minute in which they specified the following Patents on which they intended to found—viz., No. 17,512 of 1888 granted to *Fisher and Richardson*, No. 2155 of 1887 granted 50 to *Tickle*, No. 1108 of 1877 granted to *Jones*, and Nos. 270,396 of 1883 and 262,649 of 1882 (U.S.A.) granted to *Cumminsky*. The amendment was admitted, the question of expenses being reserved, and the right to lead evidence in replication with respect to the several Patents and the questions (if any) raised by them was reserved to the Pursuers. 55

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These Patents showed that previous to the Pursuers' invention a cut-off valve similar to theirs had been used to exclude steam from the distributing valves of continuously working engines at the end of the stroke, so as to economise steam, and in another case at its beginning, so as to minimise friction and allow the valve to slide easily. No similar arrangement had been used in steering or the like engines until the Pursuers made their invention. *Davis'* Patent had regard to a steering engine, but the object of that Patent was not to prevent leakage, but to automatically adjust the supply of steam to the resistance to be overcome by the helm, thus economising steam. There was a conflict of evidence as to whether the Defenders' arrangement was better than the Pursuers'. The Pursuers' witnesses said it was simply a more complicated form of their mechanism with the addition of an extra valve, and was inferior to the simpler form. They pointed out that when the valves were open there was a slight blow-through past the piston valve to exhaust. The Defenders' witnesses said their mechanism was quite different from that of the Pursuers, and had the advantage over it that if the hunting gear did not bring back the control valve to a central position, their valve, worked by a steam relay, would nevertheless shut tight, while the Pursuers' cut-off valve, mechanically connected with the control valve and moving with it, must, if the control valve remained partly open, also remain proportionately open, allowing leakage. The principal advantage of a separate cut-off valve is to prevent this leakage when the controlling valve remains partly open.

On the 3rd of March, Counsel for the Pursuers were heard. They contended that the validity of the Pursuers' Patent could not be impugned by the Defenders, as they were barred by their consent to interdict in the former action (*Thomson v. Moore*, 6 R.P.C., 426; *Moore v. Thomson*, 7 R.P.C., 325). Any plea which might have been insisted on in the previous action cannot be brought forward in this second action. In the former action the defence was tabled that the Pursuers' invention was limited to the method disclosed in their Patent, and that the Defenders attained a similar object by a different method. That defence is, therefore, no longer open to them (*Thomson v. Moore*, 6 R.P.C., at p. 441; *Moore v. Thomson*, 7 R.P.C., at p. 334). It was part of the defence in the last action that the construction of the Pursuers' claim limited it to a claim for "counterpart inclines"; that defence can no longer be taken. [Lord KYLLACHY.—Of course they say this present invention is a different one from the last invention.] The real question is whether there has been infringement. This depends on the construction of the Pursuers' Specification (No. 29,773 of 1897). They state that their invention relates to steering and the like engines. This excludes continuous working engines. The object of the invention was the prevention of leakage without affecting the ordinary method of steering. The inventor did three things: he fitted a close valve into the casing; he made it move in unison with the control valve; and he thus prevented leakage when the engine was stopped and the control valve in the middle position. The Specification claims mechanical equivalents for the stop-valve described. In the state of knowledge at the date of the Pursuers' Patent and of the Defenders' Patents (Nos. 7575 and 17,851 of 1900) it was assumed by all engineers that a loose control valve must be used. The tight control valve is an afterthought. The second purpose which the Defenders allege is served by their invention—viz., that the leakage of steam is prevented when the control valve does not return exactly to the middle position—is first hinted at in No. 16,525 of 1902 in the narrative, but is not mentioned there as an object of the invention or in the claim. The subject of this invention is a cut-off valve operated by a steam relay. This is a mere mechanical equivalent for our cut-off valve. The same object is attained by well-known means which would occur to anyone. The Defenders' other Patent (No. 10,894 of 1903) bears to be an improvement on this last, and must be construed along with it. So

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taken, the only object disclosed as the special object of the Patent is the same as that in the Pursuers' Patent. The Defenders mention that their device serves a second purpose, and that it is therefore an improvement, but they do not disclaim the object of preventing leakage in the neutral position, and they do not claim that they use a tight valve. Their invention is, if anything, a mere improvement. They achieve a second object by a modification of our apparatus. They have not invented anything substantially different from our invention. The only distinction is that instead of the control valve being in direct mechanical contact with the stop-valve, it is in indirect steam contact. In both cases the stop-valve is worked by steam pressure. Our valve is balanced by the equilibrium of steam against steam; theirs' by steam against steam, aided by a spring. Their eccentric is equivalent to a lever. In the last action a lever was held to be a contravention. Our Patent is a pioneer Patent. We get by old methods a new result. All our means are admittedly old mechanical devices, but we combine them to obtain a result never got before. The Defenders, by other old methods, obtain the same result. The idea or principle of their machine is the same as that of ours. The following cases may be quoted on the subject of pioneer Patents: *Proctor v. Bennis* (4 R.P.C. 333, 354; L.R. 36 C.D. 740); *Boyd v. Horrocks* (9 R.P.C. 77); *Aktiebolaget Separator v. Dairy Outfit Company* (15 R.P.C. 327); *Consolidated Car Heating Company v. Came* (20 R.P.C. 745; L.R. [1903] A.C. 516). If a Patent merely reaches an old result by a new method, it is difficult to prove that a subsequent Patent is an infringement, but if the idea of the Patent is new, it is more easily infringed. Ours is such a pioneer Patent. The essence of our invention is taken by the Defenders, (*Dudgeon v. Thomson*, L.R. 3 A.C. 34). Any mechanical equivalent is an infringement. A steam relay is no better than a mechanical equivalent for our arrangement (*Automatic Weighing Machine Company v. National Exhibitions Association, Ltd.*, 9 R.P.C. 41). As to the former Patents which were brought forward, they did not prove any want of novelty in ours. The only one relating to steering gear was that of *Davis* (7014 of 1895), but the economy aimed at by it was quite different. *Davis* aimed not at keeping out the steam when the control valve was in the middle position, but at regulating, by means of a governor, the amount admitted while the engine was working. *Cumminsky* (Nos. 270,396 of 1883, and 262,649 of 1882, U.S.A.) had a cut-off valve somewhat similar to ours, but it was used for an entirely different purpose, viz., to control the supply of steam admitted at each stroke to a continuous working engine. It could not have been applied to our purpose. We admit that the separate parts of our mechanism are old. This is simply an example of the use of some of them. As to damages, we are entitled to the profit we would have made, not only on the valves, but the whole steering engines in the cases mentioned on record, for the users would have been compelled to come to us for the engines if the Defenders had not supplied them with valves similar to ours (*United Horse Shoe and Nail Company, Ltd. v. Stewart & Co.* 5 R.P.C. 260; 14 R. 266; 15 R.H.L. 45; L.R. 13 A.C. 401). This profit would have been at least £600.

On the 9th of March, Counsel for the Defenders were heard. They contended that they did not question the validity of the Pursuers' Patent, and accepted their position as being barred from that by the past action of interdict. It is put against the Defenders that they cannot dispute the construction of the Pursuers' Specification in such a way as would have enabled us to succeed in the former action; we do not admit that. *Moore's* case does not go that length. In the prior proceedings nothing was decided as to the construction of the Specification. It was merely decided that such and such a machine was an infringement (*Dudgeon v. Thomson*, L.R. 3 A.C. 34). We admit that a "pioneer Patent" has a wider ambit than another, but not that the Pursuers can bring their Patent under this head.

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We do not challenge *Proctor v Bennis*, but it must be read along with *Curtis v. Platt* (L.R. 3 C.D. 136n). The matter is clearly put in *Cunynghame on Patents*, pp. 299 and 300. Where you have specific mechanism directed to an end previously well known, the doctrine of mechanical equivalents is not applicable (*Gosnell v. Bishop*, 5 R.P.C. 159). [Lord KYLLACHY.—What is meant by the object being previously well known?] It means known and achieved. In the present case it would be incorrect to say the object of the Pursuers' invention was to prevent leakage through a slack valve. The real object was to keep the steam out of the steam casing; why this was desired was immaterial. There might be a number of reasons—viz. (1), because the control valve leaked; (2), because enough steam had already been admitted to do the work of the engine; (3), because the steam, if admitted, impeded the action of the control valve, *z.g.*, owing to friction in slide-valves; (4), because the control valve might be left partially open. When the Pursuers' invention was made it was well known that in these steering engines steam ought to be kept out of the casing, and also that this was to be done by means of a stop-valve. All that was left to inventors was the method of actuating this stop-valve. There were many previous similar inventions. The first was that of *Jones* (No. 1108 of 1877). His object was to exclude the steam from the control-valve casing as soon as enough had been admitted to do by its expansion the work necessary for a stroke of the engine. He used a cut-off valve actuated by a cam with a cut-off edge. His Patent was for his method of actuating it. Then came *Tickle's* Patent (No. 2155 of 1887). His object was similar to that of *Jones*, but he used a double-beat valve like that employed by the Pursuers. *Cumminsky* followed with Patents 262,649 of 1882 and 270,396 of 1883 U.S.A. His object was to prevent friction in the distributing valve, so he kept steam out of its casing while it performed its motion. His cut-off valve was a double-beat valve actuated by inclined planes on the valve-lifter and a roller fixed on the valve itself and moving along the planes. This valve-lifter was linked by a connecting rod to the rod actuating the distributing valve, so that the distributing and cut-off valves acted in unison. This was the state of knowledge when the Pursuers' Patent was taken out. All that was left then was to invent some better method of actuating the cut-off valve, and to time its action differently, so that, instead of moving with every stroke of the engine, it should move only when the control valve was opened or shut. This was what *Brown* did. [Lord KYLLACHY.—You treat these prior Patents simply as helping us to construe *Brown's* claim.] Precisely. *Brown* has a reciprocating rod moving his control-valve, and this actuates his double-beat stop-valve by direct mechanical action, just as in *Cumminsky's* Patent, but he does with one rod what *Cumminsky* does with three. *Cumminsky's* distributing valve corresponds in its relation to the cut-off valve to *Brown's* control valve. This difference is immaterial. We call attention to two features of the Pursuers' invention: first, that the opening of the two valves is proportional, so that, if the control-valve does not reach the central position, the cut-off valve cannot completely close; and, second, that both valves may be actuated, though there is no steam in the pipes. Our two first Patents (Nos. 7575 and 17,851 of 1900), which we admitted to be infringements of the Pursuers', had these same features. The Patents at present in question (Nos. 16,525 of 1902, and 10,894 of 1903) do not have them, so that our cut-off valve closes completely, even though the control-valve may not return completely to the middle position, and the operation of our cut-off valve depends entirely on the presence of steam in the pipes. Our method of actuating the cut-off valve is therefore essentially different in its nature and operation from the Pursuers. Our Patent is good, theirs not being a pioneer Patent. To get a pioneer Patent, the inventor must strike out a fresh path. Thus an undoubted example of a pioneer Patent would be *Rughe's* microphone. An example of the smallest degree of novelty that would constitute

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a pioneer Patent was *Thomson's* compass (*Thomson v. Moore, ubi supra*). The rule is that the second Patentee must not take the substance of the first's invention (*Dudgeon v. Thomson, ubi supra*). The present case is similar to *Gwynne v. Drysdale* (3 R.P.C. 65; 13 R. 684) where there was held to have been no infringement. If any material part of a combination is omitted (*e.g.*, 5 the inclined planes) the improved combination is good subject-matter for a new Patent. (See *Consolidated Car Heating Company v. Came, ubi supra*). Three methods of infringing a Patent are recognised, viz., by taking the whole invention, by taking the material parts of it, and by substituting mechanical equivalents. But where the object of the invention was familiar before, you 10 are outside the doctrine of mechanical equivalents, and the Patent can be infringed only by taking it with mere superficial changes or by colourable imitation. The principle of *Foxwell v. Bostock* (10 L.T. N.S. 144, 4 De G.J. & S. 298) has been so whittled away that little is left. What is protected is what is described in the Specification (*Dudgeon v. Thomson, ubi supra*). The vital 15 part of our machine, the method of actuating the cut-off valve, is quite different from that described in the Specification of the Pursuers. It also serves an improved and additional purpose—that of cutting the steam off even when the control-valve is not quite in the middle position.

As to damages, they ought, if given, to be confined to the profit the Pursuers 20 would have made on the valves supplied by us if they had had the supplying of them. We did not get the orders for the steering engines because we supplied these valves. *United Horse Shoe and Nail Co., Ltd. v. Stewart & Co. (ubi supra)* is distinguishable. There the part produced by the patented mechanism was not separable from the rest of the manufacture, while here the cut-off valve is 25 separable from the steering engine, and might be fitted on to any such engine. There also infringement was admitted though under a misapprehension. Here no such admission is made. Damages for infringement of a small part of a complicated machine are not to be assessed as if the whole machine had been taken, *Mowry v. Whitney*, 14 Wallace (U.S.) Reports, 620. See also the cases 30 quoted in *United Horse Shoe and Nail Co.* (14 R. 272 note).

On the 25th of March 1904 Lord KYLLACHY pronounced an interlocutor granting interdict as concluded for, and finding the Defenders liable in £300 damages. The following is his Lordship's opinion :—

Lord KYLLACHY.—The Pursuers in this case are proprietors of a Patent dated 35 in 1897 which relates to improvements in connection with the valves of steering and like engines; and speaking generally the improvement which the patentee claims may be said to consist in a certain contrivance for stopping or reducing to a minimum the waste of steam, formerly found inevitable, during the periods (constantly recurring and often prolonged) when the steering engine is at rest, 40 but when nevertheless there exists a constant pressure of steam upon, and consequently leakage through, the controlling valve of the engine.

There is no dispute as to the merit and novelty of the invention. The question is simply as to an alleged infringement by the Defenders, who are said to make, sell, or use certain similar apparatus, having the same object, for which 45 they hold certain Patents of subsequent date. As not unfrequently happens, the controversy comes really to turn on the construction of the Specification filed with reference to the Pursuers' Patent, dated as I have said in the year 1897.

The Pursuers contend that on the just construction of that Specification, read as it falls to be read with reference to the state of prior knowledge, the essence 50 and substance of the invention consisted in the introduction for the first time into steering engines of what I may call a separate stop-valve, formed in the steam casing through which the steam enters the controlling valve; this stop valve being arranged to move in unison with the controlling valve, by means of suitable mechanism, one form of which the patentee fully describes. 55

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The Defenders on the other hand say that the Pursuers' Specification properly construed is only for the particular method described of actuating the stop-valve, viz., the motion of opposite inclines fitted on the stop-valve acted upon by counterpart inclines fitted on the controlling valve. On that assumption they say, and I think truly, that their (the Defenders') apparatus—the alleged infringing apparatus—actuates the stop-valve in a different way, viz. indirectly by variations of steam pressure, instead of directly, by the direct mechanical contact of counter inclines. And that being so, they contend that there is no room in this case for what is called the doctrine of mechanical equivalents,—a doctrine which applies only where, the essence of an invention being taken, some part of the described mechanism, essential to its working but not an essential part of the invention, has had substituted for it by the alleged infringer some known different but equivalent mechanism to produce the same result.

It is, I think, clear that the question thus sharply raised cannot be solved upon the mere language of the Specification or of the Specification and claim. It has to be first ascertained what, having regard to the state of prior knowledge, was the field open to the inventor, and how far what I may call his total apparatus was at its date new,—new particularly in the sense of achieving a new and important result. In other words, it is necessary to know whether his invention was what has been called a "pioneer" or "master" invention, or was only in truth a new and improved mode of achieving an already achieved result. It is obvious and has been repeatedly decided (*Consolidated Heating Co. v. Came*, L.R., Appeal Cases, 1903, p. 516) that in determining what is essential and what is not, that is always a most important and generally a crucial consideration.

It appears to me to be the just result of the evidence that the Pursuers' invention was undoubtedly of the former class, and not of the latter. Steering engines were of course well known in 1897, and in such engines there was of course, besides the usual distributing valves near the cylinder, what was known as a controlling valve—a valve which, being operated by the usual hand-wheel, determines the passage of the steam in different directions, according as it is desired to move the helm to port or to starboard; and which, as each motion is completed, comes back to its neutral position, and thus, at least theoretically, shuts off steam for the time. The difficulty, however, was that this controlling valve was necessarily loose. It had to be sensitive, and to work easily, and it could not therefore be tight. Hence leakage and consequent waste of steam was inevitable, and in large vessels was serious; and at the date of the Pursuers' Patent no method had been devised, or even proposed, for curing this leakage—this waste of steam when the engine was not at work. In particular, it had not occurred to anybody that the problem might be solved by the introduction of a separate valve—a separate stop-valve—working automatically in connection with the controlling valve, and which, while leaving the latter valve loose, was in itself absolutely tight. Of course stop-valves and cut-off valves were old and well-known contrivances. So, also, as applied to ordinary engines (continuously working engines like locomotives) were cut-off valves working automatically. They were used for promoting economy of steam, or more effective expansion of steam, when the engines were working. But it had not occurred to anybody to use either a stop-valve or cut-off valve in connection, not with the ordinary distributing valves common to all engines, but with the controlling valve peculiar to steering engines; or to use such valve for the purpose, not of economising steam when the engine was working, but of preventing the waste of steam when it was not working. It was left for *Brown* to make for the first time this new and useful application of the automatic stop-valve, and by doing so to achieve a result which was much desiderated and has been a great commercial success.

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Plainly therefore it must, I think, be taken that the Pursuers' invention was in the most real sense what is called a "pioneer" invention. It was not of the kind in question in such cases as *Curtis v. Platt* (L.R. 3 Ch. Div., 135), or *Dudgeon v. Thomson* (L.R. 3 App. Cases, 34). It belonged, on the contrary, to the class of patented inventions which were the subject of such cases as *Proctor v. Bennis* (L.R. 36 Ch. Div., 740), *Thomson v. Moore* (6 R.P.C., 426; 7 R.P.C., 325); and *Aktiebolaget Separator Co. v. Dairy Outfit Co.* (15 R.P.C., 327). 5

Having this in view, the question at issue is really this—whether it can be held, on the fair reading of the Pursuers' Specification, that, having in fact made this new and valuable invention, he (the Patentee) has yet, for some reason, claimed only or, what comes to the same thing, put forward as the essential or one essential part of his protected invention, the particular mode which he describes of actuating his stop-valve by the action of counter inclines. Of course, such a thing is possible. The Patentee may have failed to recognise the true nature of his discovery, or he may have so expressed his Specification as to make the suggested reading inevitable. But the question is whether that is so, or whether, reading the Specification fairly, in the light of the state of knowledge at the time, it is not sufficiently manifest that the invention described and claimed is just the invention which the Patentee made. 10 15

Now, as to this, all I can say is that I see no sufficient ground for reading the Specification in the narrow sense for which the Defenders contend. It may be true that it would have been better, as it certainly would have been quite easy, for the framer of the Specification to state expressly that while fully describing, as he required to do, an effective method of actuating the stop-valve, he did not confine himself to that method, but only to that or some equivalent method. But that is, I am afraid, an observation which might be made in most patent cases which come before the Courts. It is the leaving of things to implication which as a rule makes construction necessary; and applying here what I conceive to be the proper principles of construction, I have on the whole come to the conclusion that the Pursuers' construction of the Specification is the correct one. I consider that the essential feature—the essence and substance—of the patented invention consists simply in the application to steering and the like engines, for the purpose of preventing leakage of steam while the engine is not working, of a separate stop-valve working in unison with the controlling valve. And as it is not disputed, or at least is clear, that the Defenders' apparatus embraces those elements and employs them for the same purpose and with the same result, I am of opinion that the Pursuers are entitled to judgment. With regard to damages, that is of course a jury question. The actual profit made by the Defenders and presumably lost to the Pursuers upon the manufacture and sale of the ten valves specified seems to have been about £100. Something, however, must be added in respect of profit presumably lost to the Pursuers by the Defenders obtaining the orders for the steering engines fitted with the Pursuers' valves, which orders, it is said, would, but for the Defenders' competition, have come to the Pursuers. It seems to be decided that this is a legitimate element to be considered, and the Pursuers' claim in respect of it an additional sum of £600. I think, however, this excessive, inasmuch as it assumes as a certainty what was hardly of that character. I think I shall do justice by fixing the total damage at £300. 20 25 30 35 40 45

Ingram and Kemp, Ltd. v. Edwards Brothers.

IN THE HIGH COURT OF JUSTICE.

QUEEN'S BENCH DIVISION.—BIRMINGHAM DISTRICT REGISTRY.

AT THE WARWICKSHIRE WINTER ASSIZES AT BIRMINGHAM.

Before MR. JUSTICE WILLS and a Special Jury.

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March 29th, 1904.

INGRAM AND KEMP, LD. v. EDWARDS BROTHERS.

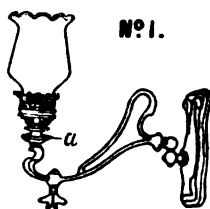
Design.—Action for infringement of two Designs.—Marking before sale.—Anticipation.—Infringement of one Design found.—Verdict for Plaintiffs with £5 damages.—Costs.—Patents, &c. Act, 1883, section 51.

- 10 On the 4th of March 1901, *Ingram and Kemp, Ltd.* registered in Class 1 a Design to be used for and in connection with the manufacture of gas brackets and pendants under No. 371,068, and on the 6th of May 1902 they registered in the same class another Design for the same purpose under No. 390,685.
- 15 On the 1st of December 1903, *Ingram and Kemp, Ltd.* commenced an action against *Edwards Brothers* for infringement of these two Designs. The Statement of Claim after setting out in the 1st paragraph the above-mentioned registrations continued as follows :—“(2) The Defendants have since the dates
- 20 “of the said respective registrations wrongfully applied and caused to be applied for the purposes of sale the said Designs or fraudulent or obvious imitations thereof to goods of the class in which the said Designs were registered; (3) The Defendants have since the said respective dates wrong-
- 25 “fully exposed for sale, and have sold articles of manufacture to which the said Designs, or fraudulent or obvious imitations thereof, have been applied, the Defendants at the time knowing that the consent of the Plaintiffs had not
- 30 “been given to such application of the Designs; (4) The Defendants have in their possession or power articles of manufacture within the said class to which the said Designs or fraudulent or obvious imitations thereof have been applied; (5) The Plaintiffs are unable to give full particulars under the aforesaid paragraph until they have had Discovery from the Defendants but
- 35 “the Plaintiffs in particular and by way of illustration say that on the 27th of October 1903 the Defendants exposed for sale and sold to Mr. *Hunt* of 115 and 117 Cannon Street, London, brackets and pendants to which they had respectively applied and caused to be applied the said Designs or fraudulent or obvious imitations thereof. The Plaintiffs claim :—(1) £500 damages; (2) an injunction restraining the Defendants their servants and agents from any further infringement of the said Designs or either of them; (3) delivery

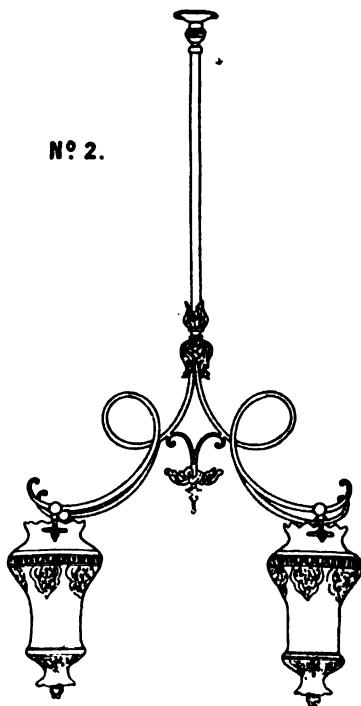
Ingram and Kemp, Ld. v. Edwards Brothers.

" up to the Plaintiffs of all articles in the possession of the Defendants made
 " in infringement of the said Designs or either of them, and of the patterns
 " from which the same have been made ; (4) all necessary accounts and
 " inquiries as to damages ; (5) further or other relief ; (6) Costs."

The Statement of Defence was as follows :—" (1) The Defendants deny all the 5
 " allegations of fact contained in paragraphs 2, 3 and 4 of the Statement of



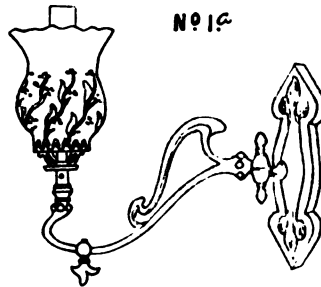
" Claim as fully as if each allegation were set out and specifically denied ;
 " (2) The Plaintiffs are not and never have been Proprietors of the said Designs
 " or of either of them, and were not entitled to register the said Designs or
 " either of them in the class in which they have purported to register the same ; 10
 " (3) The Designs were not, nor was either of them new or original at the date



" of the registration ; (4) Each Design had been published previous to the date
 " of registration, and on and previous to such last-mentioned date each Design
 " was commonly known, and was used and applied to articles similar to those
 " to which the Plaintiffs' Designs were applied ; (5) The Designs registered, 15
 " were not, nor was either of them proper subject-matter for registration ;

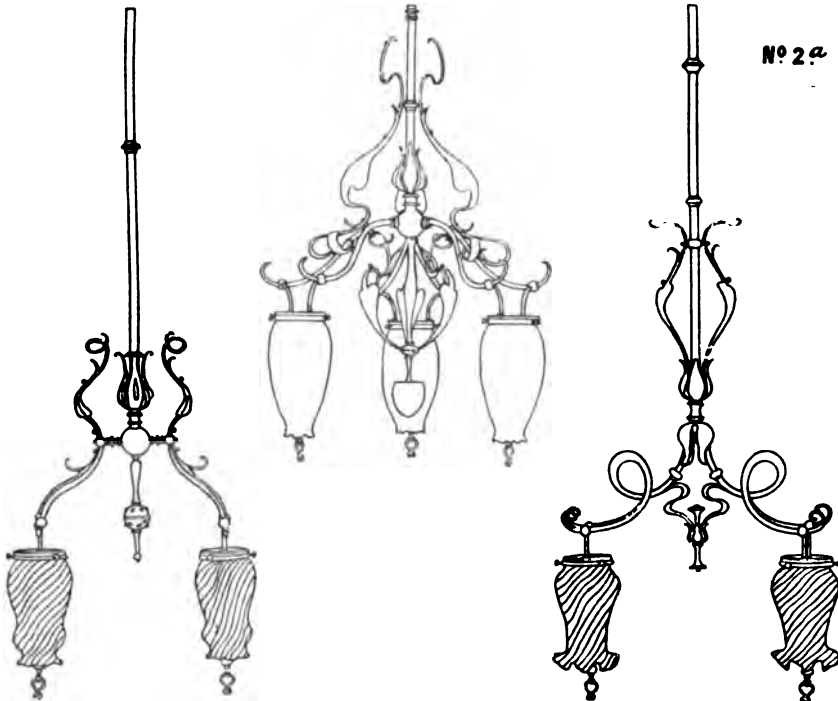
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"(6) The Plaintiffs, if they ever had any Copyright in the said Designs or in either of them (which is not admitted) have lost the same by reason of the sale of articles to some of which one Design had been applied, and to some of which the other Design had been applied, and without having the said



- 5 "articles marked as prescribed by the Patents Designs & Trade Marks Act, 1883, Sec. 51; (7) The Defendants have not infringed the Plaintiffs' Copyrights in the said Designs or in either of them."

In pursuance of an Order of the 16th of February 1904, the following Particulars were delivered by the Defendants:—"The alleged registered



- 10 "Designs or the characteristic features of the same were published before the dates of registration as follows:—As to the registered Design, No. 390,685—(1) "The shape of the pendant arm or the characteristic features of same, were published: (a) An electrolier made by the Defendants and sold by them to

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"the Bolton Corporation Gas and Electric Department, October 12th 1900; (b) a two-light gas pendant, made by the Defendants and sold by them to John Findlay and Co., Greenock, ironmongers, etc., April 1902; (c) a single light gas pendant made by Defendants and sold by them to Messrs. Sinclair and Ewing, ironmongers, etc., of Dundee, on April 12th 1900; (d) a two-light gas pendant made by Defendants and sold by them to Brixton Bon Marché, London, March 21st 1901; (e) a two-light kitchen pendant manufactured and sold by Defendants to W. E. Sadler, Salford, near Manchester, 5th June 1901; (f) Plaintiffs Design, No. 846, a two-light gas pendant exhibited at page 23 of the Plaintiffs' catalogue of special gas fittings for incandescent burners. (2) The ornament or the general features of same, were published by: (a) A two-light gas pendant made by Defendants, and sold to Findlay and Co., September 12th 1900; (b) a two-light gas pendant made by Defendants and sold to Jones Bros., Holloway, London, house furnishers, December 15th 1899; (c) a two-light gas pendant made by Defendants, and sold to Brixton Bon Marché, London, March 21st 1901. As to the registered Design, No. 371,068—(3) The shape of arm or the essential feature of same, was published by gas brackets made by Defendants and sold by them as follows: (a) Bolton Corporation Gas Department, December 12th 1900; (b) Marriot Bros., Nottingham, ironmongers, etc., 16th November 1900; (c) James Milne and Co., Ltd., Glasgow, gas fittings manufacturers, 12th December 1900; (d) W. H. Bowley, 11, Hatton Garden, London, February 22nd 1901. The ornament or the general feature of same, was published in the catalogue of the English Petroleum Lamp Co., of Birmingham, several years before the date of Plaintiffs' registration. (4) As to articles not marked as prescribed by the Act. A pendant and a bracket made to Plaintiffs' alleged registered Designs, were purchased from them on or about January 20th 1904, by Archibald Hamilton, Glassford Street, Glasgow, shop fitting manufacturer."

In the drawings on pp. 464 & 465 hereof, Nos. 1 and 2 represent the Plaintiffs' articles, and Nos. 1^a and 2^a represent the Defendants alleged infringements.

The action was tried before Mr. Justice WILLS and a special jury at the Warwickshire Winter Assizes at Birmingham, on March 29th 1904. Lewis Edmunds, K.C., and McCardie (instructed by Pinsent & Co.) appeared for the Plaintiffs; Hugo Young, K.C., Vachell and G. Milward (instructed by Howard Lloyd, Junr., appeared for the Defendants.

At the trial the objection to the marking of the Pendant was not insisted upon, but it was contended, as regards the Bracket, that as it was only marked on the cup (which is designated by *a* on drawing No. 1), and as the cup screwed on and off and was not a novel part of the design, the provisions of section 51 of the Patents, &c. Act, 1883, had not been complied with.

Clifford William Kemp, chairman of the Plaintiff Company, was called as a witness, and explained the points of resemblance between the Designs of the Plaintiffs and the alleged infringements by the Defendants.

R. Skerrett, Patent agent, deposed that he had inspected the alleged anticipations and did not find any which anticipated the Plaintiffs' Designs.

Beattie, the designer of the Plaintiffs' bracket, was called, and deposed that he saw no relation between it and those produced as anticipations.

Edwards, one of the Defendants, was called, and denied the similarity between his firm's Designs and the registered Designs of the Plaintiff.

WILLS, J., in summing-up.—Gentlemen of the Jury.—I am almost surprised that there should have been any heat thrown into this case. The gentlemen on both sides seem to me to be so eminently respectable and so perfectly candid that I regret that there should have been any heat in the matter. As far as I am concerned, they both of them, in my mind, leave the Court entitled to perfect respect.

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The Plaintiffs complain that their two registered Designs for the bracket and pendant have been infringed. Whether they have or not is for you, and you must judge by looking at them. You know that in questions of this kind there are two opposite considerations which must be borne in mind. One is that it
 5 never was intended that the registration of designs and the protection given to designers should cripple everybody else in the legitimate exercise of their business, and it is not because a particular sweep happens or happens not to be present in the two articles that necessarily the one is an infringement of the other. The other thing which one must always look to is that the Act of
 10 Parliament did intend that real original work should be protected.

If I may put what occurs to me in the compass almost of a sentence—and I really shall say very little more—I would say that it is entirely for you to say whether you agree with it. Do not take any view of the facts from me. You are the judges of the facts. My duty is to lay down the law where law comes
 15 into play, and to offer what reasonable help I can to the jury in considering the facts, but it is your judgment, and not mine, on a question of fact, and I only say what occurs to me because it may be something for you to cut and carve at and see whether you like it or not. I should have said myself in a sentence that the anticipations seem to me to be sufficiently different to come to nothing.
 20 They do not appeal to my eye as being the same at all. On the other hand, with regard to the infringement, it occurs to my mind that the bracket is not an infringement. That is entirely for you. It looks to me substantially a different thing, and I will tell you exactly why; but you are not to take it from me—you are to judge for yourselves. I think that spur, that thing like the beak or ram
 25 of an ironclad is so very different in its general effect from the other. Something like the shape of the outside of a harp is common to both of them. But when you come to that spur it is very much uglier to my mind—I like the Plaintiffs' design much better—but the Defendants' seems to me to be sufficiently ugly to constitute a very substantial difference, and also as to the nozzle, the
 30 thing at the end, the two do not seem to me to have the same characteristics. That is how it occurs to me. On the other hand, with regard to the pendant, I must say I never had in my own mind any doubt about its being an infringement. I entirely accept what the Defendant says, and I hope he will not go away with the notion that I have disbelieved anything that he said. It
 35 very often does happen where you have people always trying to make pretty things, and to make useful things, especially in regard to a matter as to which there are an abundant number of designs which everybody more or less would know are original by their combination and by the general look of the thing—it very often will happen that a man stumbles on the same thing as his
 40 neighbour has stumbled upon already. If his neighbour has happened to get the protection of registration before he has done so, then, however unwittingly he does it, he infringes, and he is giving a cause of action. That is how it strikes my mind, but it is entirely for you. I shall not say more because it is a matter of the eye after all, and I cannot discuss it any more than the designers
 45 have done, the skilled gentlemen whose evidence appears to me to leave it exactly where it was before, and not to help us a bit.

Then, if you find for the Plaintiffs, what are the damages up to the present time? There will be an injunction, and the Defendants will be put under terms not to do this again. I do not believe there is any necessity for it. But still, the
 50 Plaintiffs would be entitled to an injunction to prevent the thing being done in the future. As to the past, I see no reason to suppose that Defendants are not telling us the perfect truth when they say they have sold some 18 pendants at the outside. Well, now, the pendants are sold for 35s. a piece. That makes up 15 guineas. I suppose that the profit on these things is probably from 25 to 35
 55 per cent.—say 33 per cent., because that is one third. On that sale the Plaintiffs are entitled to the profit which the Defendants have made, which would be 5 guineas. Then, with regard to the brackets, if you take the same view that

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I have ventured to express, there would be no damages for them at all ; but if you take the contrary view (and if you do you are bound to act upon it), why, then, the sales are eight dozen—we will call it 100 for the sake of easier calculation—and that brings out a sum of £47 10s. Taking the same view of the measure of profit upon that, you get about 15 guineas. So that it would be about 15 guineas in respect of the one, the brackets, and about 5 guineas in respect of the other, or any larger or smaller sum which you, in your judgment and with your knowledge of the trade, would say would be a fairer thing than what I have suggested. You are urged to give something more. I cannot quite see that. The sale of this very small number of these things is not likely to have damaged the Plaintiffs in any other way. Nor, as far as I know, has it ever been held that, because the imitating article is an inferior looking article, and therefore if it is supposed to be the original one it would damage it in that way—I never heard of there being damages for a sort of libel on the respectability and honour of the original design. If you think that what I have suggested, 5 guineas and 15 guineas, or either or both of them, ought to be increased by what I may call general damages, then you will increase them. It is not a case in which, as far as I can see, there is anything like evil conduct which would make one incline to swell the damages beyond what is quite reasonable.

Gentlemen, I have written down four questions on paper. The objection was taken that with respect to the bracket it is not stamped with a notice of the registration, which it ought to be in order to entitle the owner of the design to the protection of the copyright. The only question I leave to you there is, would the bracket be a complete article without the cup ? Because the Act of Parliament says that before the sale of any article to which a registered design has been applied, the proprietor shall cause each such article to be marked with the mark. It seems to me that the article sold is the bracket and I do not think the bracket would be complete without the cup. It appears that it is never sold without it. If you think so you will say “No” to that question “Would the bracket be a complete article without the cup ?” That will dispose of the objection that has been taken that the registration is invalid. Objections are always made, and one always has to deal with them ; but I do not think you will have any difficulty in dealing with that. I have written the four questions for you. I do not suppose you will have much difficulty in answering them.

The following were the questions with the answers of the jury thereto :—

(1) “Have the Defendants infringed Plaintiffs design for the Bracket ?” “No.” (2) “For the Pendant ?” “Yes.” (3) “Has there been an anticipation of either ?” “No.” (4) “Would the bracket be a complete article without the cup ?” “No.”

The jury gave a verdict for the Plaintiffs with £5 damages.

Hugo Young, K.C.—The Defendants succeed as to one of the articles. The Plaintiffs succeed as to the other. Your Lordship will give each party the costs of the issue on which they have succeeded ?

WILLS, J.—There will be judgment for the Plaintiffs with costs, and of course the Defendants will have the costs of all issues on which they have succeeded.

After some further discussion, *Lewis Edmonds, K.C.*—I propose to endorse my brief, “Judgment for the Plaintiffs, with costs ; Defendants to have costs of all issues on which they have succeeded, but all costs of issues on anticipations of both Designs to be the Plaintiffs. Injunction as asked in respect of the Pendant Design. Delivery-up of infringing Pendants in stock, and destruction in presence of Plaintiffs’ solicitors or representatives of patterns from which Pendants are made. Damages £5. Certificate for special jury.” I think that covers what your Lordship intends.

WILLS, J.—Yes.

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and Others.*

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BUCKLEY.

May 6th and 13th, 1904.

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, and COZENS-HARDY.

5 May 31st, 1904.

**BADISCHE ANILIN UND SODA FABRIK v. W. G. THOMPSON & CO., LD.,
AND OTHERS.**

Patent.—Action for Infringement.—Interlocutory Injunction.—Motion to commit for breach of injunction refused.—Fresh Motion to commit for same alleged breach.—Motion dismissed with costs.—Leave to appeal refused by Judge and Court of Appeal.

On the 7th day of April 1902, the *Badische Anilin und Soda Fabrik* commenced an action for infringement of Letters Patent, No. 14,723 of 1891 and No. 9,633* of 1892, both granted to *James Yate Johnson*, and on the 25th April 1902, moved before *Buckley, J.*, for an interlocutory injunction against the Defendants *W. G. Thompson & Co., Ltd., William Goulden Thompson, William Gregory Thompson, Walter Thompson, George Nicholl, the Star Chemical Company* and *William Thompson*, and it was ordered that the said Defendants, their servants, agents and workmen, be restrained until judgment in the action or further order from importing into England and from selling, supplying and using in England, dyes manufactured according to or in manner described in the Specifications, filed in pursuance of the Patents or either of them, or according to or in any manner only colourably differing from the same.

On the 27th of November 1903, the Plaintiffs moved to sequester the property and effects of *W. G. Thompson & Co., Ltd.*, and to commit the Defendants, *William Goulden Thompson, William Gregory Thompson, and George Nicholl*, as Directors of that Company and also the *Star Chemical Company and William Thompson*, for disobedience of the Order of the 25th of April 1902. The notice of Motion also asked for an Order under the Banker's Books Evidence Act, 1879, and for other relief. On the hearing of the Motion it was partly opened and several affidavits were read, but, Counsel for the Plaintiffs stating that his materials were not sufficient for him to ask for an Order to commit, the Court did not think fit to make any Order on the

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Motion, except that the Plaintiffs should pay to the Defendants their costs of the Motion. The Plaintiffs, on the hearing of the applications hereinafter-mentioned, alleged that there had been no decision or adjudication on the question whether a contempt had actually been committed.

On the 6th of May 1904, the Plaintiffs again moved to sequester the property and effects of *W. G. Thompson & Co., Ltd.*, and to commit the Defendants, *William Goulden Thompson, William Gregory Thompson, George Nicholl, the Star Chemical Company, and William Thompson*, for contempt of Court in respect of the same alleged breach of the injunction, but on further evidence in regard to the same.

The facts are more fully referred in the Judgments set out below.

Moulton, K.C., Cripps, K.C., and J. C. Graham (instructed by *J. H. and J. Y. Johnson*) appeared for the Applicants; *T. Terrell, K.C., and Alexander Grant* (instructed by *Phelps, Sedgwick and Biddle*, agents for *Wm. Powell, of Manchester*) appeared for the Respondents.

Moulton, K.C., and Cripps, K.C., for the Applicants:—This case was before the Court some time ago on a Motion to commit. Our allegations were then met with a flat denial, but now we say there is no doubt of the truth of them. [*Terrell, K.C.*—I contend that this Motion cannot be entertained. The Motion was heard before, and was dismissed. The matter is therefore *res judicata*.] We say that the evidence of the Defendants on the previous Motion was absolutely false. [BUCKLEY, *J.*—Then why not indict them for perjury?] This is a case of contempt of Court. [BUCKLEY, *J.*—I cannot re-try the matter.] On the previous occasion no judgment was given by the Court. There is no authority for saying that an interlocutory Order will prevent a person from bringing a further Motion on fresh evidence. If an Applicant elects not to proceed with his Motion, the matter is not *res judicata*. On the previous application to commit, the Plaintiffs had not sufficient evidence to enable them to proceed with the Motion. Having obtained additional evidence, there is nothing to prevent them from making a further application to commit for contempt. There is no *res judicata*—no estoppel. All that can be said is that, on the previous occasion, the Court was not satisfied that it ought to exercise its discretionary powers of committing for contempt. In the case of *Fairclough v. Manchester Ship Canal* (L.R. 1897 W.N. 7), the Court of Appeal held that these punishments are for wilful contempt. It is not *res judicata* in this case that the contempts have not been committed. There was no decision as to whether the facts upon which we rely constituted a contempt of Court. A person is not estopped from coming to the Court on further facts.

Counsel for the Respondents were not called upon.

BUCKLEY, *J.*—This is a Motion affecting the liberty of the subject. It therefore must be treated, of course, strictly. An Order was made on the 25th of April 1902, granting a certain Injunction. Some time before the 27th of November 1903 the Plaintiffs, who had obtained that Injunction, alleged that the Defendants had committed a breach of it, and they moved to commit for the contempt thus committed. An Order was made on the 27th of November 1903. It refers to three affidavits of *William Phelps Thompson, William Gregory Thompson, and George Nicholl*, three of the Respondents, as read, and the ordering part is:—"This Court doth not think fit to make any Order on this Motion, but orders that the Plaintiffs do pay to the Defendants" (naming them) "their costs of this Motion to be taxed by the Taxing Master."

I have no distinct recollection of what passed, but from what Mr. *Terrell* has said I do remember that the affidavits were discussed to some extent, because I remember some discussion as to the son-in-law of one of the Defendants being the person who had done the act, and that he was not on friendly terms with the family, so evidently there was some discussion, although I do not remember at the moment what it was. But, whether there was a discussion

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or not, that Order, in my opinion, is an Order based upon affidavits, which were read, or taken to be read, by Counsel to the Court so far as was necessary, and upon which the Court must have arrived at the conclusion of fact that the offence had not been committed. The same Applicants now move before
5 me to commit these Defendants for breach of the same Order, and Mr. Moulton tells me that the facts upon which he relies are facts which all took place before the 27th of November 1903, and that the offences which he now alleges are the same offences as he alleged then. He says that he has now been able to procure evidence that could not be procured on the previous occasion, and he
10 seeks, therefore, to commit on better evidence for the same offences. Now, ought I to entertain this Motion? In my opinion, I ought not. I do not say that the Court could not commit for a contempt even under such circumstances as these, but it is a mistake to suppose that this Court makes Orders to commit for contempt by reason of any feeling of ruffled dignity or anything of that kind. It is nothing of the sort. The Order to commit for a
15 contempt is an Order which the Court necessarily must make in order to compel obedience to the Orders which it is the duty of this Court to make, and which it must see obeyed. It is a process to enforce obedience to the Order of the Court. That depends, of course, upon the facts. If the party, who has obtained an Injunction comes inviting a discussion and a decision on the point whether an
20 offence has been committed or not, fails to prove it, and his Motion is accordingly dismissed, or, which is the same thing, the Court makes no Order upon it, I do not think that the party against whom the Injunction is granted ought to be vexed again with a similar application simply because the party moving has
25 taken more time to get up his evidence, and has found out more facts. *Nemo debet bis vexari pro una et eadem causa* is, of course, a motto not applicable under all circumstances, but I think it is applicable to such a state of facts as this. On these grounds, it seems to me that I ought not to entertain this Motion.

30 I further point out that the offence alleged is said to have been committed before November 1903, and it is not alleged that there has been any renewal of it since that time, so that it is, in a sense, a stale offence. I do not think that I ought to interfere under those circumstances, and I cannot go behind the Order of the 27th of November 1903. Of course, it is perfectly open to the parties
35 who complain of this Order to take other proceedings, because I understand that the Respondents denied the offence altogether, and, if that evidence was perjured, of course the party against whom it was given has his remedy. The Motion will be dismissed with costs.

40 On the 13th of May 1904 Counsel for the Plaintiffs applied for leave to appeal, and the following Judgment was delivered on that application.

BUCKLEY, J.—There are two grounds upon which principally I refuse leave to appeal in this case. The first is that, in November last, a Motion to commit for breach of an interim Order was heard by me. Mr. Graham, who had the conduct of the Motion, did not find himself in a position to bring it on. The
45 Motion was not abandoned; Counsel was there to move it, and said that his materials—that was the substance of it—were not such that he could trouble the Court with it, and accordingly the Motion was dismissed. That was equivalent to a finding of fact that there was not, upon the evidence, a case for committal—that is to say, that there had been no breach up to that date;
50 Counsel making the application was not in a position to say that there had been. It appears from the shorthand notes that I said that that did not prejudice a further Motion to commit. What I meant by that was, that if further breaches took place, a further Application to the Court might be justified, and the matter could be investigated, because, of course, the Order of the Court must
55 be obeyed. The Motion which was before me last week was a Motion to commit, not on any facts arising since November, but on the same facts which were

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alleged to exist at that date, and were not proved at that date as the Applicants say they can prove them now. I thought then, and I still think, that I ought not to allow the case to be re-opened. Further, the object of any Application to commit, of course, is to compel obedience to the Order of the Court. The Applicants do not say that since November there has been any further breach. 5 The Motion, therefore, to commit in November, supposing it was well founded at that date on the true facts, succeeded in this sense, that it stopped any subsequent breaches. I endeavoured to express that view last week, by saying that this was a stale application to commit. I think it was going back to facts which have been adjudicated upon before, since which it is not alleged that there has 10 been any breach. On that ground it seems to me that this Motion ought to fail, and that I ought to refuse leave to appeal. The second ground upon which I refuse this Application is this. The breach was a breach of an interlocutory Order. Now, I find that from Mr. Justice Warrington's paper that this Action will be in the paper Monday next, subject to anything that is part heard, so that 15 the Action is now going to be tried out, and the question whether the interlocutory Order is right will be determined immediately.* That is another ground on which I refuse this Application. On these two grounds I refuse leave to appeal with costs.

On the 31st of May 1904, the Plaintiffs moved in the Court of Appeal for 20 leave to appeal from the Order of the 6th of May 1904.

The same Counsel appeared as on the Motion to commit.

Moulton, K.C., for the Appellants.—On the first Motion to commit, the Plaintiffs admitted that there was one link in the evidence which they could not prove. [*Terrell*, K.C., objected that there was no appeal even with leave; 25 and he contended that there had been a decision on the first Motion to commit, and the matter was *res judicata*.] There was no finding on the first occasion that no contempt had been committed. [VAUGHAN WILLIAMS, L.J.—Can you cite any case in which a Judge has refused to commit for contempt of Court, and, on an appeal, the Court of Appeal has made an Order for committal. In 30 *Swinfen v. Swinfen* (26 L.J. C.P. 97), an attachment was refused on the ground that one member of the Court differed from the other members as to the propriety of making an Order.] I can give no authority, but there has here been no decision on the merits by *Buckley*, J. [*Terrell*, K.C.—The first Motion to commit was actually opened.] Not on that point, but as to the other relief 35 asked for.

The Court called for the Order made on the 27th of November 1903, and, on reading it, refused the leave to appeal, and dismissed the Motion with costs.

* The trial is reported *infra*, p. 473.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE WARRINGTON.

May 17th, 1904.

**BADISCHE ANILIN UND SODA FABRIK v. W. G. THOMPSON & Co., LD., AND
OTHERS.**

Patent.—Action for infringement.—Validity.—No manufacture in the United Kingdom by owners of Patents.—No intention to manufacture in the United Kingdom.—Alleged exorbitant prices.—Patents held not to be invalidated.—Certificate of validity.

10 In an action for infringement of two Patents relating to dyes the Defendants alleged that the Patents were, or had become, invalid because, first, the Plaintiffs, the owners of the Patents, had no intention to manufacture in this country ; secondly, that they had not manufactured in this country, and had used the Patents to prevent other persons from doing so ; and, thirdly, that they had charged
15 exorbitant prices for the patented articles, much in excess of those charged in other countries. The Plaintiffs alleged that these grounds of invalidity were bad in law, but that the Excise duty on alcohol would prevent profitable manufacture in this country, and that their prices in this country were not exorbitant having regard to the circumstances, including the more complete protection against infringe-
20 ment as compared with other countries, in some of which chemical products cannot be protected by Patents.

Held, that the Plaintiffs had never manufactured or intended to manufacture in this country, and that the dyes were sold at a price considerably higher than in countries where they were not protected by Patents, and higher than in 25 certain countries where the protection was less complete; but that even if exorbitant charges for the patented articles would make the Patents invalid, the prices were not proved to be so exorbitant and unreasonable as to invalidate

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and Others.*

them; that as the dyes had been used in this country, the invention had been introduced into this country for the public good, and that manufacture in this country is not a condition of the grant of a Patent. Judgment was given for the Plaintiffs with costs against such of the Defendants as had infringed.

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A Certificate having been granted in a previous action as to one Patent, that the validity of the Patent came into question, although the Patent was then held to be, before amendment of the Specification, invalid as to one claim on the ground of insufficiency, the Court refused to go behind the Certificate or entertain any question as to the jurisdiction to give such a Certificate.*

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On the 7th of April 1902, the *Badische Anilin und Soda Fabrik*, a company incorporated according to the laws of the Grand Duchy of Baden, commenced an action against *W. G. Thompson & Co., Ltd.*, *William Goulden Thompson*, *William Gregory Thompson*, *Walter Thompson*, *George Nicoll*, the *Star Chemical Company*, *William Thompson*, and the *Basle Chemical Works* for infringement of Letters Patent, No. 14,723 of 1891, granted to *James Yate Johnson* for an invention of "The manufacture and production of new dyes related to the Rhodamine Series," and Letters Patent, No. 9633* of 1892, granted to *James Yate Johnson* for an invention of "The manufacture and production of new basic dyestuffs."

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The Plaintiffs, by their Statement of Claim, alleged :—(1) That they were the owners of the two Patents; (2) That the Patents were good and valid, and, in an action between the Plaintiffs and *La Société Chimique des Usines du Rhone, &c.*, and another, Mr. Justice Wills, on the 7th of August 1897, granted a certificate of the validity of the Patent, No. 9633 of 1892, subject to an amendment, which was duly made on the 27th of March 1899; and (3) That the Defendants and each of them had infringed both the Patents.

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The Particulars of Breaches alleged :—(1) That the Defendants had, at divers times prior to the commencement of the action, and subsequently thereto, infringed both Patents by importing into this country, using, and selling therein, dyestuffs manufactured in accordance with the inventions described and claimed in all the claims of the Specifications, No. 14,723 of 1891, and No. 9633* of 1892 respectively; (2) That the Defendants, the *Basle Chemical Works*, imported into and sold in this country, in the years 1893, 1894, 1895, 1896, 1897, 1898, 1899, 1900, and 1901, and up to the date of the writ in the Action, to their Co-Defendants, divers quantities of a dyestuff under the name of "Safflower Red G"; that the said dyestuffs were made according to the invention described and claimed in all the claims of the Patent, No. 14,723 of 1891; that the same Defendants imported into and sold in this country, in the years 1894, 1895, 1897, 1898, 1899, and up to the date of the writ in the Action, to their Co-Defendants, divers quantities of a dyestuff under the name of "Safflower Red 6 G"; that the said dyestuffs were made according to the invention described and claimed in all the claims of the Patent, No. 9633* of 1892; (3) That the Defendants, other than the *Basle Chemical Works*, carried on business as follows; that the Defendant, *William Goulden Thompson*, for some

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* *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhone*, 14 R.P.C. 875.

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time carried on business alone, and then in partnership with *William Gregory Thompson*; that in or about March 1901, the Defendants *William Goulden Thompson*, *William Gregory Thompson*, and *George Nicoll* became directors of the Defendant Company *W. G. Thompson & Co., Ltd.*; that *William Thompson* 5 in or about the year 1897, traded as the *Star Chemical Works*, and that *Walter Thompson* was in the employ of the Defendant Company, *W. G. Thompson & Co., Ltd.*; that the dyestuffs mentioned in the preceding paragraphs were imported into and purchased by the lastly above-named Defendants, at or about the dates mentioned, from the Defendants, the *Basle Chemical Works*, and were 10 used or sold by the Defendants, other than the *Basle Chemical Works*, at dates and to persons at present unknown to the Plaintiffs; the Plaintiffs were unable, until they should have obtained discovery from the Defendants, to give further or better particulars of the Defendants' infringements, but would claim to recover from the Defendants full compensation in respect of all such infringe- 15 ments.

The Action, so far as it was against the *Basle Chemical Works*, was settled, as appears from the judgment set forth below. No evidence of infringement was given against *William Thompson* or the *Star Chemical Company*. The Defendants, *W. G. Thompson & Co., Ltd.*, *William Goulden Thompson*, *William Gregory Thompson*, and *George Nicoll* by their Defence denied infringement, 20 and alleged the invalidity of the Patents.

The Particulars of Objections delivered by the Defendants, *W. G. Thompson & Co., Ltd.*, *William Goulden Thompson*, *William Gregory Thompson*, and *George Nicoll*, stated that, besides denying that they had infringed 25 the respective Patents, they relied in support of their defence on the following Objections to the validity of the said respective Patents: That both the Patents were contrary to law and mischievous to the State, and were void by virtue of the Statute in that case made and provided, and that the Plaintiffs were disabled and incapable to use and exercise 30 the same or any powers grounded or pretended to be grounded thereupon; in support of that contention the Defendants would rely upon the following reasons:—(a) that the Plaintiffs, contrary to the true intent and purport of the said respective grants, had not made, used, exercised, or vended the respective inventions thereby alleged to be patented within this realm; (b) 35 that the Plaintiffs had improperly and without lawful reason refused to sell within this realm certain dyestuffs, to wit, Rhodamine 6 G and G, manufactured by the Plaintiffs in accordance with the respective inventions the subject-matter of the said respective grants, and had so refused to sell to the Defendants, among others, although the Defendants had repeatedly 40 requested the Plaintiffs to sell such dyestuffs to them, and had offered and been at all times ready and willing to pay to the Plaintiffs their regular price for the said dyestuffs, and the Plaintiffs had so refused with the object and effect of injuring Defendants' trade; (c) that the Plaintiffs had used their alleged rights under their said respective inventions for the purpose of raising the prices of 45 certain commodities, to wit, dyestuffs, which the Plaintiffs sold in the British market, much above the prices at which the same commodities were sold by them in certain other markets—to wit, in the markets of Switzerland, Italy, Belgium, India, and Russia; that the dyers in the said other markets were competitors with British dyers, and by reason of the excessive price at which the 50 British dyers were compelled to buy the said dyestuffs, the British dyers were placed at a serious disadvantage in competition with the said other dyers whom the Plaintiffs had so unduly favoured, and the trade of the British dyers was thereby greatly hindered; that by reason of the premises the Patents were as aforesaid mischievous to the State by the raising of the prices of commodities at 55 home and caused injury to trade, and were generally inconvenient.

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Moulton, K.C., Cripps, K.C., and J. C. Graham (instructed by *J. H. and J. Y. Johnson*) appeared for the Plaintiffs; *T. Terrell, K.C., and J. W. Gordon* (instructed by *Phelps, Sidgwick and Biddle*, agents for *William Powell*, of Manchester), appeared for the Defendants; *W. G. Thompson, Ltd., William Goulden Thompson, William Gregory Thompson, and George Nicoll. C. E. R. Abbott* 5 (instructed by *Phelps, Sidgwick, and Biddle*, agents for *William Powell*, of Manchester), appeared for the Defendants *Walter Thompson, the Star Chemical Company, and William Thompson.*

Cripps, K.C., opened the Plaintiffs' case, and after referring to the pleadings and to certain of the answers to Interrogatories, continued:—The reasons alleged 10 in the Particulars of Objections for the invalidity of the Patents are bad in law. Non-user of a Patent is not a legal objection to its validity, but it will be proved that dyes made according of the patented processes have been largely used in this country. Non-user may be a ground for the grant of a compulsory licence, but not for a defence to an action for infringement. Then it is alleged that the 15 Plaintiffs refused to sell the dyes to the Defendants and others; but the Plaintiffs have not refused to sell except to infringers, or where they suspected infringement; thirdly, even if the Patents have been used to raise prices, as alleged, that is no answer in law to the action.

The following witnesses were called for the Plaintiffs—namely, *P. Leuthardt,* 20 *J. H. Johnson, and Dr. Erhardt.*

No witnesses were called on behalf of the Defendants.

Terrell, K.C., and Gordon for the Defendants *W. G. Thompson, Ltd., William Goulden Thompson, William Gregory Thompson, and George Nicoll.* The Defendants' case is of a kind discussed in the early times of Patent law. 25 The right of the Crown to grant a Patent was not conferred by the Statute of Monopolies, but is inherent in the Crown, and the Statute only declared that certain grants of monopolies were abuses, and it regulated the prerogative, but it was held not to alter the nature of a Patent, which is a franchise. The nature of a Patent is that it is a grant made for the encouragement of manufacture, not 30 of commerce. An inventor originally meant a person who introduced a manufacture into this country; it was in consideration of such introduction that Patents were not invalidated in the Statute of Monopolies. *The Clothworkers of Ipswich Case* (Godbolt 252), decided in 1615, shows that Patents were not granted for an invention, but for the introduction of a new manufacture. The 35 Case of Monopolies (*see Gordon on Monopolies*, at pp. 226 and 231) is the earliest authority as to the reason for the grant; and the grant of the sole right to import was held to be bad, because it was not for the advantage of the public, but for private gain. *Mansell's Glass Patent* was specially saved by the Statutes of Monopolies (1 Webst., 17); but there it was held that the Patent was void at 40 law on account of the way in which it had been used. [WARRINGTON, J.—The result was that the Crown said that it would not undertake the defence of the Patent, and left it to the Common Law.] Yes, on the ground that the Patent had become prejudicial to the public. The new Patent granted declared that the old Patent was bad at Common Law. The Statute of Monopolies was founded on the 45 Declarations of James I. In Sections 5 and 6 "inventor" has always been held to include an importer of a new manufacture from abroad, as well as a person making an invention. The Statute was merely declaratory. *The Universities of Oxford and Cambridge v. Richardson* (6 Ves, 689), at p. 712, shows that if the Patentees had been proved to have used their grant contrary to the interest of 50 the commonwealth, the Patent would have become void. A Patent, though originally good, must not be used so as to become against the interest of the commonwealth. [The Form of Letters Patent in the first Schedule to the Patents, &c., Act, 1883, was referred to.] The grant is to "make 55 "use, exercise, and vend"; if it was "or vend" it would be invalid.

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[WARRINGTON, J.—Do you say that a Patentee must exercise all his rights?] If he uses his Patent, not for the purpose of introducing a new manufacture, but for the purpose of stopping a new manufacture, the Patent becomes bad. The proviso to the form of Letters Patent says, that if at any time during the term it shall be shown that the grant is prejudicial to the public, it shall determine. In *R. v. Eston* (2 Dyer, 197) it was held that a Patent conferring an office was bad, because the office was not exercised. Patents for inventions are not different from other patent grants, and become void if not properly used. Under Section 26 (3) of the Patents, &c., Act 1883 every ground on which a Patent might have been repealed by *Scire facias* is to be available by way of defence to an action for infringement. In *R. v. Eyre* (1 Strange 43) the user of a Patent was held to be prejudicial and the Patent was revoked. Publication of the Specification is not the consideration for the grant, it is merely one of the conditions. *Feather v. The Queen* (35 L.J.Q.B. 200 at pp. 205 and 207), shows that a Patent grant is construed so as to carry out the intention of the Crown in granting it, and against the grantee. [Coke's Institutes, Part III., Ch. 85, p. 184 were referred to.] In the present case the witnesses admit that there never was any intention to manufacture in this country. A Patent must be for a "new manufactures," Section 6 of the Statute of Monopolies; for whenever a Patent is granted, one must go back to that Statute to see whether it is valid. It is the "sole working or making" of new manufactures which is saved by the Statute. Infringement by selling only is a modern development of the law and is founded on the grant to the Patentee of "the whole profit and advantage" of the invention. A Patent is not granted for an article, but for the production of it. The invention is the producing. The policy of the Patent law is the employment of the people; this would not be encouraged if a Patent were for an article. A Patent for the sole right of importing was held to be bad, because it took employment from the people. In the present case the Patent is bad, first, because the Patentee never had any intention of manufacturing in this country, and secondly, because it has been misused. The provisions as to compulsory licences are very expensive and are not an adequate remedy. [WARRINGTON, J.—Is the manufacture in this country the only advantage of the Patent to the public?] No; the use of the dyes is an advantage, but the Plaintiffs only introduce them under extravagant terms. *Mansell's* case, and the *Universities* case (*ubi supra*) show that an exorbitant price avoids a Patent.

Abbott for *Walter Thompson*, the *Star Chemical Company*, and *William Thompson* adopted the above arguments, and contended that there was no evidence against those Defendants.

Counsel for the Plaintiffs were not called on to reply.

WARRINGTON, J.—This is an action for infringement of two Patents, the first being No. 14,723 of 1891, and the second being No. 9633 of 1892, and those two Patents are vested in the present Plaintiffs, the *Badische Anilin und Soda Fabrik*. The action is brought against three sets of Defendants. In the first place it is brought against the Limited Company, and the members of the firm, the Limited Company being *W. G. Thompson & Co., Ltd.*, and the firm being the firm of the like name: they are the Defendants, *William Goulden Thompson*, *William Gregory Thompson*, and *George Nicoll*. It is also brought against certain other Defendants, the *Star Chemical Company*, *Walter Thompson*, and *William Thompson*. As to them, I can deal with the matter by saying that there is no evidence of infringement against them. Lastly, it is brought against the *Basle Chemical Works*. I have only to deal now with the case against *W. G. Thompson & Co., Ltd.*, and the firm they represent,

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The Patents in question refer to two aniline dyestuffs, which are called the "Safflower Red 6 G," and the "Safflower Red G." It is proved or admitted that the *Basle Chemical Works* have supplied to the firm of *W. G. Thompson & Co.*, and to the Limited Company, considerable quantities of dyestuffs made in accordance with those two Patents, both the "Safflower Red 6 G" and the "Safflower Red G." In other words, infringement of the two Patents has been proved or admitted by the Limited Company and by the firm.

The case raised by the defence is one of a most unusual character. Each Patent is admitted to be useful; it is admitted that the invention is properly described in the Specification; it is admitted that there is no anticipation. Therefore, so far as all the ordinary grounds upon which the question of validity or invalidity is discussed in this Court, it is admitted that the Patents are valid. But the Defendants raise this Defence, which I will state shortly without reading the Particulars of Objections. They say the Patentee never intended to manufacture, and does not manufacture, the dyestuffs in this country, and makes use of his Patents to prevent other persons from doing so; and they say, further, that he makes use of the privilege granted to him by the Patents—to put it shortly—by selling the dyestuff at an exorbitant and unreasonable price, and to the serious disadvantage of our people as compared with the people in certain other countries in which the dyestuff is sold at a lower price.

So far as the facts are concerned I have this:—The Plaintiffs have never manufactured in England. The ground which they put forward as the reason for their not having manufactured in England is that alcohol forms an important element in the manufacture of this product, and that the Excise laws in England impose such a duty upon alcohol as that the manufacture cannot be carried on at a profit in this country. Whether their reason be a good or a bad one does not really concern me; but, at all events, it is not an unreasonable one, and it commends itself as having some reasonableness behind it. I think I must infer also that from the first they never intended to manufacture in this country. I have it also proved that the dyestuffs are sold in this country at a price considerably higher than that at which they are sold in certain other countries, and in particular I will take Switzerland as an example. But it happens that in Switzerland, and, as I gather, in all the other countries in which these dyestuffs are sold at a price considerably under that at which they are sold in this country, there is no Patent protection for chemical products, and so the Plaintiffs have to suffer from competition, and the consequence of that is that they are compelled in those countries, where they have competition, to sell at a lower price. So also in certain countries where they have protection they are exposed to more or less infringement, and according as the infringement is more or less, so again in those countries they are driven to make their prices lower or higher. Certain examples were given at a period some years ago when the stuff in this country was sold at 30s., and the infringing material was sold at 15s. I am asked to infer from a comparison of these prices that the price charged by the Plaintiff Company was such an exorbitant and unreasonable price that on that ground alone the Patent ought to be declared void or revoked. I cannot on these facts come to any such conclusion. There may have been various circumstances affecting the manufacture of the patented article, and affecting the manufacture of the infringing article, which determined the price, and it is impossible for me on the facts, therefore, to come to the conclusion that the prices at which they have sold are so exorbitant and unreasonable as on that ground, assuming that the case of *The King v. Eyre*—and I only assume it for the moment, and do not express any opinion about it—is a general authority for the invalidity of a Patent where the Patentee makes use of it by charging an exorbitant and

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unreasonable price—assuming that to be an authority in the present case, I cannot on the facts come to the conclusion that the present case falls within that authority.

Am I to refuse to give the Plaintiffs relief on the other ground, which is the ground mainly put forward by Mr. Terrell and Mr. Gordon—namely, that the Patentee did not intend to manufacture, and does not manufacture, the articles in this country? It is put in this way. It is said that, *primâ facie*, all monopolies are bad at law; that at Common Law a monopoly was good if it was for the introduction of a new manufacture into this country by which employment was increased and the general prosperity of the country was contributed to. Mr. Terrell has referred me to certain authorities in support of that contention, and I think no one can doubt, that when the Case of Monopolies was dealt with in 1603, and when the Clothworkers' Case was dealt with in 1615, the employment of labour in the country was mainly that which was in the minds of the Judges, who expressed their opinions in those cases with reference to the granting of monopolies. But can I say that at the present time this Patent is to be bad because in that sense it does not introduce into this country a new manufacture? I observe in *Feather v. The Queen*, which was cited by Mr. Terrell and relied upon by him, and also relied upon by Mr. Gordon for another purpose, in a passage that was not read by Mr. Terrell or Mr. Gordon—on page 204—Chief Justice Cockburn said: "The granting of monopolies in respect of inventions was, however, held good at Common Law, on the ground that, by tending to promote inventions, it was in the end productive of advantage to the community," and it is noticeable, also, that the Patent itself is put upon that very ground. The recital is: "We, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend the request contained in the Petition."

May not the introduction of the invention be in that sense for the public good, although the article covered by the invention is not manufactured in this country? It seems to me that it may. The value of the article to the country is not only because it may be made in the country, but because wherever made it may be made use of in the country, and the manufactures to which it may be applied may therefore be improved. I think what I have just said is really sufficient for the purpose, but I ought to say this, that no case in modern days has been cited to me, nor indeed has any case since the Statute of Monopolies been cited to me in which it has been laid down, or even suggested, that a Patentee who does not make the subject of the Patent in this country thereby loses the protection afforded by the Patent; and I think the Court ought to hesitate long before it invalidates of its own authority the protection which is given by the granting of the Letters Patent. In fact it really comes to this, that the arguments addressed to me, sitting here to administer the law, were arguments which might more properly, if I may say so with respect, be adduced in another place where the law may be made. I have only to administer the law as it stands, and what I hold is that the Patent here is granted to the Patentee to make, use, exercise and vend the invention. It contains certain provisions which, it is sufficient to say, do not include a condition that he shall make the patented article in this country. I cannot hold that such a condition is essential to the validity of the Patent, and therefore, so far as the Defendants, the Limited Company and the firm, are concerned, I must grant the injunction asked for.

Cripps, K.C., asked for judgment against the Defendants, *W. G. Thompson & Co., Ltd.*, and *William Goulden Thompson, William Gregory Thompson*, and *George Nicoll*, for an injunction, an inquiry as to damages, delivery up of infringing articles, and costs, which, as regards Patent, No. 9633* of 1892, would be between solicitor and client, because a Certificate as to the validity of that

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Patent having, when in question, been given by *Wills, J.*, under Section 31 of the Act of 1883.

Terrell, K.C., contended that the Plaintiffs, having recovered damages against the *Basle Chemical Works*, they were not entitled to recover damages against the above Defendants, it being a case of joint tort-feasors; and, as to the 5 certificate of validity, that, under the circumstances, it was *ultra vires* of the Judge to grant it, the Patent having been held invalid by him as to one claim.

Cripps, K.C., contended that it was not a case of joint tort-feasors, and stated that there had been no judgment against the *Basle Chemical Works* in the present action, but that a sum of money had been accepted from them in 10 settlement of the Plaintiffs' claim in this and several other actions.

After considerable discussion, *WARRINGTON, J.*, decided against the contentions on the part of the Defendants, holding that he was bound to act upon the Certificate, and that the Plaintiffs were entitled to an inquiry as to damages, the costs of such inquiry being reserved. 15

Judgment was given accordingly, and a Certificate was given as to Patent, No. 14,723 of 1891, that the validity came in question in the action.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE KEKEWICH.

February 12th and May 9th, 1904.

B. WARSOP & SONS, LD. v. WARSOP.

- 5 *Action to restrain passing-off.—“Get-up” of Cricket Bats.—Name, address, and device.—Undertaking given by Defendant on Motion for interlocutory injunction to drop the device until the trial.—Injunction refused at trial.—Costs refused to Defendant by reason of wrongful use of word “registered.”*

10 *The Plaintiffs were old-established manufacturers of “B. Warsop’s Cricket Bats.” The Defendant, Alfred Warsop, who was formerly in the Plaintiffs’ employ, commenced to sell “A. Warsop’s World-renowned Cricket Bats,” stamped with his initial and surname, and with a device somewhat similar to that which appeared on the Plaintiffs’ bats. The word “registered” appeared on both bats, the Plaintiffs’ device being in fact registered as a trade-mark, but not the*
15 *Defendant’s, although steps had been taken to obtain registration.*

On the Plaintiffs’ Motion for an interim injunction, no Order was made on the Defendant undertaking to sell his bats without any mark except his name and the address “Marylebone.”

20 *Held, at the trial, that the markings on the two bats were so distinct that it was impossible for an average man about to purchase a cricket bat to be deceived into thinking that the Defendant’s bat was the Plaintiffs’; and the action was dismissed, but without costs, by reason of the Defendant’s wrongful user of the word “registered.”*

25 *In January 1904, B. Warsop and Sons, Ltd., commenced an action against Alfred Warsop for an injunction to restrain him from carrying on the business of a maker or seller of cricket bats under the name of “Warsop,” so as to represent that the Defendant’s business was the business of the Plaintiff Company, and from using the word “Warsop” in connection with the making or selling of cricket bats without clearly distinguishing such bats from those of*
30 *the Plaintiff Company.*

The Plaintiff Company and their predecessors in business had for thirty years past carried on in Marylebone, under the name of “B. Warsop & Sons,” the business of makers and sellers of cricket bats, which had been founded by one Benjamin Warsop, and it was their practice to impress and stamp all cricket bats

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made and sold by them with the words "*B. Warsop, Marylebone*," on the face of each bat at each side of the splice, and with a circular trade-mark bearing round its edge the words "*B. Warsop's Conqueror patent spring handle*," and in the centre a device of a mounted gun, all a short distance below the splice; beneath this trade-mark was the word "registered." On their best bats the Plaintiffs had the words "Conqueror," or "Improved Conqueror," stamped on the back of each bat across the splice. The Defendant was a son of *Benjamin Warsop*, and for some time prior to April 1902 was a director of the Plaintiff Company, and from April to November 1902 was also in their employment, his share of the business being that of selecting the willow for the bats. In November 1902, the Defendant started business as a timber merchant under the name of *A. Warsop*, in Culworth Street, St. John's Wood, in the parish of Marylebone, and he shortly afterwards began to sell bats which were made for him by one *Trimmings*, of Bedford. These bats had impressed or stamped on them the words "*A. Warsop, Marylebone*," in the same type and position as the words "*B. Warsop, Marylebone*," on the Plaintiffs' bats, and had also impressed or stamped on them a circular trade-mark of the same size and in the same position as the Plaintiffs' trade-mark, with the word "registered" thereunder. The Plaintiffs' mark was in fact registered as a trade mark, but the Defendant's was not. Representations of the Plaintiffs' and Defendant's marks are given below. It appeared, however, that the Defendant had made arrangements with his manufacturer, *Trimmings*, for the latter's trade mark agent to obtain registration, but



this had not been effected at the date of the trial. Round the edge of the Defendant's trade-mark were the words "*The World-renowned*," and the inner space was filled up by a somewhat crude map of the world.



In January 1904, a written order was sent by one *Winter Robinson* to the Defendant for "three Warsop's World-renowned Conqueror Cricket Bats," and the Defendant, in response, supplied three bats invoiced by him as "*A. Warsop's World-renowned Bats*." Altogether the Defendant had sold about one dozen of the bats complained of.

On February the 12th 1904, the Plaintiffs moved before Mr. Justice KEKEWICH for an interim injunction.

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Stewart Smith, K.C., and Stokes (instructed by *Dod, Longstaffe, Son, and Fenwick*) appeared for the Plaintiffs; *H. J. Turrell* (instructed by *Seeley and Son*) appeared for the Defendant.

Stewart Smith, K.C., opened the Motion, and suggested that the matter should stand over till the trial on an undertaking by the Defendant not to carry on business under the name of "Warsop" except in conjunction with his full Christian name, and not to stamp the bats with his device.

Turrell, for the Defendant.—The Defendant has already offered to take off the trade-mark, to which he does not attach any importance. That should be sufficient without altering the name; the Defendant calls himself "*A. Warsop*," which is his own name, and the Plaintiffs are called "*B. Warsop*."

KEKEWICH, J.—If the Defendant takes the trade mark off altogether, I should probably not grant an injunction at the present time. I am only now considering what ought to be done immediately. I reserve my full liberty, when the matter is gone into more thoroughly, and I have more evidence. What strikes me as the great cause of offence at the present moment is the device or trade mark. Having regard to the authorities, it is quite clear that I cannot restrain the Defendant from trading in his Christian name and surname. There is no doubt about that. If the Defendant now undertakes to take off the device or trade mark without prejudice to any question at the trial, I think that is all I ought to do at present. If the Defendant does that, the similarity will be very much destroyed, but I must not be taken as saying that is enough. If, in addition, he were to put "*Alfred*," there ought to be an end of it. But at present, without any decision, there will only be the undertaking by the Defendant to sell his bats without any mark whatsoever except *A. Warsop* and "*Marylebone*."

The Defendant having given an undertaking to that effect, no order was made on the Motion.

The action came on for trial before Mr. Justice *KEKEWICH* on the 9th of May 1904. The same counsel appeared for the Plaintiffs; *P. O. Lawrence, K.C.*, appeared with *Turrell* for the Defendant.

Stewart Smith, K.C., opened the Plaintiffs' case, and called evidence in support of it.

KEKEWICH, J.—I am in the Defendant's favour on the merits of the case, but I am minded to deprive him of his costs having regard to the stamping of the word "registered" under the trade mark on his bats.

Lawrence, K.C.—This Defendant should not be deprived of his costs for an offence which, if it is an offence, is a technical one, and is provided for by the Merchandise Marks Act. To deprive him of his heavy costs of this action, as compared with the possible fine under that Act, would be a strong thing to do when he has done the Plaintiffs no injury and cannot be said to have injured the public. This is not a case where the Defendant has used the word "registered" with no intention of registering the trade mark. Admittedly, if the Defendant were a Plaintiff, this fact would disentitle him to an injunction, but even then he would be able to obtain damages—per *Vaughan Williams, L.J.*, in *Jamieson & Co. v. Jamieson* (15 R.P.C., 169, 191). But this Defendant has not come to the Court of himself. He has been dragged into Court, and, being successful in his defence, is entitled to his costs.

Stewart Smith, K.C., in reply.—The Plaintiffs are entitled to an injunction on the ground that the Defendant's bats are calculated to lead the public into the belief that they are the Plaintiffs' bats, in the judgment both of persons who are accustomed to handle these goods, and, as we submit, of the eyesight of the Court. As to costs, if the Court refuses to grant an injunction, the Defendant should at any rate be deprived of his costs. [*KEKEWICH, J.*—The only thing I hesitate about is that I do not recollect any precedent for depriving a successful Defendant of his costs.] It is stated that there is jurisdiction in *Sebastian on Trade Marks* (4th Edit.), p. 220, on the authority of cases

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on which we rely—*Paine v. Daniells & Sons' Breweries, Ltd.* (10 R.P.C. 71, 82), *In re Bradley* (9 R.P.C. 205), and Section 105 of the Patents Act, 1883. For this purpose there is no difference in moral culpability between a Plaintiff and a Defendant.

Lawrence, K.C., in reply on the cases cited.—The cases referred to are distinguishable on the facts. Without denying the jurisdiction, we submit that, looking at the innocent user and general conduct of the Defendant in this case, the Court, in the exercise of its discretion, should not deprive him of his costs of the action.

KEKEWICH, J.—There are before me two cricket bats, and the question which I have to decide is whether one is to be regarded as an attempt to pass off the goods of the maker of that particular bat as the goods of the maker of the other. So many of these cases have been before the Court, and I have myself quite lately gone into all the authorities, that I do not propose to treat them at length now. My duty is to decide this case according to the principles laid down in the case which was cited just now for another purpose, of *Jamieson and Co. v. Jamieson* (15 R.P.C. 169), where the principles are fully stated by the *Master of the Rolls*, and I think also by Lord Justice *Vaughan Williams*. Also I must not forget the two or three other cases, one before me, and two before other Judges known as the Coffee Tin cases, one of which went to the House of Lords. The principles are to be found there determining the class of thing you are to look for, and the evidence you are to rely on; but in a case of this kind it really comes back to the judgment of my own eye, assisted by such knowledge as I may presume myself to possess respecting the average man. The average man will be found playing cricket as well as in other occupations, and I am not to look merely to the unwary purchaser, certainly not to the skilful expert, but, as I understand the authorities now, to the average man who is about to purchase a cricket bat, and consider whether he is likely to be deceived.

These two cricket bats have a great deal in common. They are very similar—so much so that an extremely unwary man, or a child, would certainly look upon one as merely the duplicate of the other. They have a great deal in common; but one must bear in mind that they necessarily have a great deal in common. They are cricket bats; they are instruments intended to be used in the game of cricket, and they are instruments intended to be used by grown-up persons, and in playing cricket according to the ordinary rules of the game. Therefore, to begin with, they must have this in common, that they must be of one size that they must be of one length, and really be so like one another, that, apart from any stamping on them, it will be impossible to tell one from the other. Of course there may be a slight difference in the grain of the wood, or a slight difference in colour, and so forth; but substantially they are bound to be very much like one another.

That brings me to see what the difference is in the stamps on them, and what there is in common. The first thing that strikes me, of course, is that they are both marked "*Warsop*." That of course indicates—the evidence tells me so, and I might also jump to the conclusion—that the bat is made by a man of the name of *Warsop*. I find out that one of them is "*A. Warsop*," and the other "*B. Warsop*," indicating different Christian names. If there is one thing more settled than another, it is, I think, as was laid down by Lord Justice *Knight Bruce* in *Burgess v. Burgess* (3 De G. M. & G. 903), that every man is entitled to trade in his own name, and not the less because it was the name of his father before him. *A. Warsop* is entitled to make bats and sell them in his name, and *B. Warsop* is entitled to make bats and sell them in his name. What *A. Warsop* must not do is to make and sell bats in such a manner that his customers will be induced to believe that he is selling bats made by *B. Warsop*. Unless he takes sufficient pains to distinguish his bats from those of *B. Warsop*, he may find himself under the jurisdiction of the

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Court. But here *B. Warsop* thinks "B" is sufficient to distinguish him, and surely he cannot say that "A. Warsop" is not sufficient to distinguish the Defendant. Then they each add the word "Marylebone." Well, it is not difficult to guess why the word "Marylebone" is added to a cricket bat, but
5 that certainly ought not to be added except by those who have some connection with Marylebone. Now, both of these gentlemen carry on business in Marylebone, and, therefore, nothing can be said about that. Really, we are driven to these marks which are below the splice, which at first sight are very similar. I mean at first sight from a reasonable distance, because they are both marks with two concentric circles of a similar size, and they have both included in the inner of the two concentric circles something which it is not easy to distinguish till you look closely at it, and in the interval between the two circumferences there is writing which it is not easy to read at a distance. When you come to look closely into them, both the figures inside the inner
15 circle, and the writing between the two circumferences, are quite different from one another. On the Plaintiffs' bat there is, in the inner circle, a figure of a gun on a carriage, and underneath the mouth of the gun there is a heap of balls, which, I suppose, are meant to be balls such as would be fired from the gun, and, except that the words, "Trade Mark," are there, that is the whole thing.
20 In the Defendant's inner circle, you have the figure of the globe. How much is intended to be represented of the globe it may be difficult to say, but certainly some part of the globe, and when you come to look at it closely enough to see what the distinction is, it is perfectly obvious that the globe has no more similarity to the gun, as is depicted here, than a real globe, such as is used for demonstrations in geography, is similar to a real gun. That disposes of that.
25 Then inside, between the two circumferences, the Plaintiffs have "*B. Warsop's* 'Conqueror Patent Spring Handle,' and the other does not contain *Warsop* at all, and has nothing but "The World renowned." In one case you have a description of the article intended to be sold, with a reference to the maker's name, and, in the other, you have nothing more than a legend, "The World
30 'Renowned.'" It is not meant as an adjective without a substantive to follow it; at least, I suppose not. It is merely a legend. It seems to me those things are so distinct one from the other that it is impossible for any ordinary average man to be deceived into thinking that the bat sold by the Defendant is a bat
35 manufactured by the Plaintiff. I am not forgetting the principles that I have to apply, and I do not wish to repeat them; but, after all, two circles are common as a figure—they are common to the trade—and when you see there is no greater similarity than that, I think the whole question is disposed of.

That being so, the Plaintiffs' case fails, and then arises the rather difficult
40 question about costs. The Plaintiffs' case failing, the Defendant in the ordinary course would have Judgment with costs; but he has seen fit to put on his bat under his Mark the word "Registered." The Plaintiffs have done the same. The Plaintiffs have done it because they have got a Registered Trade Mark, and they are entitled, if not bound, to put the word "Registered"
45 on. I will not say for a moment that the word "Registered" is put on the Defendant's bat because he found it on the Plaintiffs' bat, and was glad of the additional similarity. I do not think there is any reason for saying so. I will accept the Defendant's story that he intended to register his Mark; that he instructed somebody to take the necessary steps, and, in anticipation of doing
50 that, making the stamp, he had it made with the word "Registered" on it, and so far as he sold bats at all, he has sold bats with the word "Registered" on them. It is quite obvious he did that for a purpose. He did it, not intending in the first instance to use it until he was entitled to use it, but he intended, when he could use it, to put it forth to the world that it was a valuable article
55 registered in that way to attract attention in some way or other, and to enhance the value in the market of his cricket bat. That was his intention, and he has used the word before he has a right to use it. I do not accuse him of any direct

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fraudulent intent. I free him from that, but a man must take the consequences of his own acts, and he has done that which is certainly wrong. There is no question about that. In fact one of the arguments against depriving him of his costs is that under the 105th Section of the Patent Act of 1883 he is liable to a penalty, and that that is the real and right remedy, and that it ought not to be enforced in a different way in this action. 5

Then it is also said that though plaintiffs have been deprived of their costs when they have used the word "Patent" or "Registered," or done something wrong, there is no real authority for so depriving a defendant; and, more than that, a plaintiff is only deprived in a Court of Equity, and the authority of Lord Justice *Vaughan Williams* in *Jamieson and Co. v. Jamieson* is cited for this proposition (15 R.P.C. at p. 191), that though he might lose his right to an injunction, he might still retain his right to damages in an action for damages. It is not for me to doubt the complete accuracy of the Lord Justice's law, and as long as that stands I suppose a plaintiff is entitled to recover damages, because the question of coming into Court with clean hands is not to be considered in an action for damages. In other words, the way it has been put in a mere action for damages is that the Plaintiff is suing for a wrong done to him, and it is no answer to him to say that he himself has not behaved properly. Of that there is no question between plaintiff and defendant when it is put on that ground. 20

I have turned to the case cited by Lord Justice *Vaughan Williams*.* It is a case which came before me a great many years ago, and is a case very well known, though it is not reported in the Law Reports. In that case the plaintiffs sued the defendants for passing-off with regard to cigars, and a more deliberate case of copying by defendants I suppose was never proved in any Court. I was carried away by the impudent copying by the defendants, and did not pay proper attention to the counter iniquities of the plaintiffs, but the Court of Appeal decided the case, reversing my decision entirely on that ground. The plaintiffs, though there was a shocking copy of their boxes and get-up, and everything, had advertised, and were selling as "Havana Cigars" cigars which were made in Germany, in boxes made in Germany, and therefore they were deceiving the public. In giving judgment, Lord Justice *Cotton*, on p. 685 of 3 Times Law Reports, said this:—"The proper course for a Court of Law, and still more for a Court of Equity, was to refuse to protect any person "who sailed under false colours." It seems to me, with great respect to Lord Justice *Vaughan Williams*, it has nothing to do with coming into equity with clean hands as a personal question between the plaintiff and defendant, but that the Courts regard the rights of the public, and that the policy of the law is only to assist those who act rightly. Lord Justice *Cotton* further said:—"The "mere fact that there were other persons in the trade who committed the same "imposition, or rather he would say the same attempt to impose upon the "public, did not authorise the Court to interfere in a case like this, where there "has been a false representation as to the origin and manufacture of the article "sought to be protected." Lord Justice *Bowen*, in concurring, said:—"Why "this elaborate concatenation of pictorial lies except for the purpose of deceiving "the public?" So that the Court there did not put it on the question between the plaintiff and the defendant, but put their decision on the deceiving the public. I cannot conceive myself any reason that prevents my applying that principle to a defendant as well as to a plaintiff. In that case the Court dismissed the plaintiffs' action. They did not grant an injunction. If a plaintiff cannot have relief because he has deceived the public, why is a defendant to if he has deceived the public. It cannot give a plaintiff a right to an injunction, and why should not a defendant suffer if he has deceived the public? 40 45 50

Mr. *Sebastian*, in the last edition of his book, says that it has been done, and he refers to two cases which I am not disposed to say much about. One, I think, 55

* *Newman & Co. v. Pinto & Sons*, 3 T.L.R. 685; 4 R.P.C. 508.

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is hardly in point, and the other *Paine v. Daniells & Sons' Breweries, Ltd.* (10 R.P.C. 71 and 217; L.R. 1893, 2 Ch. 567), is a case that went to the Court of Appeal from me, and my decision was reversed. It would not be right, and certainly I should be reluctant to dwell upon anything said by me in a case
 5 which, on its merits, was upset in the Court of Appeal. I have looked through it. It will probably be found that what was said on the question of the costs was never touched at all. The case having gone, the remarks must be taken to have gone with it, but I think that in principle what Mr. *Sebastian* puts in his book as having been decided is what ought to have been decided. Here is a man who
 10 comes and says I am not bound to come into Court with clean hands. That, I agree, only applies to a plaintiff, but he comes here bound to show that his bat has not a get-up that infringes the Plaintiffs' rights, and, at the same time, he exhibits it, and we see that he has been deceiving the public by using the word "Registered." I do not think one ought, in protecting the rights of the public,
 15 to give that man, though successful, his costs of the action, and, therefore, there will be judgment for the Defendant without costs. I shall be very glad to have that point discussed, and decided elsewhere.*

IN THE HOUSE OF LORDS.

Present—THE LORD CHANCELLOR, LORD MACNAGHTEN, LORD JAMES, and
 20 LORD LINDLEY.

February 19th, 22nd and 23rd, and May 16th, 1904.

LEEDS FORGE COMPANY, LD. v. DEIGHTON'S PATENT FLUE AND TUBE COMPANY, LD.

Patent.—Action for infringement.—Infringement found.—Injunction granted
 25 *at the trial.—Injunction dissolved by the Court of Appeal.—Appeal to the House of Lords allowed.—Judgment at the trial restored.*

The owners of a Patent for "An improved boiler flue" sued the Defendant Company and its directors for infringement. The Patentee claimed: "A boiler "flue or furnace consisting, as to its general form, of a series of annular or

* See *Estcourt v. Estcourt Hop Essence Co.*, L.R. 10 Ch. 276.—J. C.

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"partially annular flutings connecting a corresponding series of sharp ridges." The Defendant's flue had corrugations, which the Plaintiffs contended were ridges, and also a subsidiary corrugation between these. It was contended by the Defendants that their corrugations were not similar to the sharp ridges claimed by the Patentee, and that this and the subsidiary corrugations so differentiated the Defendants' flue as to take it outside the claims in the Plaintiffs' Specification. At the trial it was held that the Defendants had infringed, and an injunction was granted. The injunction was suspended until the 1st of May 1901 to enable the Defendants to apply to the Court of Appeal. On such application the injunction was by consent stayed pending the appeal. On the appeal being heard, the Court of Appeal held that the Defendants had not infringed, and the appeal was allowed. The Plaintiffs appealed to the House of Lords.

Held, reversing the decision of the Court of Appeal that the Defendants had infringed, and that the judgment of the Judge at the trial be restored with costs.

On the 23rd of May 1889 Letters Patent (No. 8591 of 1889) were granted to Edwin Chambers John Devis for "An improved boiler flue."

The Complete Specification was as follows:—"The object of this invention is to provide a form of internal boiler flue at the same time capable of withstanding high working pressures and of more efficiently transmitting heat than the flues generally used for high pressures.

"Flues formed of plain cylindrical portions alternating with stiffening rings, and those of barrel section are necessarily of comparatively thick metal and inefficient in proportion, while those formed of close pitched corrugations are of thinner metal but, on account of the closeness and depth of the corrugations, a large part of the surface is comparatively sheltered from the heat, both of radiation and conduction, and inefficient in proportion.

"By my invention both these objections are, to a large extent, eliminated by forming along the flue a series of ridges of sharp section and at a wider pitch than that of the corrugations of an ordinary corrugated flue and strengthening the metal between such ridges by what may be called suspension from them.—That is to say, the flue is constricted in diameter between ridge and ridge, forming a series of annular or circumferential flutings whose depth is small compared with their width, thus allowing of direct exposure of all parts to the radiant heat and to contact of the hot gases.

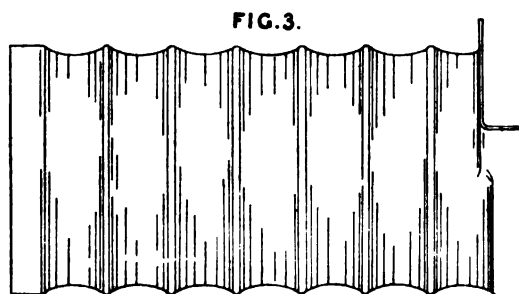
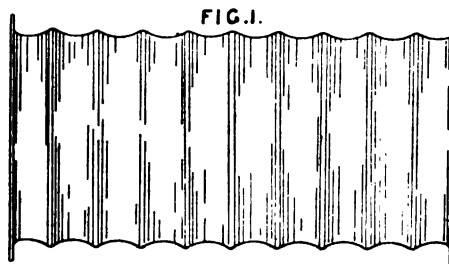
"The metal at the ridges may, if desired, be made thicker than elsewhere, and besides the advantages already mentioned I claim that these tubes will be stiffer longitudinally than corrugated tubes.

"Fig. 1 of the accompanying drawings shows my invention as applied to the flue tube of an ordinary land boiler. In this case I do not consider it necessary to incur the expense of thickening the metal at the ridges and the section is as shown in the enlarged view, Fig. 2, the pitch or width of the flutings being from six to nine inches and the depth about an inch and a half. Fig. 3 shows my invention as applied to the furnace tube of a marine boiler where the ridges may be advantageously thickened as shown in Fig. 4, which is an enlarged view of part of the same. In this case the pitch or width of the flutings may be made greater, say eight to twelve inches, and the depth about two inches.

"I do not, however, limit myself to the dimensions stated, as the best proportions can only be determined by experience and careful trials.

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- "The flutings may be formed by rolling, by suaging by means of a hydraulic press or steam hammer, by fluid pressure direct on to the plate pressing it on to a single die, or by the indirect fluid-pressure process to which my Letters Patent No. 5122 of 1888 relate. They may all pass entirely round the tube or
- 5 "some may be intersected by plain parts for the attachment of cross tubes, furnace bearers, &c., and in some cases there may be partial flutings where the tube is incomplete, for instance, under the combustion chamber of a marine boiler, as shown by Fig. 3. In other cases the flutings may be carried round the upper part of the tube only, the lower part being formed of a plain plate if
- 10 "a complete tube is required."
- The claim was :—"A boiler flue or furnace consisting, as to its general form of a series of annular or partially annular flutings connecting a corresponding series of sharp ridges."



- This Patent became vested in the *Leeds Forge Company, Ltd.*, who on the
- 15 8th of March 1900 commenced an action for infringement thereof against *Deighton's Patent Flue and Tube Company, Ltd.* and *William Deighton, Lawrence Clayton, Joseph Hartley, Joseph Clayton, and John R. Pickering*, directors of the Defendant Company. At the trial no evidence was given as to any acts of the directors.

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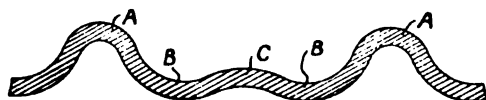
By the Statement of Claim the Plaintiffs alleged that they were the registered proprietors of the Patent, and that the Defendants had infringed. The usual relief was claimed.

The Particulars of Breaches as amended were as follows :—“(1) Prior to the issue of the writ in this action, and subsequent to the date of the Letters Patent in the Statement of Claim referred to, the Defendant Company have infringed the said Letters Patent by the manufacture, sale, offer for sale, and use of corrugated steel furnaces or boiler flues constructed according to the invention described in the Final Specification of the said Letters Patent and claimed in the claiming clause thereof. The Defendants other than the Defendant Company are the directors and officers of the Defendant Company, and take an active part in the management of the Defendant Company, and are directly concerned in and about the manufacture and sale and offer for sale of the said furnaces and boiler flues, and are personally liable as infringers of the Plaintiff Company's said Patent. (2) In particular the Plaintiffs complain of the manufacture and sale by the Defendant Company in or about the month of August 1899 to Messrs. *George Fletcher & Sons*, of Bowling Green Street, in the city of Sheffield, of a corrugated steel furnace constructed as aforesaid. The Defendants other than the Defendant Company are personally connected with the said manufacture and sale in manner aforesaid.”

By their Defence delivered on the 19th day of December 1900 the Defendants (1) denied that the Plaintiffs were owners of the Patent; (2) denied infringement; and (3) alleged that the Patent was invalid.

The Particulars of Objections alleged that—(1) The alleged invention was not new at the date of the Letters Patent, but had been published in the following Specifications :—*Samson Fox* (No. 1097 of 1877); *Hopkinson* (No. 3258 of 1880); *Hopkinson* (No. 2683 of 1885); *Purves* (No. 2974 of 1885); *Meredith* (No. 4834 of 1886); *Adamson* (No. 534 of 1887); *Robertson* (No. 11,666 of 1887). (2) The invention had also been published by the public manufacture and exhibition of corrugated boiler flues at the Leeds Forge, Leeds, in or just before the year 1887 as follows (a description followed). (3) The alleged invention was not useful. (4) Having regard to the state of public knowledge at the date no invention was required to produce the arrangements described and claimed in the Specification, and the Patent was invalid by reason of want of subject-matter. (5) The Complete Specification did not particularly describe and ascertain the nature of the said alleged invention and in what manner it was to be performed. No sufficient directions were given for the formation of a series of annular flutings connecting a corresponding series of sharp ridges as described and claimed in the said Specification.

The subjoined drawing shows a section of the Defendants' flue :—



A shows the main outward corrugations, the metal between taking an inwardly curved sweep as indicated at B, and a slight outwardly curved sweep as shown at C, so as to form supplementary corrugations.*

* See the Specification of *William Deighton's Patent* for "Improvements in Boiler Flues and Fire Boxes" (No. 15,670 of 1896).

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The action was tried before Mr. Justice *Cozens-Hardy* on the 18th, 19th and 20th of March 1901, who granted an injunction against the Defendant Company, but not against its directors, the action being dismissed against them without costs. The injunction was stayed until the 31st of May 1901, to enable the Defendants, if they appealed, to apply to the Court of Appeal as to a further stay.*

The Defendant Company appealed, and on the 26th of April 1901, by consent, an Order was made by the Court of Appeal staying the injunction pending the appeal on terms arranged between the parties, which terms were embodied in the Order.

The Plaintiffs subsequently moved to commit certain officers of the Defendant Company for alleged breaches of the consent Order. The motion was heard on the 15th and 25th of January 1902, no Order being made except that the Defendants should pay the costs of the motion, the Defendants giving a certain undertaking.

The appeal in the action came on for hearing on the 4th March 1902. The Court of Appeal, on the 7th March 1902, allowed the appeal, deciding that the Defendants had not infringed.†

The Plaintiffs appealed to the House of Lords.

The appeal came on for hearing before the House of Lords on the 19th February 1904.

Moulton, K.C., *Bousfield*, K.C., *A. J. Walter* and *H. A. Colefax* (instructed by *Vincent and Vincent*, agents for *Day and Yewdall*, of Leeds), appeared for the Appellants; *T. Terrell*, K.C., and *J. C. Graham* (instructed by *Harrison and Davis*, agents for *Ramsden and Carter*, of Leeds) appeared for the Respondents.

Bousfield, K.C., for the Appellants.—The action is for infringement of a Patent for boiler flues. *Cozens-Hardy*, J., gave judgment in favour of the Plaintiffs. His judgment was reversed by the Court of Appeal. *Devis*' Patent represents the high water mark of ingenuity and experience. The boiler flue is cylindrical in form, with corrugations of sharp section. A broad sweep is thus obtained between the sections, and the loss of heating surface and risk of collapse obviated. The deposit of scale is greatly diminished, and the consequential overheating and "pocketing" of the metal are no longer present. The oldest form of boiler flue was a plain cylinder. Later, cylinders were strengthened by being made in sections, with stiffening rings at each section. In 1877, *Sampson Fox* invented the corrugated section. This had great advantages, but also many disadvantages. The Patents of *Purves* and *Adamson*, relied upon by the Court of Appeal, as well as the Patent of *Fox*, were all subject to the disadvantages of (*inter alia*) loss of heating surface, overheating in parts, and "pocketing." The effect of the improved form of *Devis* is that, whereas 30 per cent. of *Fox*'s flues collapsed between the ridges, none of *Devis*' have failed. They have been used by the *Cunard Company*, the *White Star Line*, and the *Peninsular and Oriental Company*. The sharp ridges hold the metal between the sections in suspension. The Respondents' flue is made according to the *Devis* Patent, but it has a hump between the sections. The hump serves no purpose, except to get outside *Devis*' Patent. An additional advantage of *Devis*' Patent is that the corrugations can be "rolled in" from the cylinder. [Models of the flues were produced, and the "rolling in" process demonstrated.] A point was raised in the Court of Appeal that the Appellants' flue was not in practice made according to the Specification, inasmuch as the ridges were not made "sharp," nor as sharp as in a flue put in evidence in the Court of Appeal, manufactured by *John Brown & Co.*, the Applicants' licensees. But the Court of Appeal was misled. *John Brown & Co.* produced the sharper

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ridges by a particular method of manufacture, and not by rolling in. "Sharp" is a relative term, and the degree of sharpness depends upon the mode of manufacture. The *Devis* invention could not have been got from *Fox*. The Court of Appeal took the view that *Purves* and *Adamson* reduced *Devis*' invention to a narrow point, and that nothing but the exact thing described in the Specification could come within it. *Purves* differs from *Devis* in that it cannot be manufactured by the method used by the Appellants, and in that the metal between the ridges is not in suspension. *Adamson* is practically the same. [The learned Counsel read the reasons of the Judges of the Court of Appeal, and of *Cozens-Hardy, J.*, for their decisions.] The improvement effected by *Devis* appears to be a slight one, but it is important on the question of construction, for, when an alteration produces such remarkable practical results as *Devis*' Patent does, the substance of the invention must be regarded. The Court of Appeal have narrowed the construction by comparing the Specification with two prior Specifications which were failures. Things demonstrated to be impracticable, or shown to have gone out of use by reason of failure ought not to be held to narrow the construction of a Specification.

Walter, followed, and submitted that the Respondents had taken the substance of *Devis*' invention. The flue was made in the same way—i.e., by rolling in from a cylinder; for tests it was treated in the same way by the Board of Trade; the freedom from scale was the same; the heating efficiency the same; the suspension the same; and there was no difference of function between the two, and no appreciable advantage obtained by the introduction of the hump.

Terrell, K.C., for the Respondents.—The case is not one of words, but of things. The flues produced by the Appellants and Respondents respectively must be looked at. To ascertain what was in the mind of *Devis* when he drew his Specification, regard must be had to what was accomplished before. *Fox* had a cylinder with corrugations supporting the intervening valleys of metal. All sorts of corrugations have been adopted—namely, those of *Purves*, *Hopkinson*, *Adamson*, and *Robertson*. It is erroneous to say that none of the prior Patents were put into practice. A great many flues were manufactured under them. *Devis* never contemplated rolling from the cylinder. He contemplated rolling from the flat. *Devis*, by rolling, produces a concavity between the ridges, whereas the Respondents, by rolling, produce a convexity. The support of the valley in *Devis* is effected by pressure, but in the Respondents' flue it is produced by compression. The difference is material, for in *Devis* the flue has a tendency to shorten longitudinally, but in the Respondents' it has a tendency to lengthen, because of the outward curve or hump. The difference caused by the hump is of practical importance. The Respondents' ridges are very nearly the same as those of *Fox*. Instead of having a valley between the ridges, they have an outward curve. If *Devis*' invention is what is described and shown in the Specification and drawings it is new, but if it is sought to widen the construction, then the Appellants, in view of the anticipations, get perilously near invalidity. The case made in the Court of first instance was that the whole object of the invention was to avoid scale. But there is deposit of scale on every kind of boiler-flue, and there is nothing in the Specification to support the statement. The deposit of scale depends upon the kind of water used. As to the point about suspension of metal, whatever suspension there is was equally present in the previous Patents. A Patentee must be confined to his claim, and when he has described his invention, set out drawings, and distinguished it from things that have gone before, a fair construction must be given to the language. The Patent here is for a combination of ridges and flutings. When he used the words "ridges of sharp section" he meant sharp ridges and not relatively sharp with those in the flues previously made. It was contended that the figures in *Devis*' Specification must not be looked at, because the ridges

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could not in practice be made as sharp as indicated. But the flue produced by the Respondents in the Court of Appeal shows that they can be so made. The flues produced by the Appellants are not made in accordance with *Devis'* Specification. Again, the Respondents' flue has not a sharp section in the sense
 5 in which the flue can be made according to *Devis'* Specification. If the Specification of *Devis* is strictly construed, the Respondents have not infringed. The hump in the curve is of great practical importance. It prevents the shortening of the flue.

Graham followed, and compared the Specifications of *Purves*, *Adamson*,
 10 *Hopkinson*, and *Robertson* with that of *Devis* in order to show that, on a true construction of the Specification, the Respondents had not infringed.

Bousfield, K.C., was heard in reply.

LORD MACNAGHTEN.—My Lords, I have been asked by the LORD CHANCELLOR, who is unable to be here this morning, to read this Judgment for him.

15 LORD HALSBURY, L.C.—(Judgment read by Lord MACNAGHTEN).—My Lords, in this case, which is an action for the infringement of a Patent, the validity of which is not disputed, the real question is whether, what the Defendants have done is, or is not, an infringement, or, stating the question more precisely,
 20 whether the form of boiler flue which the Defendants are manufacturing is, or is not, within the patented inventions of which the Plaintiffs are the proprietors. In order to solve this question, one must see exactly what it is that the Patentee invented, and compare it with the alleged infringement. On the one side it is said that the real principle—the pith and marrow of the patented invention—
 25 the Defendants is merely colourable, and has no effect in substance at all. On the other hand, it is contended that it is not the same form which is manufactured by the Defendants, and that there is a real effect produced by the Defendants' form of manufacture, which differentiates it from the Plaintiffs'.

To render intelligible the dispute, it is to some extent necessary to look at the
 30 history of steam navigation in respect of the boiler flues which form part of the necessary machinery. The boiler used to have the flue in which the fire is placed in plain cylindrical shells, and it used often to collapse from pressure on one side, and from great heat on the other. Of course, the tendency to this misfortune was increased by the increase of pressure which improved types of
 35 engines rendered possible. A Mr. *Fox* invented a type of boiler flue, in itself a great improvement upon the plain cylinder, but as Sir *James Flannery* explained there was a great disadvantage arising from the fact of corrugation upon the surface. According to that gentleman a deep corrugation was a place in which scale would deposit by reason of the precipitation, under pressure and
 40 evaporation, of the solids which are in the water. The effect of this is very clearly described by the same witness. It prevents the heat passing into the water which is on the other side of the plate; the heat thus prevented passing, heats the plate of the flue to such an extent as to render it ductile or soft; it thus loses its strength, and being subjected to the pressure, results in what is
 45 called "pocketing" or depression of that part. I am paraphrasing rather than literally quoting the witness' evidence. He also describes the way in which *Devis* solved the problem of how to get rid of this source of danger. He invented the form of boiler flue which made the places where scale would deposit neither so deep nor so narrow, with the result that when the scale did
 50 deposit at all, it lay more thinly on the surface, and was accordingly less dangerous than when it was confined in a lump at the bottom of a narrow cavity.

My Lords, it is not necessary to go more minutely into the invention, its utility or inutility, for the reason I have already given. Indeed the practical
 55 evidence of its adoption by so many important Navigation Companies is itself the best evidence of its practical utility, and the same witness I have quoted

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says it was an improvement of a most decided character. Nor is it, I think, necessary, after your Lordships' decision in this House, to insist upon the principle, now sufficiently established, that a minute difference, if it makes the difference between success and failure, is enough to establish a patentable invention. It is, however, a perversion of that principle to suppose that where, as in this case, it is a question of the form of the thing invented, a mere difference of form while retaining the substance of the invention, will enable a person to appropriate the invention, and make the new variation a new invention. To my mind the Defendants' manufactured article is exactly the same as the Plaintiffs' in all which constitutes the merit of the invention; the only difference is a hump between the corrugations of *Devis'* invention. I do not think the Defendants have been able to make out that that hump served any useful purpose. It is a variation of form such as I think the evidence shows has no practical operation at all, and for the purpose of the argument here may be disregarded altogether.

The question then is resolved into a question of the true construction of the Specification. Two criticisms are made, one that the ridges or corrugation of *Devis'* Patent are not sharp, as to which I think it is a verbal criticism which rests upon a supposed definition of the word "sharp," to which I do not assent. In the use of human language, which is after all an imperfect instrument for the embodiment of human thought, the context and the subject-matter dealt with, must modify and expound to a very considerable extent the meaning of a word. I suppose it would be a very intelligible distinction to say that Mont Blanc was a flat mountain compared to Monte Rosa which is a sharp peak, though Mont Blanc is not flat and Monte Rosa is not sharp, in the sense of the word sharp, if you were speaking of a knife or a razor.

The other verbal criticism is on the word "suspension," and I do not deny that if one had not the form of the flue before one, and did not appreciate the theory upon which one piece of curved metal may give strength to another, it might be difficult to put into language the exact principle which the Patentee desired to point out, but if one looks at the Drawing, one sees directly what is meant by the word, and it can, I think, be defended upon the mechanical principles which regulate the strain to which metal in the shape devised by the Patentee is subjected.

It may be that the invention is simple; I think it is. It may be that the others forms went near, but they did not attain the success that followed *Devis'* invention. The practical fact seems to me the strongest evidence of the merit of the invention, and as I have said the sole question here is whether it has been infringed. I have carefully considered the addition of the hump, and if I thought it made any real difference one would have to consider what would be the effect of treating it as an improvement upon *Devis'*, but I think the evidence fails to show that it has any operation at all, and I therefore move your Lordships that this Judgment be reversed.

LORD MACNAGHTEN.—My Lords, I concur in the Lord Chancellor's Judgment.

LORD JAMES OF HEREFORD.—My Lords, I also concur in the Lord Chancellor's Judgment.

LORD LINDLEY.—My Lords, when *Devis* obtained his Patent for an improved boiler flue there were two types of boiler flues in existence, which have to be considered in this case, viz., first, plain tubes, and second, corrugated tubes. There were several varieties of plain tubes, viz. (1) simple tubes; (2) simple tubes strengthened by external bands of metal fastened round them at intervals; (3) simple tubes strengthened by being so rolled as to have rings or folds of the tube projecting outwards and round the tube at intervals, and which rings or folds strengthened the tubes and did little else. *Purves'* Patent and *Adamson's* Patent were for flues of this last kind. Their essential

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character is that the tubes between the rings or folds were straight, and that a line drawn on the tube from the apex of one ring or fold to the apex of the next ring or fold would not be a regular catenary curve such as is produced by a chain suspended between two points. In this type of flue a line drawn on the tube from the apex of one ring or fold to the apex of the next ring or fold would be straight at the bottom of the furrow between the ridges; and this straight piece of tube is liable to bulge inwards under the combined influence of great heat below and great pressure above. Corrugated flues were not open to this defect.

10 *Devis'* Patent is for an improved flue of the other type, *i.e.*, the corrugated type. In this type of flue there is no straight metal; all is curved. As originally patented by *Fox* the curves were regular and gradual round the tops of the convex ridges, and the bottoms of the concave furrows. *Devis* improved on this form: he made his convex ridges much sharper, and his concave furrows longer and shallower than in *Fox's* corrugated flues. The essential character of *Devis'* Patent is that the ridges are stronger than in ordinary corrugated flues, and that all the metal below the ridges is, as it were, suspended from them, so that the pressure on that metal is thrown upon and borne by the ridges. This prevents that bulging in the furrows which is the great defect in the *Purves* type of flue, and is a great improvement on the ordinary corrugated flue. The idea of suspension is made quite intelligible by looking at *Devis'* Drawings, which show the form of curve he had in his mind. It is a curve formed by a line drawn on the flue from the apex of one ridge to the apex of the next, and is a catenary curve such as is produced by a chain suspended between the apices of two adjacent ridges. This feature was a distinct improvement in flues for high pressure boilers; and *Devis'* Patent is recognised to be new and useful. Its validity is not now questioned by the Defendants. Your Lordships, have not, therefore, to consider the novelty or utility of *Devis'* invention, nor the sufficiency of his Specification.

30 There was, however, a great deal of controversy, and no little conflict of testimony about the idea of suspension as applied to the furrows between the ridges. The expression is not a happy one; but the idea intended to be conveyed by the Specification, and really conveyed by it, is that which I have endeavoured to describe, and is quite intelligible and not difficult to grasp.

35 The Defendants' flue differs from *Devis'* in one respect, and one only. The bottoms of the furrows between the ridges are bulged upwards so as to form convex humps. The furrows between two adjoining ridges are not flat as in *Purves'* or *Adamson's*, nor are they concave as in *Devis'* Drawings. They are convex. The question is whether this difference is substantial or immaterial. The Judge who tried the case considered the difference immaterial, and held that the Defendants had infringed *Devis'* Patent. The Court of Appeal were of a different opinion, and dismissed the Plaintiffs' action.

My Lords, the learned counsel for the Defendants contended that their flue was one of the first type to which I have alluded when speaking of plain flues. If this were so, I agree with them that there would be no infringement. But I cannot accept this view. The Defendants' flue appears to me to be one of the other type, *i.e.*, the corrugated type. It is a ridge and furrow flue. The idea of what may be called suspension which I have already explained, and which is the essential feature of *Devis'* Patent, underlies the Defendants' flue. This, I think, is clearly established by the expert evidence in the case, and by the casts and drawings (especially J.S. 6 and J.S. 7) produced before your Lordships on the hearing of the Appeal.

But then it is said that the Plaintiffs are tied down by their Specification and Drawings to an unbroken curve between each pair of adjacent ridges, and that those ridges must be sharp. What is meant by sharp in the claim is

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apparent from the body of the Specification and Drawings. The Specification describes "a series of ridges of sharp section, and at a wider pitch than that of the corrugations of an ordinary corrugated flue." When a subject-matter to which the Patent relates is understood, I do not myself feel any difficulty about the word "sharp." To my mind it obviously means sharp as compared with the convex ridges of an ordinary corrugated flue. The Defendants' ridges are sharp in this sense. 5

The real difficulty arises from the difference in the bottoms of the furrows between the ridges. If your Lordships had to deal with a registered design and not a Patent, it would, in my opinion, be impossible to hold that the Defendants' design was an infringement of the Plaintiffs' rights. The differences are too obvious. But when dealing with a Patent there is something more than shape or outline to be considered, viz., the practical end to be attained by the means described. *Devis* describes this end with sufficient clearness. After referring to ordinary corrugated flues and their defects, he says: "By my invention both these objections are to a large extent eliminated by forming along the flue a series of ridges of sharp section, and at a wider pitch than that of the corrugations of an ordinary corrugated flue, and strengthening the metal between such ridges by what may be called suspension from them; that is to say, the flue is constricted in diameter between ridge and ridge, forming a series of annular or circumferential flutings, whose depth is small compared with their width, thus allowing of direct exposure of all parts to the radiant heat, and to contact with the hot gases." The Defendants have, as already stated, a series of ridges such as are here described; they strengthen the metal between them as here described; what may be called suspension is to be found in the Defendants' flue, for the humps at the bottom of their furrows are, as it were, suspended from the ridges; the flues are constricted in diameter between ridge and ridge; a series of annular or circumferential flutings are formed, although not as shown in *Devis*' Drawings; their depth is small compared with their width; and there is direct exposure of all parts to the radiant heat and to contact with the hot gases. The annular or circumferential flutings here spoken of are drawn in *Devis*' Specification as continuous curves, whilst the Defendants shape them differently; but the difference in shape does not alter the fact that the end attained by *Devis* is attained by the Defendants, and in the way described by him. The Defendants' humps may or may not add strength to the bottoms of the furrows and be improvements on *Devis*' Patent. The evidence on this point is conflicting and I am not satisfied that they are really improvements. But even if they are improvements, the Defendants' flues appear to me to be made in accordance with *Devis*' Patent, and the humps are simply additions to what he invented and described. The Court of Appeal, I think, attached too much importance to the difference in the shape of the bottoms of the furrows, and too little to the fact that in every important point the Defendants' flues resemble *Devis*'. 10 15 20 25 30 35 40

The case is a difficult one, but having considered it carefully I have come to the conclusion that infringement is proved. To use the language of Lord Cairns in *Clark v. Adie* (L.R. 2 App. Cas. at 320, 321) the Defendants have taken the pith and substance of *Devis*' invention, although they have departed in one particular from the precise method in which he carried it out. *Proctor v. Bennis* (L.R. 36 Ch. D. 740),* and *Consolidated Car Heating Co. v. Came* (L.R. 1903, A.C. 509),† also illustrate this principle. 45 50

For the above reasons I am of opinion that the Appeal should be allowed, and the Judgment of Mr. Justice COZENS-HARDY be restored, and that the Respondents should pay the costs both here and below.

* 4 R.P.C. 333.

† 20 R.P.C. 745.

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The Order appealed from was reversed, and the Judgment of COZENS-HARDY, J., was restored, and the Respondents were ordered to pay the costs both in the House of Lords and below.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

5

Before MR. JUSTICE BUCKLEY.

June 23rd, 1904.

HASKELL GOLF BALL COMPANY v. ROBERT HUTCHISON and JOHN MAIN.

Patent.—Action for infringement.—Motion by Defendants to restrain advertisements by Plaintiffs.—Threats.—Due diligence.—Contempt of Court.—Motion dismissed.—Patents, &c. Act, 1883, section 32.

10

On the 19th of April 1904 the owners of Letters Patent commenced an action for infringement of the Patent, in which they delivered their Statement of Claim on the 20th of May 1904. On the 8th of June they issued advertisements containing threats, which were circulated among the customers of the Defendants and referred specifically to their goods. The Defendants moved in the action to restrain the Plaintiffs from representing by advertisements or otherwise that the Defendants' goods were infringements of the Plaintiffs' Patent, and they relied on section 32 of the Patents, &c. Act, 1883, alleging that the Plaintiffs had known of the sale of the Defendants' goods for eighteen months; they also alleged that the advertisements were a contempt of Court. At the date of the hearing of the Motion, on June the 23rd, the Defendants had not put in their Defence. The Plaintiffs had brought actions against other persons, who had submitted.

15

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Held (following Challender v. Royle, 4 R.P.C. 368), that "due diligence" in section 32 means after the threat and not after the acts complained of as infringements, and that no want of due diligence on the part of the Plaintiffs

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was proved; also that the advertisement was not a contempt of Court. The Motion was dismissed with costs.

On the 19th of April 1904 the *Haskell Golf Ball Company* commenced an action against *Robert Hutchison* and *John Main* for infringement of Letters Patent (No. 17,554* of 1898) granted to *Alfred Julius Boulton* for an invention 5 of "Improvements in balls for use in golf and other games."

The Statement of Claim and Particulars of Breaches were delivered on the 20th of May 1904.

By the Particulars of Breaches the Plaintiffs in particular complained of the manufacture and sale by the Defendants of golf balls known as "Springvale 10 "Eagle" and "Springvale Hawk" to certain persons in the Particulars mentioned in or before the month of April 1904.

On the 13th of June 1904 the Defendants gave notice of Motion for an injunction to restrain the Plaintiffs until the trial of the action from representing by advertisements or otherwise that the golf balls made and sold by the 15 Defendants as "Springvale Eagle" and "Springvale Hawk" were infringements of any valid Letters Patent belonging to the Plaintiffs.

No Defence had at the hearing of the Motion been delivered by the Defendants.

The terms of the advertisements complained of appear from the following 20 paragraphs of an affidavit made by *Claude Archibald Hutchison*, the Defendants' works manager, in which he also alleged the invalidity of the Patent and also non-infringement by the Defendants:—"(7) On the 8th day of June 1904 the "Plaintiffs caused to be inserted in a paper known as the 'Irish Golfer,' which 25 "is a paper with a large circulation, the following advertisement:—

"Important Notice.

"It has come to the notice of the *Haskell Golf Ball Company* that golf "balls known as the 'Springvale Eagle,' the 'Springvale Hawk' "are being offered for sale in the United Kingdom in infringement of Letters "Patent belonging to the *Haskell Company*. This is to give notice that 30 "actions have been commenced against the manufacturers of or dealers in "such balls claiming injunctions to restrain such infringements and damages. "And further notice is given, that the *Haskell Company* will enforce its rights "against all persons buying or selling or otherwise dealing in or using such "infringing golf balls. 35

"Wilson, Bristows, and Carpmael,

"1, Copthall Buildings,

"London, E.C.,

"Solicitors for the Haskell Ball Company.

"(8) The Plaintiffs have also caused circulars in the terms of the said adver- 40 "tisement to be sent to large numbers of dealers in golf balls, very many of "them customers of the Defendants. (9) The said advertisement and circular "set out in substance as a fact which is not true, and which is a statement "extremely injurious to the Defendants' trade, that 'Springvale Eagle' and " 'Springvale Hawk' golf balls are infringements of some valid Letters Patent 45 "belonging to the Plaintiffs."

Other affidavits were filed on the Motion, but it is not necessary for the purpose of this report to refer to the same, the facts sufficiently appearing in the judgment printed below.

Bousfield, K.C., and J. C. Graham (instructed by *Burton, Yeats, and Hart*) 50 appeared for the Defendants; *Moulton, K.C., Astbury, K.C., and A. J. Waller* (instructed by *Wilson, Bristows, and Carpmael*) appeared for the Plaintiffs.

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Bousfield, K.C., and *J. C. Graham* for the Defendants in support of the Motion.—First, the advertisements should be restrained under section 32 of the Patents, &c. Act, 1883; the Plaintiffs cannot in this case set up the defence that they have proceeded with due diligence; the previous proceedings against 5 other Defendants constitute no defence and they came to an end some time since. Moreover, the Defendants have been selling the article complained of for 18 months. [BUCKLEY, J.—How can I say that there is a want of due diligence on the part of the Plaintiffs when they have brought actions against other persons who have submitted; they could not help that?] At all events, the 10 Plaintiffs have long known what the Defendants have done, without for a long time taking proceedings against them. In the present case the threats were after the commencement of the action; but the Plaintiffs have not with due diligence commenced and prosecuted an action for infringement. Secondly, the advertisement amounts to a contempt of Court. [*Fenner v. Wilson & Co.*, 15 *Ld.* (10 R.P.C. 283) was referred to.]

Moulton, K.C., for the Plaintiffs.—It was expressly decided in *Challender v. Royle* (4 R.P.C. 363; L.R. 36 Ch. D. 425) that “due diligence” in section 32 means due diligence after the threats. The Defendants either apply under section 32 or under the common law. And if an action is brought under 20 the common law in respect of threats, *malâ fides* must be shown (*Wren v. Weild*, L.R. 4 Q.B. 213, 730). Section 32 was passed to meet that; it says that if one threatens one must promptly bring an action for infringement. The circular is only a threat, not a contempt of Court in any way.

Bousfield, K.C., in reply.—The point on which *Challender v. Royle* was cited 25 was not the ground of the decision. This appears more clearly in the Patent Reports.

BUCKLEY, J.—The material dates are these. On the 19th of April in this year the *Haskell Golf Ball Company* issued a writ in an action against *Hutchison and Main*, claiming an injunction to restrain them from infringing 30 certain Letters Patent (No. 17,554* of 1898). Subsequently, on the 8th of June, the Plaintiffs inserted in the “Irish Golfer” the notice which is complained of; and they have also caused circulars in the terms of that advertisement to be sent to large numbers of dealers in golf balls, very many of them the customers of the Defendants. The Statement of Claim was delivered on the 20th of May. 35 To-day is the 23rd of June. No Defence or Particulars of Objections have yet been delivered by the Defendants, who have already had two extensions of time for delivering the same. Under these circumstances the Defendants move in the action for an injunction to restrain the Plaintiffs till the trial from repeating the statement contained in the “Irish Golfer” or circularising that 40 statement.

The Defendants put it upon two grounds. First, upon section 32 of the Act of 1883. Mr. *Bousfield* tells me that most of the cases under that section are cases in which the course of events has been this: threats first, then action to restrain the threats, then action to restrain the infringement. It is said that 45 there is some difference, because in this case the course of events has been, action to restrain infringement first and threats next. It seems to me impossible to draw any distinction in favour of the parties moving in that order of events. The effect of section 32 is, as I understand it, that if a patentee is going to threaten other people with proceedings for infringement of his Patent 50 he must take upon himself to issue legal process for the purpose of obtaining a decision as to whether he has a good Patent or not, and, if he does that before he threatens, his position is much stronger than if he threatens first and sues after.

Then Mr. *Bousfield* says that these Plaintiffs have not proceeded with due 55 diligence. He says that the Defendants have been selling the article for the last eighteen months, and that this writ was only issued last April—a couple of months ago. The facts are stated in paragraph 2 of the Respondents’ affidavit:—

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"Proceedings have already been taken upon the said Letters Patent for infringement against other firms and persons, and an injunction obtained and undertaking given not to infringe the said Letters Patent." They have been asserting against other parties the validity of their Patent actively, and have been obtaining injunctions and undertakings. Further, according to the judgment of Lord Justice *Cotton* in *Challender v. Royle*, all I have to look at here is, what is the date of the threat, not what is the date of the act done against which the threat is directed. Here the date of the threat was after the issue of the writ. There is no possible ground, as it seems to me, for asserting that the Patentees have not proceeded with due diligence. It is the Defendants in fact—I do not say improperly, as it is a Patent action and a serious matter—who are preventing the action coming on by getting time for the delivery of their Defence; the Plaintiffs are in no default whatever. There has been in my opinion no want of due diligence.

Then it is said the advertisement ought to be stopped because it is an interference with the course of justice, and in that sense a contempt of Court; that it is a proceeding that will embarrass the Court in coming to a fair decision in the action when it comes on for trial. I confess that I have great difficulty in understanding how that contention can be put forward seriously. The contention as I understand it is this: that by this notice the Patentee says, "You are infringing my Patent; you are selling an infringement of my Patent; I have commenced an action to restrain the infringement of my Patent," and he is thereby affirming that the decision in the action will be in his favour. Would it have made any difference had he said "offering for sale that which I allege to be an infringement of my Patent"? I think certainly not. The circular simply means this: "I say my Patent is good, and I say you are infringing it; I have commenced an action in which I am going to maintain the affirmative of that, in which of course I may be defeated, and I may be wrong." In *Fenner v. Wilson & Co., Ltd.* (10 R.P.C. 283) the language of the threat was this: "The public are especially warned that users of" certain things "are liable to damages and injunction in respect of such user"—which is stronger language than this. That was a direct affirmation that they were liable and that the decision would be in the Patentee's favour. Upon that Lord Justice *Lindley* said: "We think we ought to say that we could not possibly treat these advertisements as a contempt of Court; it would be extravagant to treat them as anything of the sort." That language is stronger than this. The circular in this case, in my opinion, amounts to nothing more than this; the Patentee says, "The Patent is a good one, I am going to maintain that it is a good Patent, and you are infringing it." Of course it would be competent for the Patentee to commence actions against all the persons dealing in these alleged infringing articles. What he has done is something less than that. Instead of suing them all, he gives them notice that they are doing that which, as he claims, is a wrongful act. To use the language of Lord Justice *Lindley*, it seems to me that it is extravagant to treat anything of that kind as a matter which calls for the interference of the Court or one which will interfere in any way with the course of justice.

The Motion fails, and I dismiss it with costs, the costs to be the Plaintiffs' in any event.

Brown v. Evered & Co.

IN THE COURT OF SESSION IN SCOTLAND.

OUTER HOUSE.

Before LORD PEARSON (Ordinary).

March 19th, June 7th, and July 5th and 9th, 1904.

5

BROWN v. EVERED & CO.

Patent.—Infringement.—Conclusion for damages or profits.—Allowance of proof.—Diligence for recovery of documents.—Business books.

B., a Patentee, raised an action of interdict against E. for infringement, concluding also for damages or alternatively for profits. On the 19th of March
10 *the Lord Ordinary before Answer allowed the parties a proof of their respective averments and to the Pursuer a conjunct probation. On the 7th of June B. asked for a diligence to recover documents in terms of a specification calling inter alia for E.'s business books.*

Held, that the interlocutor allowing proof could not be altered; that the
15 *inquiry into profits or damages was not to be postponed until infringement had been proved. Diligence granted.*

Amendment.—Expenses reserved.—Abandonment.—Expenses.

On the 5th of July the Defenders were allowed to amend their record, the question of expenses being reserved. On the 9th of July the Pursuer abandoned
20 *the cause in terms of the Statute 6 Geo. IV., c. 120, section 10, under which the Pursuer has it in his power to abandon the case on paying full expenses or costs to the Defender.*

Held, that the terms of the Statute did not preclude the Court from dealing with the expenses reserved by the interlocutor of the 5th of July, modifying them
25 *and awarding them to the Pursuer.*

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The Pursuer in this case was *Andrew Brown*, aseptic furniture maker, 104, George Street, Glasgow, and the Defenders were *Evered & Co., Ltd.*, bedstead manufacturers, Surrey Works, Smethwick, Birmingham. Arrestments *jurisdictionis fundandæ causa* had been used against the Defenders. The object of the action was to interdict the Defenders from infringing Letters Patent (No. 4588 of 1899) for "Improvements in and relating to portable aseptic surgical stands." The Pursuer also asked for delivery to him or alternatively for destruction of all stands in the possession of the Defenders made in infringement of his Patent. He concluded for damages or alternatively for profits. He also asked in his Summons for delivery "of all letters, invoices, bills, 10 "business books, drawings, models, and other papers or documents belonging "to or in the hands of or under the control of the Defenders or of their agents "or others having their authority relating to the said infringement of the said "Letters Patent," and that the Defenders "should exhibit and produce a full "and particular account of the number of portable aseptic surgical stands 15 "manufactured by them during the continuance of the said Letters Patent and "of the prices charged and profits made by them thereby."

The Defenders pleaded *inter alia* :—4. The Letters Patent *et separatim* the second claim in the Specification was null and void in respect (1) that the alleged invention therein described was publicly known and used prior to the date of the said Letters Patent; (2) that the second claim was bad for want of subject-matter; (3) that there was no sufficient specification or explanation of the process claimed in the second claim; and (4) that the Patentee in his Letters Patent failed to distinguish what was old and not claimed from what was new; they also pleaded that they had not infringed the Patent. 20 25

Findlay (instructed by *J. W. and J. Mackenzie, W.S.*) appeared for the Pursuer; and *Tait* (instructed by *Forrester and Davidson, W.S.*) for the Defenders.

On the 19th of March 1904 Lord Low closed the record; and before Answer allowed the parties a proof of their respective averments, and to the Pursuer a conjunct probation. On the 7th of June 1904 the Pursuer asked for a diligence to recover documents in terms of a specification. *Inter alia* the Defenders' business books were called for. These were wanted for the purpose of proving the amount of the damages or profits concluded for. Counsel for the Defenders contended that the Pursuer must first prove the validity of his Patent and that there had been infringement; unless he proved this there would be no claim for damages or profits, and until it was proved the question of damages or profits did not arise. He might then make his election between damages and profits and proceed to prove their amount. The Pursuer was a rival trader, and the Defenders might be injured if access to their books was given him at this stage. Counsel for the Pursuer contended that proof had already been granted in general terms, which covered the question of damages as well as that of infringement. English practice on the point was misleading, for in Scotland it was the invariable custom to take the whole proof at once. The following authorities were quoted :—*United Horse Shoe and Nail Company v. Stewart* (5 R.P.C. 260; 15 R., H.L., 45); *Incandescent Gas Light Company v. McCulloch* (5 S.L.T., Nos. 233 and 245); *Gwynne v. Drysdale* (3 R.P.C. 65; 13 R. 684); *Dunlop Pneumatic Tyre Company v. New Lamb Tyre Company* (20 R.P.C. 303; 10 S.L.T., No. 26); *Frost's Patent Law and Practice*, pages 598, 605, 609; *Neilson v. Betts* (L.R. 5 H.L. 1, at page 22); *Dicks v. Brooks* (15 C.D. 39); *Edison v. Holland* (5 R.P.C. 483); *Hutchison v. Patullo* (5 R.P.C. 351; 15 R. 644). 30 35 40 45 50

Lord PEARSON (to whom the case had been transferred) granted the diligence. He said :—The Defenders ask me to disallow the Specification *in toto* on the ground that the inquiry into profits and damages should be postponed until it 55

Brown v. Evered & Co.

is decided that the Pursuer's Patent is valid. I have no power to alter the interlocutor allowing proof; and I think I should be virtually altering it if I were to separate the proof allowed as to infringement from that as to damages or profits. I think this is a typical case of the unfairness of allowing the Pursuer, a rival in trade, to have access to the Defenders' business books before the question as to the validity of the Patent is decided. But on looking into the authorities I find two cases which appear to support the general allowance of proof in such circumstances, namely, *Gwynne* (13 R. 684) and *Hutchison* (15 R. 644). The one was an action for interdict against infringement and for an account of profits. The other was an action upon alleged infringement and for damages, and the validity of the Patent was attacked. In neither case was there any division of the proof. I am unable to disallow the specification as craved, both because I cannot alter the interlocutor allowing proof, and because the interlocutor appears to be supported by practice in cases of the kind.

On the 5th of July, a week before the date fixed for proof, the Defenders amended their pleadings. In these they had pleaded that the second claim of the Pursuer's Patent was bad for want of subject-matter. They now brought this objection against the whole of the claims in the Pursuer's Patent, *et separatim* against his second claim. The amendment was allowed, the question of expenses being reserved.

On July the 9th the Pursuer's Counsel intimated that he abandoned the action in terms of the Statute 6 Geo. IV., c. 120, section 10, which reads:—"The Pursuer having it in his power to abandon the cause on paying full expenses or costs to the Defender." Counsel for Defenders asked for expenses, and argued that the terms of the Statute entitled him to his expenses in full. Counsel for the Pursuer argued that the interlocutor of the 5th of July reserving expenses left it to the Lord Ordinary to award him the expense caused to him by an amendment which altered the whole nature of the Defence being made at that late stage. The question of expenses reserved from the 5th of July fell to be disposed of before the Motion for abandonment was made. The Lord Ordinary modified the expenses reserved from the 5th of July at 3*l.* 3*s.* and awarded them to the Pursuer, allowed the minute of abandonment to be received, and awarded the Defenders full expenses except as above mentioned.

L. and C. Hardmuth v. Edward Baker & Son.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE WARRINGTON.

July 7th and 8th, 1904.

L. AND C. HARDMUTH v. EDWARD BAKER & SON.

*Patent.—Action for infringement.—Anticipation.—Differences between 5
patented article and infringing article.—Sufficiency of Specification.—
Judgment for Plaintiffs.*

*The owners of a Patent for a cigar piercer brought an action for infringe-
ment. The infringing cigar piercer differed in some details from the
patented article. The Defendants relied mainly on anticipation, insufficiency 10
of description in the Specification, and non-infringement.*

*Held, that the Patent was for the particular cigar piercer described in the
Specification and delineated in the Drawings; that the Patent had not been
anticipated and that the Specification was sufficient; and that, although the
Patent was confined to the machine described, the Defendants had infringed, as 15
they had taken the patented machine with immaterial differences. Judgment was
given for the Plaintiffs for the relief claimed.*

This was an action brought by the Plaintiffs alleging infringement of a Patent owned by them (No. 6958 of 1899) granted to *Lawrence Gunn Sloan* for "A cigar piercer," as a communication from abroad by *Franz von Hardmuth.* 20

The Complete Specification was as follows:—"This invention relates to a
"cigar piercer whereby to bore a longitudinal draught orifice in the tip of a
"cigar without impairing the continuity of the outer wrapper and causing it to
"become unrolled when moistened by the saliva, as happens when the tip of
"the cigar is cut off or cross notched by cigar cutters of the ordinary kind. 25
"By means of the instrument of this invention the draught hole is bored
"axially in the tip of the cigar by means of a tubular scoop-like cutter whereby
"the removal of a solid central core of tobacco is effected without splitting the
"outer wrapper or destroying the continuity of the final convolutions by which

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"the tip is formed, the hole so bored being of such depth as to ensure a free draught whilst owing to its small diameter and axial direction the hole is not liable to become choked with saliva in smoking.

"The invention will be described with reference to the accompanying drawings wherein Figure 1 represents a longitudinal section of the instrument, drawn to an enlarged scale, the cutter being in its normal retracted position, and Figure 2 shows an external view of the instrument with the cutter projected to its full extent into the tip of a cigar which is shewn in dotted lines. Figure 3 shews longitudinal views and a cross section on $x-x$, of the acting end of the cutter drawn to a still further enlarged scale.

"The case of the instrument comprises two outer tubular sections a b sliding telescopically the one in the other, the section a terminating in a bell body portion c having a bell mouth c^1 adapted to receive within its conical recess the tip of a cigar and so confine it as to prevent its splitting when the cutter is driven in. Fitted to slide axially through this bell mouth is a tubular punch or cutter d having its acting end oblique to its axis so as to present cutting edges e e meeting at an acute point or angle f whereby to facilitate the initial penetration of the cutter and cause the cutting edges by reason of their obliquity to make a drawing cut, these cutting edges being chisel-like in cross section, that is to say bevelled towards the inner side only of the cutter so that the latter when driven into the cigar will exert no outwardly directed wedge-like action which would tend to burst the end of the cigar but the tobacco removed by the cutter on its entry will be forcibly compressed into the bore of the cutter in the form of a solid core which will be extracted along with the cutter when the latter is withdrawn. This cutter may be formed of a strip of thin steel bent to a tubular form and tempered and it is in rigid longitudinal connection, through a cutter-carrying tube g , with the upper member b of the outer case so that when the latter is pressed into the part a the cutter will be extruded through the bell mouth as shewn in Figure 2. In order however to prevent torsional straining of the connections between the various parts the member b of the casing can turn freely and independently of the cutter. With this object the cutter carrying tube g may terminate in a disc or other head h adapted to be engaged with the part b by a circumferential groove i pressed or spun in the part b after the head h has been introduced. In one with the body portion c is an inner guide tube j within which the cutter carrying tube g slides and about this guide tube is a spiral spring k confined between the body portion c and the closed upper end of the member b of the casing whereby the parts are normally retained in the position shewn with the cutter wholly retracted within its guide tube. In order to expel from the cutter the core of tobacco withdrawn by it, a stationary core-extruding plunger l is fixed within the cutter by means of a cross pin m which is rivetted into the guide tube j and traverses longitudinal slots n in the cutter carrying tube g , which slots permit of the said tube and of the cutter d sliding freely on the stationary core-expelling plunger which extends to the acting end of the cutter so that when the latter is entirely retracted the core must of necessity be ejected therefrom.

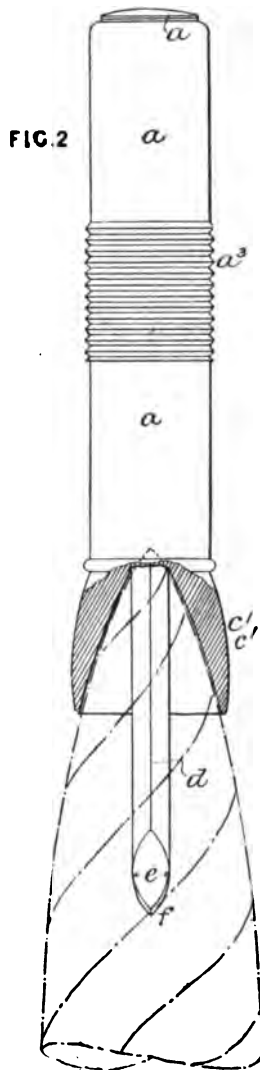
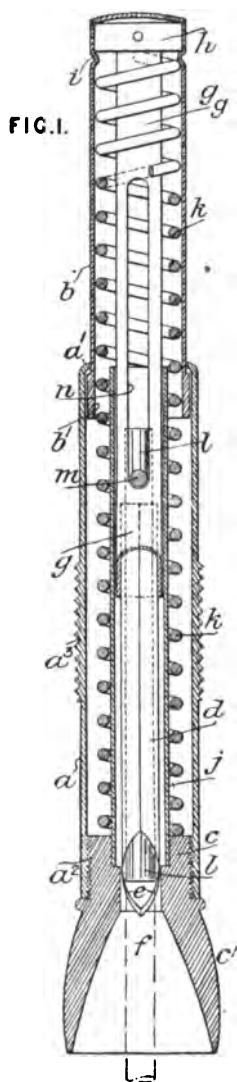
"In order to guide the sliding cutter-carrying portion of the instrument and to limit the outward motion of the part b , it is formed with a shouldered lower end b^1 which fits the internal diameter of the part a of which the upper end is contracted as shewn at a^1 so as to engage with said shoulder b^1 . The part a is preferably screwed to the body part c , as at a^2 , and may be provided with an externally roughened or corrugated surface, as at a^3 , to enable it to be firmly grasped.

"The core-ejecting plunger might be omitted, in which case the cutter-carrying tube g would be in one with the end of the telescopically sliding

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"member *b* and would open through the end of the latter for the ejection of the
 "cores, but this construction is less advantageous since the pressure necessary
 "to force the preceding cores up through the cutter and eject them at the upper
 "end of the part *b* must be supplied by the end of the cigar being perforated
 "which is liable to be injured in the operation."

5



The Patentee claimed :—" 1. The herein described cigar piercing instrument
 "constructed substantially of the parts shewn and described, said parts being
 "combined to operate in the manner specified. 2. A cigar piercer for boring a
 "longitudinal axial hole in the tip of a cigar and consisting essentially of a

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“bevel-ended tubular punch or cutter fitted to slide axially through and to be projected from a bell-mouthed body portion adapted to confine the cigar tip, the cutter being held in a tubular holder connected to a telescopically-sliding member of the casing of the instrument so as to slide, but not turn, therewith, a core ejector formed of a stationary plunger within the cutter fixed to the inner guide tube of the body portion of the instrument by a cross pin passing through longitudinal slots in the cutter-carrying tube, and a spring confined between the telescopic members of the casing substantially as specified.”

10 The infringements complained of were certain cigar piercers supplied by the Defendants to various customers of theirs which were all substantially alike. The Drawing shown on p. 508 from the Specification of *Caldicott* (No. 23,817 of 1902) fairly represents the last mentioned piercers.

The Defendants denied infringement, and also alleged that the Plaintiffs' Patent was invalid on the grounds that the invention was matter of common knowledge; that the invention was not useful, in that the form and action of the cutter were inferior to the form and action of cutters in use previously; that the Crown was deceived by false suggestions on the part of the Patentee as to the novelty of the use of tubular cutters for the purpose of boring holes in cigar tips and as to the utility of the freedom of the cutter head in its casing; that the Patentee did not show the best manner of carrying out the invention in that he described an unnecessarily elaborate form of cutter; that the invention had been previously published in the Specifications of *Haddan* (No. 4460 of 1877), *Carter* (16,309 of 1886), *Fairchild* (United States, No. 367,800 of 1877), *Larsen and Bersted* (United States, No. 308,906 of 1884); and that there had been prior user of the invention by the manufacture and sale of piercers made according to *Carter's* Specification above referred to and of a piercer made and sold by the Plaintiffs.

Carter's Provisional Specification was as follows (it is deemed unnecessary to set out the Complete for the purposes of this report):—“A pocket cigar cutter, that will make a round hole running up the end of the cigar, about an eighth, or half an inch long, so that it will have the appearance of being bored like a pipe.

“My invention is a round hollow cutter that revolves as it is boring the cigar.

“For making the cutter in the form of a charm, there are two tubes about an inch long, one to slide easily within the other, the outside tube is closed at one end, and the inner tube is shaped to receive the end of the cigar at one end, the cutter is fastened to the outer tube in the centre at the top so that it revolves freely, a double spiral slot is cut in the top part of the cutter exactly opposite each other, and worked by the inner case being held in position by a pin running through the double slot, inside the inner and outer cases there is a spiral spring which presses the inner case forward.

“The cigar is pressed against the inner case, and is cut or bored by means of the case sliding up and so making the cutter revolve and project, so cutting the cigar. Inside the cutter is a piece of wire worked by the pin of the inner case, which clears it of any tobacco dust. A catch may be fitted to hold the inner case up while the cigar is withdrawn, to prevent the cleaning wire forcing the tobacco cuttings back into the bore.

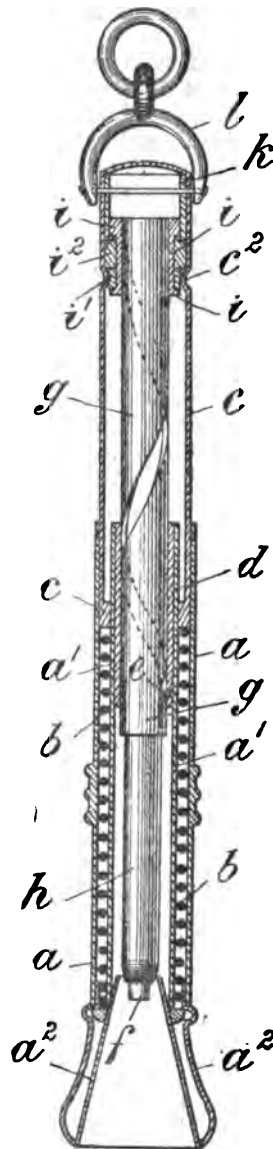
“There are several ways to obtain the movement, and they can be made any shape or placed on the top of pencil cases, etc.”

At the trial of the action *J. C. Graham and M. D. Warmington* (instructed by *Hollams, Sons, Coward, and Hawksley*) appeared for the Plaintiffs; and *J. W. Gordon* (instructed by *Morgan, Price, and Mewburn*, agents for *Hargreave and Heaton*, of Birmingham) for the Defendants.

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J. C. Graham for the Plaintiffs.—This is an action for infringement of a Patent for a cigar piercer, and the main questions at issue are as to the novelty

Fig. 2.



of the invention and as to infringement. The Patentee claims in his Specification a new article, the main features of which are two tubes, an outer and inner,

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attached to a bell mouth, a spring in the chamber between the two tubes, a tubular cutter arranged so as to bore an axial hole in the cigar and remove a plug of tobacco therefrom and give a draw cut in so doing, a tube pressed up by the spring which projects the cutter into the cigar to be pierced, leaving the cutter free to rotate independently of the tubes, and an ejector fastened to the innermost tube and inside the cutter tube so as to clear out the plug of tobacco removed from the cigar. These elements are not to be found in any of the alleged anticipations, but are all to be found in the Defendants' piercer, the only differences being that where the Patentee has a straight slot to insure a straight travel of the cutter the Defendants have a spiral slot, and the cutter of the Defendants is a tube cut off flat across its end where the Plaintiffs is pointed, but these two alterations combined give the same result of obtaining the Plaintiffs' drawing cut by a method well known as the equivalent of that arrangement of the Plaintiffs. There is a slight difference in the length of the spring and the point where it abuts on the upper tube, but this has not the slightest effect on the working of the device.

Evidence was given by Mr. Adam on behalf of the Plaintiffs to explain the construction of the Patentee's piercer. He was cross-examined as to a model illustrating the Defendants' construction of *Carter's* Provisional Specification, which differed from the piercer shown in the Complete Specification of *Carter* in having the cutter mounted so as to revolve in the outer tube instead of being fixed to it. The witness agreed that the model represented one reading of the Specification, but said it could be read in various ways. Mr. Symonds was called to prove the utility and large sale of the piercers made according to the Patentee's Specification.

The Defendants called Mr. Swinburne, who said that the parts common to the Plaintiffs' and Defendants' piercer were none of them new, and agreed that there were differences between *Carter's* and *Sloan's* piercers. Mr. Bristow gave evidence as to the use of a piercer made as shown in *Carter's* Complete Specification before the date of *Sloan's* Patent.

Gordon for Defendants.—The Specification must clearly describe and ascertain the invention (section 5, subsection 4, Patents, &c. Act, 1883); if part only of what is described is to be claimed the Patentee must say so. This Patent is for a particular form of cutter. The Patentee does not claim the use of a lower outer tube, which is said to be a distinction between his and *Carter's*. I submit that his is the same as *Carter's* with the addition of an extra outer tube for convenience in arranging a longer travel of the cutter, but this he has not claimed. The Patentee must give the most advantageous way of carrying out his invention (*Savory v. Price*, 1 Webst. 23). This he has not done; he has described an elaborate form of cutter having its inner edge bevelled; this is costly to make, and it has not been shown to have any advantage over a cutter made with the bevel on the outside, which is cheaper to make. Again, he describes a loose head which is of no utility, the evidence showing that piercers are made with fixed or loose heads indifferently. On the issue of infringement, the Defendants have taken nothing which was new from the Plaintiffs.

The Plaintiffs' Counsel were not called upon to reply.

WARRINGTON, J.—This is an action for the infringement of a Patent. The subject-matter of the Patent is a contrivance for cutting cigars, the feature of the contrivance being that you make in the cigar a longitudinal hole from the point. The usual defences are raised, but substantially the two defences with which I have to deal are anticipation and non-infringement. Anticipation after the evidence of Mr. Swinburne resolves itself into the question of whether the Patent has been anticipated by the Specification of *Carter*. Infringement depends mainly, as it has been argued, upon the question whether or not I hold

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the Patent to be a combination, and if I do hold it to be a combination, whether the Defendants have substantially taken the combination.

I have carefully considered the Specification. It consists as usual of a descriptive part, some passages in which I shall have to refer to for another purpose, and the descriptive part refers to Drawings. Then there are two claims. The first claim is the "herein described cigar piercing instrument, constructed substantially 5
"of the parts shewn and described, the said parts being combined to operate in
"the manner specified." Now it seems to me that that is a claim for the article itself, and not a claim for any particular part of it, and that in my view agrees with the descriptive part in the Specification. I propose therefore to treat the 10
questions which arise on the footing that the claim in the Specification is for the article itself which has been described, and is delineated in the Drawings. Of course two results flow from that. The first is that it is more difficult for the Defendants to prove anticipation, but on the other hand it is more difficult for the Plaintiffs to prove infringement. I propose to deal first of all with the 15
question of anticipation.

The only Specification substantially relied upon for the purpose of proving anticipation is the Provisional Specification of *Carter*. The combination or the article itself which I have held is the subject-matter of the Plaintiffs' Patent is so constructed that it has in connection with and firmly fixed to the 20
bell mouth into which the point of the cigar is fitted two tubes, an inner and an outer tube, and in the space between those two tubes there is a coiled spring, and also room for an upper member, which is in connection with that coiled spring, to move up and down. That upper member actuates another tube which carries the cutter, and which works inside the inmost of the two fixed tubes 25
of which I have spoken. That is the general principle of the Plaintiffs' arrangement. The result of that, for the purpose of comparing it with *Carter*, is that there is in the lower part of the instrument a fixed portion which is capable of being held between the finger and thumb, while the movable portion at the top can be forced down by another finger. Therefore you can cut a 30
cigar with one hand using the cutter in one hand and holding the cigar in the other in the way in which I have described. *Carter* has no double tube fixed to the bell mouth. There is one tube fixed to the bell mouth, and there is on the outside of that bell mouth what I may call a cap which moves up and down. The particular one I hold in my hand rotates. It is made in accordance with 35
the Complete Specification; the Provisional Specification did not provide for rotation. There is a cap which moves up and down, upon what I may call the fixed tube fixed in relation to the cigar point. This is practically incapable of being used in the way I have mentioned. In order to work this you must hold the cigar in one hand and put the cutter on the top of the cigar 40
with the other, and then force the cap down on the top of the cigar. I mention that difference between *Carter's* and the Plaintiffs', not because I think that taking it by itself the Plaintiffs' Patent consists in that capacity of being actuated by the forefinger pressed on the top of the instrument, while the finger and thumb hold the middle. I do not refer to it for that purpose at all, 45
but I do refer to it for this purpose, that treating the Patent as a Patent for the article itself, I cannot find in *Carter's* Specification the article itself. It seems to me that the principle upon which *Carter's* Specification, or the article made under *Carter's* Specification, is contrived, is altogether apart from the principle upon which the Plaintiffs' article is contrived. I therefore find there 50
is no anticipation.

Now is there infringement, viewing the Plaintiffs' Patent as I have viewed it as one for the thing itself? The Defendants' article and the Plaintiffs' article are externally identical; you use them in the same way. The Defendants say the Plaintiffs' is contrived with those two tubes, an inner and an outer tube fixed 55

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firmly to the bell mouth, and it has the sliding upper member held in place by a coiled spring and restored to its place by that coiled spring after having been compressed. There is one difference to which I now propose to allude. The Plaintiffs use a rather peculiar form of cutter. It has a sharp point shaped like
5 a pen, a sharp point with a double chisel coming away from the point, the object of that being to make what is called in the Patent a drawing cut; instead of the sharp edge being simply pressed down hard on the surface it has to cut, a sharp point is pressed in first, and then, as the instrument goes further into the material it is cutting, the edge operates to give a drawing cut. The Defendants have
10 an ordinary cylinder end, a plain round end sharpened, a plain round end to the cutter, but they also get a drawing cut, and the way in which they get it is that, in compressing the machine, by means of a spiral slot, in the upper part of the tube to which the cutter is attached, they give the cutter a twist so that as it is forced down into the end of the cigar it turns round, and in that way gives the
15 drawing cut that is required. That seems to me to be the only difference really between the two contrivances. I ought to mention that in the Plaintiffs' contrivance the coiled spring goes right up to the top, in the Defendants' it stops half way near the top of the two fixed tubes. It seems to me that the difference between those two is absolutely immaterial. I have not had any
20 witness who gives me any reason either why the Plaintiffs have adopted the longer spring or why the Defendants have adopted the shorter spring. There is one obvious result, that whereas in the Plaintiffs' the movable thing, which has been called the upper member, has to pass down outside the coiled spring in the lower member, in the other it does not, because it is attached to it
25 and presses it down. But, looking at the thing substantially and from a broad point of view, I see no real difference in that respect. There is one other matter of difference. The Patentee, as he described his contrivance in his Specification, thought that the cutter tube had better be left free inside this upper member so that the user should be compelled to neglect the temptation which he seemed
30 to think was inherent in human nature to give a twist to the article as he pressed it on the cigar end. The Defendants do not seem to have thought that it was necessary to provide that, and accordingly theirs is fixed, and I find that in practice for the purpose of using the Plaintiffs' as charms to be attached to a watch chain they are generally furnished with a ring, and the two things are
35 fixed also in the Plaintiffs'. I do not consider, therefore, that there is any substantial variation there.

I now come back to the point in which it has been insisted that there is a substantial variation, I mean the difference between the two cutters. In both there is the slot. In the Plaintiffs' it is straight, in the Defendants' it is spiral,
40 but they exactly fulfil the same purpose with this difference only, that the one in the Defendants' enables them to give the draw cut without servilely copying the Plaintiffs' cutter, and the slot, therefore, serves that purpose in addition to that which it serves in the Plaintiffs' case. Looking at it as a whole, I come to the conclusion that substantially, with immaterial variations, the Defendants
45 have taken the Plaintiffs' machine. The consequence is that although I find the Patent is confined to the machine yet there has been an infringement.

There are one or two minor matters which were insisted upon by Mr. Gordon as objections to the validity of the Patent. The first of those is this. He says a Patentee must describe the best way of performing his invention, and that
50 this Patentee has not done it. One must qualify that statement of the law, and, I think, Mr. Gordon admitted that. All that the Patentee has to do is to state the best way he knows of performing his invention. Now he has in this particular case told the person who has to make his article that the inner edges of that bevelled punch should be sharpened and not the outer ones, and I have
55 had evidence to-day to the effect, first, that to do that would be expensive and

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inconvenient, and, secondly, that in practice it is not done. Now it is not shown that the Patentee knew that it could not be done or could only be done at considerable expense and inconvenience, and, I think, on the whole, that I should be doing wrong to hold that that description which, for anything I know to the contrary, he may have thought was really the best way of performing his invention is so imperfect or so incorrect as to invalidate the Patent. 5

The next point on which it is said that the Patentee has not given the best description he could is that to which I have already referred, namely—that in his Specification he tells you that he considers it desirable that the top of the cutter tube should revolve freely inside the upper limb of the outer case in order to prevent what has been referred to here as torsional strain. I really do not see why he has not, in saying what he has in that respect, described the best way of making his article. I think it is quite likely he has. I think it is quite likely that his article would be better—it may be only in a minute degree—if the cutter tube were left free; but it has been found in practice that there is no harm in fastening the two together, and in the case of those which are made to hang on a watch chain, or for some similar purpose, they are furnished with a ring, and it is convenient to run the pin which holds the ring to the outer case through both. That seems to me to be the outside to which that matter extends, and I cannot hold, therefore, that in that respect either the Patentee has imperfectly described his invention in the way of not telling the maker the best way of making it. 10 15 20

On the whole, I think the Plaintiffs are entitled to succeed.

Judgment was given for an Injunction, an Inquiry as to damages, delivery up of infringing articles, and costs. 25

The delivery up and the Inquiry were, on the application of the Defendants, stayed for 21 days, and, if notice of appeal was given within that time, then until after the appeal is heard.

Heine, Solly & Co. v. Julius Norden & Co.

IN THE HIGH COURT OF JUSTICE—CHANCERY DIVISION.

Before MR. JUSTICE FARWELL.

June 17th, 1904.

HEINE, SOLLY & CO. v. JULIUS NORDEN & CO.

5 *Patent.—Action for Infringement.—Motion for Interlocutory Injunction.—*
Effect of Certificate as to validity granted in previous action.—Interlocutory
Injunction granted.

This was an action for infringement of Letters Patent (No. 17,093 of 1901)
granted to *Carl Ernst Julius Berthold*, for an invention for "Improvements
10 "in Pocket Automatic Gas Lighters."

In a previous action for infringement of the same Patent (see *Heine,*
Solly & Co. v. Coninco Incandescent Light Co., ante p. 202) the Court held
that the Patent was valid, and granted a Certificate that the validity of the
Patent came in question in that action.

15 On 17th June 1904, the Plaintiffs in the present action moved for an
injunction restraining the Defendants from infringing the Patent pending the
trial, or until further order.

Vale Nicolas (instructed by *Edgar Francis Weldon*) appeared for the
Plaintiffs; *A. J. Walter* (instructed by *J. E. Harris*) appeared for the
20 Defendants.

Nicolas, for the Plaintiffs, contended that they were entitled, as of right, to
an interlocutory injunction, as infringement (provided the Patent be valid) was,
he alleged, not denied, and the validity of the Patent had been established, and
a certificate as to validity granted in a former action. He referred to *Pneumatic*
25 *Tyre Company v. Marwood and Cross* (13 R.P.C. 347) and Lord *Romilly's*
Judgment in *Bovill v. Goodier* (L.R. 2 Eq. 195), as authorities for the proposi-
tion that once the validity of a Patent has been established by a Court of
competent jurisdiction, the Plaintiffs are entitled to an interlocutory injunction,
notwithstanding that fresh facts or matters tending to show that the Patent is
30 invalid, are brought before the Court in the subsequent action.

Walter, for the Defendants, contended that an interlocutory injunction should
not be granted. He submitted that the evidence filed on behalf of the Defendants,

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showed clearly that the Patent was bad on the ground that it had been anticipated. The Defendants were willing to give an undertaking to keep an account pending the trial. In the case of *North British Rubber Company v. Gormully and Jeffrey Manufacturing Company* (12 R.P.C. 17) an injunction was not granted in like circumstances, and an injunction should not be granted here. 5

FARWELL, J.—In my opinion the practice of the Court is correctly stated in Mr. Frost's book at page 547, which says: "Where the validity of the Patent has been established on previous occasions, though it is open to the defendant at the trial to dispute it, the Court will, on an interlocutory application regard its validity as sufficiently established by the previous proceedings to warrant the grant of an interim injunction, if the infringement is clear, or there is a *prima facie* case of infringement, and this notwithstanding that the defendant disputes the validity of the Patent on a ground not raised in any of the previous proceedings." I should have thought, without the assistance of that passage in this excellent work and the cases referred to, that would be a reasonable course. In the present case I am the more disposed to grant an injunction, because I am told that one of the present Defendants was in Court at the trial of the former action, and he evidently knew all about the proceedings. If he had any evidence to offer he might have assisted in that case to defeat the Plaintiffs' claim. As far as regards the case of the *North British Rubber Company v. Gormully and Jeffrey Manufacturing Company*, there are two facts which entirely distinguish that case from this; first, there was, as Mr. Justice Chitty pointed out, an admission of infringement, and another was that the defendants offered to pay into Court, and did pay into Court, a sum sufficient to meet the royalties, namely, 500*l.* No such offer is made here, and in my opinion the Order must go. The costs will be costs in the action. 15 20 25

Walter.—There will be the usual undertaking as to damages.

FARWELL, J.—Yes.

In the Matter of Clifton's Patent.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BUCKLEY.

June 21st, 1904.

IN THE MATTER OF CLIFTON'S PATENT.

5 *Patent.—Petition for Revocation.—Consent Order for Revocation.—Application in Chambers refused.—Order for Revocation made in Court.—Form of Order for hearing of a Petition when the Respondent is out of the Jurisdiction.*

On the 5th of July 1900, Letters Patent (No. 12,116 of 1900) were granted to *Charles Henry Clifton* of Renfrewshire, for an invention of "Improvements
10 "in Circular Saws." On the 26th of February, *Joseph Hill* presented a Petition for Revocation of the Patent, alleging in his Particulars of Objections that the Patent was invalid for want of novelty, and want of subject-matter.

On the 12th of March 1904, Counsel for the Petitioner applied for directions as to the hearing of the Petition, and, the Respondent being out of the jurisdiction,
15 asked for an Order in the form made in *Re Drummond's Patent* (6 R.P.C. 576). *BYRNE, J.*, made an Order that the hearing of the Petition take place on * the hearing of an action with witnesses, and be set down in the list accordingly, unless the Respondent should within fourteen days from the date of the service of the Order show cause to the contrary, and notice of the Order
20 was to be given to the Respondent on or before the 31st day of March 1904.

The Respondent, being prepared to consent to an Order for Revocation, the Petitioner applied by Summons in Chambers for an Order upon the Petition, revoking the Patent, such Order to be in the terms of Minutes annexed to the Summons.

25 As appears in the Judgment printed below, *BUCKLEY, J.*, refused to make an Order for Revocation in Chambers; and the Petition, on the 21st June 1904, came on before *BUCKLEY, J.*, in Court.

J. W. Gordon appeared both for the Petitioner and Respondent (being instructed for the Petitioner by *Baker, Baker and Co.*, and for the Respondent

* *Sic* in Order; *quare* "as."

In the Matter of Clifton's Patent.

by *Wilson, Bristows, and Carpmael*), and asked for an Order for Revocation by consent in the terms of the Minutes, and referred to the application in Chambers.

BUCKLEY, J.—In this case a Petition has been presented for the Revocation of a Patent under Section 26 of the Patents, &c. Act, 1883. Yesterday, in 5 Chambers, the matter came before me upon a Summons. The Respondent, after the Petition had been presented, was prepared to consent to Judgment for Revocation, and a Summons was issued to obtain Judgment for Revocation in Chambers, without coming into Court. That process was adopted in reliance upon something which my Brother *Joyce* was supposed to have 10 decided in the matter of *Scott's Patent* (20 R.P.C. 604). I took the opportunity of mentioning the matter to Mr. Justice *Joyce*, and he told me that he had no intention of deciding in that case that it was proper to obtain such an Order in Chambers. Under these circumstances I feel myself free to do what seems, in my judgment, right. A Petition presented under the statutory jurisdiction 15 for the Revocation of a Patent is, I think, a matter which ought to be dealt with in Court. I do not forget the fact that certain relief has to be obtained upon Petition, and not in Chambers, where the amount involved is over a specific sum.* *Primâ facie* a Petition is a matter to be adjudicated upon in Court, and where the relief obtained is the Revocation of a Patent, I think it 20 is expedient that the relief should be given in open Court, and not in the way in which applications are dealt with in Chambers. I therefore refused to make the Order on the Summons, and this Petition accordingly comes on to be dealt with in Court. I pronounce Judgment for Revocation by consent. 25

* See R.S.C. Order LV., Rule 2 (2).

George Hattersley & Sons, Ltd. v. George Hodgson, Ltd.

IN THE COURT OF APPEAL.

Before THE MASTER OF THE ROLLS and LORDS JUSTICES ROMER and
MATHEW.

May 10th, 11th, and 12th, 1904.

5 GEORGE HATTERSLEY & SONS, LD. v. GEORGE HODGSON, LD.

Patent.—Action for infringement.—Construction of Specification.—Sufficiency of description.—Essential feature shown in Drawings, but not in letterpress.—Parts of Specification struck out on amendment not to be regarded.—Utility.—Anticipation.—Action dismissed.—Appeal by Plaintiffs allowed.—Patent held
10 *to be valid.*

The Plaintiff Company, the owners of a Patent for "Improvements in dobby looms for weaving," sued the Defendant Company for infringement. It appeared on the evidence that, in order to carry out the invention, it was necessary to incline the knife guides in a dobby (which before the date of the
15 *invention were always placed parallel to one another) at an angle to one another, and also to alter from their usual positions the centres of certain levers in the dobby known as the balk and jack levers. The Specification was amended some time prior to the action, when one of the claims, together with the whole of the letterpress relating to the position of the centres of the above*
20 *levers, was struck out. The Drawings attached to the Specification, however, were not altered, and showed the centres of the levers in the required position for carrying out the invention. It was held at the trial, that the Plaintiffs' invention was useless unless the centres of the levers were placed in certain particular positions; that, since in the letterpress of the amended Specification*
25 *there was no reference to the position of these centres, the Specification did not sufficiently describe the invention, which as described was useless, and that the Letters Patent were consequently invalid. The action was dismissed with costs. The Plaintiffs appealed. On the appeal the Respondents contended that, even if they were wrong on the question of construction, the Patent was anticipated;*
30 *and, further, that one claim was meaningless and bad for want of utility.*

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Held, by the Court of Appeal, that on the true construction of the Specification the invention claimed was a dobby with the knife guides inclined to one another and having the system of centring shown in the Drawings, and that the claim for this combination was good; that the Patent had not been anticipated and was valid. The appeal was allowed with costs of the appeal and below, and an injunction was granted with delivery up and an inquiry as to damages, but a stay as to delivery up and as to the inquiry was arranged in case of an appeal to the House of Lords. A Certificate of the validity of the Patent having come into question was granted. 5

Where a Specification has been amended by deleting certain parts, those parts 10 cannot be looked at on a question of construction.

Inglis v. Buttery (L.R. 3 App. Cas. 552) followed.

On the 29th of March 1897 Letters Patent (No. 8000* of 1897) were granted to Richard Longden Hattersley and Simeon Jackson for an invention of "Improvements in dobby looms for weaving." 15

In accordance with a decision of the Comptroller-General of the 28th of October 1901 the Complete Specification was amended by striking out Claim 2 (of the original Specification) and parts of letterpress.

The Complete Specification, as amended, was as follows:—"This invention relates to improvements in that class of weaving looms in which the shedding 20 of the warp is effected by what is commonly called a 'dobby.'

"When the draw hooks of a double lift dobby engage with one of the draw knives and are 'drawn' or operated the ends of the balks to which the hooks are attached describe a curve or move in a curved path and rise and fall as the case may be according as to whether the lower or upper end of the balk 25 is operated and consequently the hooks do not remain in line with the direction of motion which causes unnecessary friction and loss of power. To obviate this as much as possible we incline the upper and lower guides in which the draw knives work towards each other sufficiently to raise the lower knives and lower the upper ones as the hooks are operated and thus keep the 30 hooks practically horizontal or in line with the direction in which they are moving.

~~"A further advantage in respect to ease of working and to keeping the draw hooks in line is attained by arranging the fulcrum of the jack levers or bell crank levers in the same plane as the centre of attachment of the hooks 35 to the balk levers when the latter are not 'lifting' and by arranging the centre of attachment of the balk levers to the jack levers in such a position in relation to this plane that when operated they oscillate between two points located equidistant from each side of the plane.~~

"In order to enable the pick stopping and card reversing mechanism to be operated by the same operating rod we introduce levers into the respective motions arranged in such a manner that on the first movement of the operating rod the said lever in the pick stopping motion is in its most active position that is to say: its arm communicating the motion is moving in a direction almost parallel to the direction of motion so that the pick stopping mechanism is 45 immediately actuated. On the other hand the said lever in the card reversing mechanism is at first in its most passive position and at first the arm communicating the motion moves approximately at right angles to the direction of motion and only passes into an active position after the picking motion has been stopped. 50

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"In looms in which the shuttle box changing cylinder is upon the same shaft as the dobby cylinder and is operated at the same time the indication imparted to the box motion is required to be some degrees later than the indication imparted to the healds. To obtain this we make use of compound
 5 "levers for the box indicating lags each consisting of a simple lever and having an arm on either side of its fulcrum one of which is arranged to be engaged by the lag pegs and the other projects over one arm of a second simple lever, the other arm of which controls the box indicating mechanism. Each of the second simple levers is formed with a slot through which the fulcrum rod passes
 10 "and it is normally supported with the bottom of the slot up against the underside of the fulcrum rod by means of a spring which may be immediately above said rod. These slots are sufficiently long to allow the simple levers to be operated by the lag pegs which only has the immediate effect of depressing the ends of the second levers nearer to them without operating the other end
 15 "as the said slots are provided to allow this. When this takes place the box indicating levers are prevented from being lifted by the ordinary detent or stop piece which is removed at the time the indications are required to be made this allows the said springs to lift the ends of such of the second simple levers that have their opposite ends depressed by the first simple levers and
 20 "this movement is imparted in any convenient way to the box indicating levers connected to the box motion.

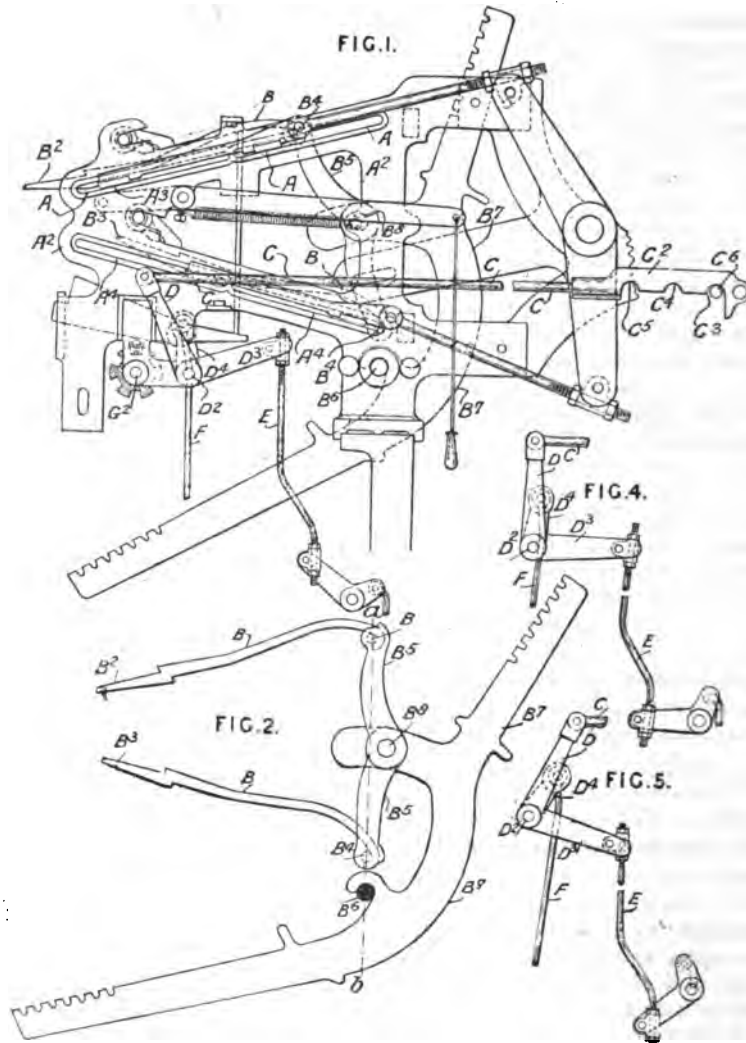
"To fully describe our invention reference is made to the accompanying sheets of drawings forming a part of this specification, in which similar letters of reference indicate corresponding parts in each of the figures. Figure 1,
 25 "represents an elevation looking towards the front of the loom of such parts of a dobby as are necessary to illustrate the application of our improvements. Figure 2, is a separate view of one of the jack levers together with its balk lever and hooks. Figure 3, is an end view of Figure 1 together with certain other parts. Figures 4 to 9, are views of details hereinafter referred to.
 30 "The upper guides A, A in the side frames A² of the dobby in which the knives A³ work are inclined down towards the lower knife guides A⁴, A⁴ consequently as the hooks B, B move backward and forward their ends B³, B³ are kept more in line with their centres of attachment B⁴ to the balks B⁵.

~~"The parts are so relatively arranged that when they are not operated by
 35 "the knives the fulcrum B⁶ of the jack levers B⁷ is vertically beneath the centres of attachment B⁴ of the hooks B as shown by the broken line a, b Figure 2. And the centre of attachment B⁸ of the balk B⁶ to the jack lever B⁷ lies, before the jack lever is moved, such a distance from the line a, b that when said lever is fully operated it passes to a position equi distant
 40 "from said line but on the opposite side.~~

"The pick stopping and card revolving mechanism are under the control of one rod C (shown broken away in Figure 1) but in reality the end C³ reaches approximately to the other side of the loom and one of its notches C³, C⁴, or C⁵ rests upon the stud C⁶ fixed at the other side of the loom to support it.
 45 "The other end of the rod is connected to an arm D, on the rocking shaft D² mounted in bearings formed in the framework A². This shaft D² has arms D³ and D⁴ fixed upon it in such a position that when the notch C³ is engaging the stud C⁶ the arm D³ is nearly horizontal and the arm D⁴ is nearly vertical in the position shown in Figure 1. When the rod C is moved to bring the notch
 50 "C⁴ on to the stud C⁶ the arms D³ and D⁴ are brought to the position shown in Figure 4, and as when moved in this way the arm D³ is nearly at right angles to the rod E connecting it to the pick stopping mechanism this rod has sufficient movement imparted to it to throw the picking motion out of operation. On the other hand the arm D⁴ merely passes over the dead centre or
 55 "moves practically parallel to the rod F which connects it to the card reversing

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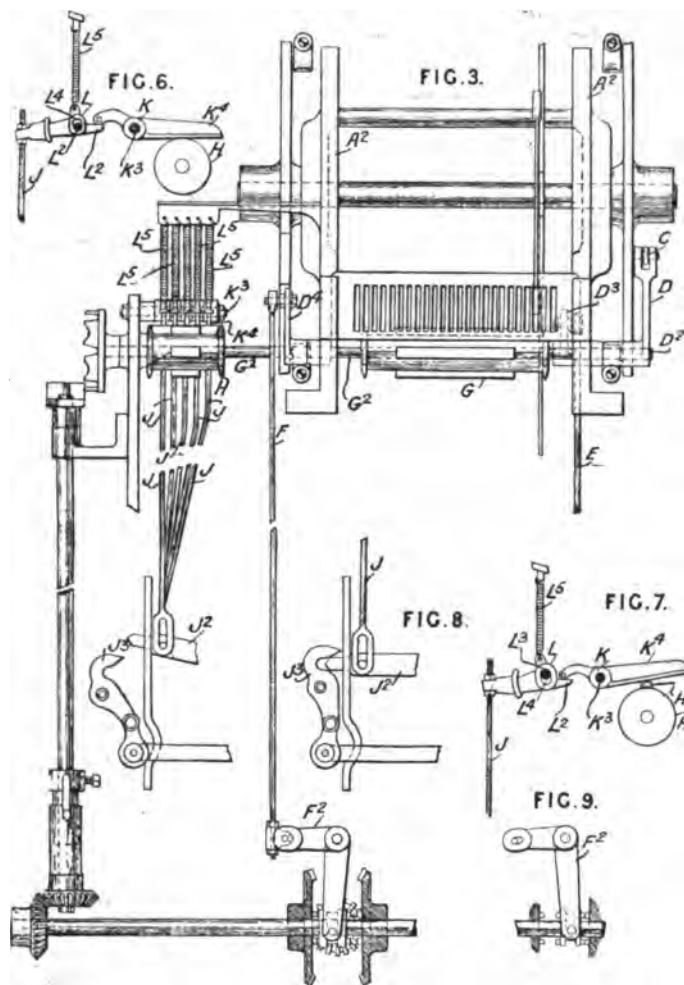
"mechanism, consequently the longitudinal motion imparted to the
 "rod is so slight that it has no effect on the card reversing mechanism. But
 "when the notch C^6 of the rod is passed on to the stud C^6 the arm D^4 is brought
 "to the position shown in Figure 5 and the rod F is moved sufficiently to move
 "the clutch lever F^2 from the position shown in Figure 3 to that shown in 5
 "Figure 9.



"To permit the dobby cylinder G to be operated at the same time and to be
 "mounted on the same shaft C^2 as the shuttle box changing cylinder H and
 "allow the lag pegs H^2 on the latter to be brought into effect slightly later than
 "the pegs, bowls or their equivalent on the dobby cylinder we employ 10
 "compound levers for operating the rods J connected to the box motion levers
 " J^2 . These levers each consist of two simple levers L and K . The levers K

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“are pivoted side by side on the pin or shaft K^3 and one arm K^4 of each lever
 “projects over the shuttle box changing cylinder H whilst the other projects
 “over the arm L^3 of the lever L . Figure 6, represents a side view of the levers
 “when the lever K is not lifted and Figure 7, represents a similar view with
 5 “the lever lifted by a peg H^2 . The levers L are mounted upon a fulcrum rod
 “ L^3 by their slots L^4 and when the levers K are not lifted the springs L^5 hold



“the levers L with the bottom of their slots L^4 touching the underside of the rod
 “ L^3 . When however a lever K is lifted the lever L in contact with it is
 “depressed as shown in Figure 7 consequently tension is put upon the spring
 10 “and when the ordinary detent lever J^3 releases the box motion lever J^2
 “connected to the particular level L under mention by its rod J the spring L^5
 “contracts and lifts the lever L within the limits allowed by the slot L^4 and
 “thereby raises the rod J and the box lever J^2 connected to it. Figure 8,
 “shows the lever J^2 engaging the box motion lever J^3 .”

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The claims were—"1. A dobby in which the knife guides are inclined towards each other, substantially as herein shown and described. 2. A dobby which, when the jack levers are not 'lifting,' has the fulcrum of the bell crank levers in the same plane as the centres of connection of the hooks to the balk levers, and in which the centre of connection of the balk levers to the jack levers is in such a position that in the movements of the latter such centre passes equidistant on each side of said plane, substantially as herein shown and described. 2. 3. The combination of the rod C having a notched end adapted to be supported by one of such notches and the rocking shaft D³ having arms D, D³ and D⁴, substantially as herein shown and described and for the purpose specified. 3. 4. The combination of the levers K and L arranged and operating substantially as herein shown and described, and for the purpose specified."

On the 11th of February 1902, *George Hattersley & Sons, Ltd.*, as owners of this Patent, commenced an action for infringement against *George Hodgson, Ltd.*, claiming the usual relief.

The Particulars of Breaches complained of the manufacture and sale by the Defendants of several looms with dobbies, similar to the dobby described and claimed in the Plaintiffs' Specification, and also of the issue of a circular by the Defendants, in September 1901, entitled, *Hodgson's* new Patent one-shaft pick and pick-at-will drop box loom."

The Defendants, by their Defence, denied the validity of the Patent and also denied infringement, and contended that as one of the looms complained of in the Particulars of Breaches was delivered by the Defendants prior to the date of the amendment of the Plaintiffs' Specification, the Plaintiffs, pursuant to section 20 of the Patents, Designs, and Trade Marks Act, 1883, could not recover any damages in respect of such loom.

The Particulars of Objections were as follows:—"1. The invention was not new, but had been published (A) by the publication of the following Specifications:—(1) *Sowden* (No. 2861 of 1883); (2) *Hodgson* (No. 4687 of 1884); (3) *Day* (No. 2019 of 1885); (4) *Thompson and Japson* (No. 8952 of 1886); (5) *Nelson* (No. 8305 of 1893); (6) *Crossley* (No. 17,636 of 1895); (B) by the use and manufacture of looms containing the devices described in the Specification by the following persons:—(1) *George Hodgson*, at Bradford, in the year 1878; (2) *David Sowden & Sons*, at Bradford, in the year 1884; (3) Messrs. *Peates*, at Guiseley, in the year 1878; (4) *A. Moon & Sons*, at Guiseley, in the year 1878; (5) *George Hattersley & Sons*, at Keighley, prior to the year 1893; (6) *Hargreave and Massey*, at Leeds, since the year 1893; (7) *Dodgshaw & Co.*, at Hunslet, since the year 1893; (8) *Butterworth and Dickinson*, at Globe Iron Works, Burnley, since the year 1887; (9) *Butterworth and Dickinson*, at Westgate Shed, Burnley, since the year 1887. 2. Having regard to the state of public knowledge, the matters claimed in the Plaintiffs' Specification were not matters of invention but of re-arrangement, and the Letters Patent were invalid for want of subject-matter. 3. The alleged invention was not useful." The above Particulars of Objections were alleged against all the claims of the Plaintiffs' Specification.

Certain interrogatories were put by the Plaintiffs and answered by the Defendants with respect to the looms referred to in paragraph 1 (B) of the Particulars of Objections.

An application for leave to amend the Particulars of Objection was pending when the action came on for trial. The application was made to the Judge at the commencement of the trial, and was not opposed by Counsel for the Plaintiffs. The Particulars of Objections were therefore treated as amended by the addition of certain prior Specifications, the only one of which referred

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to at the trial was *Lake* (No. 679 of 1890), and by the addition of certain instances of prior user, none of which were referred to at the trial.

The action was tried on the 15th and 16th of July, 1903, by *Kekewich, J.*, who held that the invention was useless unless the centres of the levers were placed in certain particular positions; that since in the letterpress of the amended Specification there was no reference to the position of these centres, the invention was not described in the Specification, and that the Patent was invalid. The action was dismissed with costs.* The Plaintiffs appealed.

Bousfield, K.C., Astbury, K.C., and W. Neill (instructed by *Richard F. and C. L. Smith*, agents for *Spencer, Clarkson & Co.*, of Keighley) appeared for the Appellants; *Moulton, K.C., T. Terrell, K.C., and J. C. Graham* (instructed by *Bell, Brodrick and Gray*, agents for *Weatherhead and Knowles*, of Bradford) appeared for the Respondents.

Bousfield, K.C., and Astbury, K.C., for the Appellants.—The decision of *Kekewich, J.*, on the construction of the Specification was wrong. Claim 1 is not for any dobbie in which the knife guides are inclined towards each other, but for that feature in combination with the system of centreing shown in the Drawings. The Drawings are a part of the Specification, and the whole must be looked at for the purpose of construction. If this is the proper construction of the Specification, then on the evidence the Patent is perfectly valid. The invention had utility, for the machine had several advantages; for instance, there are no mislifts, and friction is reduced by the patented arrangement.

Moulton, K.C., and Terrell, K.C., for the Respondents.—On the true construction of the Specification the inclination of the knife guides to one another is claimed in any dobbie. Considering the Specification as though the amendments were not shown, this is its true construction. The Specification, as amended, does not describe in the letterpress the centreing arrangement; this is only shown in the Drawings, and it cannot, we submit, be that the inclination of the knife guides is only claimed in combination with the special arrangement of centres shown in the Drawings, the advantage of which is not pointed out. The state of the art was important, double and single lift dobbies were well known. Moreover, the arrangement of centres was not new, but had been published in *Lake's* Specification. There were several types of double lift dobbie, and the Patentees took one well-known type. The Patentees after two years of experimenting found the conditions under which the inclined guides were useful, but they did not tell the public what these were. The Defendants only use them to make more room; the reduction of friction has nothing to do with it. [The following cases were referred to, namely:—*Gandy v. Reddaway* (2 R.P.C. 49); *Heath v. Unwin* (5 H.L.C. 505); *Simpson v. Holliday* (L.R. 1 H.L. 315); also on the question of amendment *Moser v. Marsden* 13 R.P.C. 24.] If we are held to be wrong on the question of construction, the Patent is, we submit, invalid; first, because the Patent was anticipated or there was no subject-matter in view of *Lake's* Specification; secondly, Claim 3 discloses no useful invention; and thirdly, as to Figure 7, it had been anticipated by *Hodgson's* Specification and user.

Bousfield, K.C., replied.

COLLINS, M.R.—This is an appeal by the Plaintiffs from the decision of Mr. Justice *Kekewich*, who has held, on the construction of the Specification, that the Patent is bad. The question before the learned Judge resolved itself, I think, ultimately into a question of construction. There were other points raised, and the evidence was to some extent addressed to them; but I think substantially both parties ultimately—at all events before the decision was given—invited the learned Judge, or certainly did not object to the learned

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Judge treating the most substantial, and in fact the only real question in the case, as one of construction. I say that now, for I shall have to refer very shortly to arguments that have been addressed to us on some other points that might have been decided by the learned Judge, but which, at all events as to one of them, was not decided by the learned Judge.

The question arises in this way: the Patentees in their Complete Specification describe their invention thus:—"This invention relates to improvements in
"that class of weaving looms in which the shedding of the warp is effected by
"what is called a 'dobby.'" The shedding of the warp I may say has been
explained to us to mean a particular method of lifting certain of the threads in
the warp under or over which the shuttle has to pass, and thereby the pattern
is produced for the fabric which is woven. Then they go on to say: "When
"the draw hooks of a double lift dobbie engage with one of the draw knives
"and are 'drawn' or operated, the ends of the barks to which the hooks are
"attached describe a curve or move in a curved path, and rise or fall as the
"case may be according as to whether the lower or upper end of the bark is
"operated, and consequently the hooks do not remain in line with the direction
"of motion, which causes unnecessary friction and loss of power. To obviate
"this as much as possible we incline the upper and lower guides in which the
"draw knives work towards each other, sufficiently to raise the lower knives
"and lower the upper ones as the hooks are operated, and thus keep the hooks
"practically horizontal or in line with the direction in which they are moving."
I come at once to the point made. Claim No. 1 is: "A dobbie in which the
"knife guides are inclined towards each other, substantially as herein shown
"and described," and it is said that that is, rightly construed, a claim merely for
the knife guides inclined towards each other, and, if that should be the true
construction of the claim, it is a claim that is bad in itself, inasmuch as it is
common ground that knife guides alone disconnected from a particular mode
of centreing the levers which guide them would not be the subject-matter of a
Patent, and if this claim is construed as applying to all dobbies, whatever
system of centreing is adopted in them, then it undoubtedly would be too
wide, and, therefore, bad. On the other hand, it is admitted that if this is a
claim for a combination of the inclined knife guides with the particular mode
of centreing, which is in point of fact described in detail in the Drawings
accompanying the Specification, then no exception can be taken to it. The
combination would be perfectly good, the claim singly would be bad, and
the question then resolves itself into this—fairly construed, does this Specification
show a claim to such a combination?

It is a matter of history in this case that the original Specification has been amended and certain parts of it have been deleted, but in construing
this Specification I propose to omit those parts that are deleted, and in doing
so I think I am acting upon the authority of the House of Lords. The
case I refer to is not specially connected with Patents, but there are other
authorities, connected with Patents, which are to the same effect; but the
principle is most clearly laid down in the case of *Inglis v. Buttery & Co.*
in the House of Lords, reported in 3 Appeal Cases at page 552. This is the
head note:—"A firm of ship-builders agreed to lengthen and repair an iron
"steamship, the object being that she might be classed 100 A 1 at Lloyd's."
The specification forming part of the contract contained this stipulation:
"Ironwork.—The plating of the hull to be carefully overhauled and repaired."
Then came the words which were deleted, "but if any plating is required the
"same to be paid for extra," and that deletion was signed by the parties. "Held,
"affirming the decision of the Court below," and so on, "that neither the
"letters of the parties before the contract was signed, nor the initialed deleted
"words in the contract, could be considered for the purpose of interpreting the
"intention of the parties." In other words, that, for the purpose of construction,

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- you could not look at that which had originally been there, but which had been deleted. Following that out here, I am not going to draw inferences as to the true construction of what is left by reference to what has been deleted, but it is necessary for the Patentees, in order to be protected, to clearly show
- 5 what it is that they intend to cover. Therefore what we have to decide in this case is—whether on the fair construction of the Specification there is a claim for a combination. Now in my judgment (and I think it has been so held) a Patentee may show what he claims either by the printed matter of the Specification alone, or by the Drawings alone, or by the combination of the two.
- 10 In this case, it is common ground that if you are to take this Specification and claim as a claim for the particular arrangement, which is clearly shown on the Drawings, it is perfectly good, because it does show the upper and lower guides made to approximate towards each other, but the Patentees show that in connection with a system of centreing which is distinctly shown on the Drawings,
- 15 and which is the only system of operation that they show for working those guides; and if the combination there shown is their claim then they show, by the admission of both parties, a thoroughly efficient and useful way of producing the benefit claimed for this use of inclined guides. I have to see whether, fairly considering the Specification, the Patentees have so introduced these Drawings
- 20 into their description as to make the thing shown on the Drawings what they claim. I have read the initial part. I now come down to line 32: "To fully describe our invention reference is made to the accompanying sheets of Drawings forming a part of this Specification"—so that in the clearest possible words they make the Drawings part of their Specification—"in which similar letters
- 25 "of reference indicate corresponding parts in each of the figures." Therefore you really require the Specification itself as well as the Drawings in order to understand what these parts are, and what their relations are. You have them defined by certain letters on the Drawings, and references are made to those letters in the descriptive part of the narrative of the Specification. Then they
- 30 go on: "Figure 1 represents an elevation looking towards the front of the loom of such parts of a dobby as are necessary to illustrate the application of our improvements. Figure 2 is a separate view of one of the jack levers together with its balk lever and hooks," and Figure 2 is confined to that part of the dobby which they are depicting, which consists in what is called the centreing. That is clearly shown, and it is the subject-matter of a separate
- 35 Figure. No. 1 shows the centreing in connection with this mode of inclining the lower and upper guides towards each other. Then comes an important part of the Specification, as bearing upon this question, at line 42: "The upper guides A, A in the side frames A³ of the dobby in which the knives A³ work
- 40 "are inclined down towards the lower knife guides A⁴, A⁴, consequently as the hooks B, B move backward and forward their ends B², B³ are kept more in line with their centres of attachment B⁴ to the barks B⁵." We look at the Drawing showing the barks and showing their centres, and, therefore, it seems to me that the Patentees include the centreing arrangement which is there
- 45 indicated by those parts referred to in the Specification and indicated in the Drawing and make them part of the claim in respect of which they found their right to their Patent. It is not until after they have given those descriptions which are easily traceable on the Drawings by the letters which are referred to in the printed part of the Specification—not till that has been
- 50 explained in the language I have read—that they formulate their claim to a dobby in which the knife guides are inclined towards each other, substantially as herein shown and described." Now the only dobby that they show here is a dobby centred according to the particular method which in fact it is admitted makes it workable and useful. It is said that that
- 55 is the only method by which it is workable and useful, and if it be the only method it seems to me it is most distinctly portrayed on the Drawings

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and referred to in the Specification as being part of that which is covered by the invention—a part of the combination consisting of the special mode of centreing as well as this particular mode of bringing the upper and lower guides towards each other. It is said that the learned Judge held that, having regard to the words used (which I have just read) in the first claim, that must be taken to be a claim for this particular merit of causing the upper and lower guides to work towards each other; that it is a claim for that into whatever dobby it is put—that is to say, whatever system of centreing the levers is adopted—and that, if that be so, the claim would necessarily be bad because it will not work with every dobby, but will only work with one particular centreing arrangement in a dobby. There was a point made which is not now material in this case—that, if the claim is properly a claim for a combination, the centreing arrangement was not new. No doubt the Patentees were under the impression at one time that they had themselves invented the particular arrangement of centreing which they show. It turned out that they were wrong there, although they had as a matter of fact, I think, independently reinvented it; but somebody had already hit upon that special mode of arrangement before and made it the subject-matter of, or had embraced it in an application which he had lodged for another Patent. That was a Patent granted to a man called *Lake*; but that Patent, so far as the evidence goes, never really was workable and never worked, and the best possible compliment has been paid to the Plaintiffs' invention by the Defendants in this case in that, although they appear to have had *Lake's* Specification before their eyes, they deliberately chose to make a machine following in all respects that which has been indicated in the Plaintiffs' Specification, and the Defendants have not chosen to try to successfully operate *Lake's* Patent. I only mention that, for it is not really important here on the main point that I have been discussing, namely, whether the claim itself is a claim for a combination which is in fact admitted by both parties to be a very efficient machine; if the claim does embrace that combination, then this Patent is good. If it is limited to the first part—namely, the inclination of the knife guides—then, for the reasons I have already referred to, it is bad; and that is the view which Mr. Justice *Kekewich* has adopted. In my judgment, for the reasons I have given, there is sufficient on the face of this Specification, taking the printed matter and the Drawings together, to portray this particular combination, and there is nothing in the claim itself in the Specification and on the Drawings to show that the Patentees ever meant to embrace any other method of actuating these guides than centreing them, and that, therefore, it is a combination which in itself is good, although one of the factors of the combination was not new. That is really the main point in the case, and the point on which I think it was really argued and decided, but Mr. *Terrell*, at the end of the case, made a point which was not made by his leader, Mr. *Moulton*. He said that there were two subsidiary points, one that the invention was not useful, and that, therefore, it was not the subject-matter of a Patent; also that *Lake* also had entirely anticipated it, and he said that point had not been fully discussed below, and that he ought to have an opportunity of thrashing the whole of that out again in a new trial. But, when one comes to look at the admissions made in the course of the case, it seems to me quite clear that all parties admitted the utility of this invention, and proved it by adopting it. I think, on the evidence, it was quite clear that *Lake* was not an anticipation of the Plaintiffs' combination. *Lake* had really, on the evidence, never produced an efficient working machine at all; and, when one comes to examine that which he purported to effect, it seems to me that it is a different thing effected in a different way, and, in addition, as I have said, was never a workable Patent at all. That disposes of *Lake's* matter, which properly dropped into an entirely subordinate position in the discussion of the case.

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Then Mr. *Terrell* took another point. He said this Patent is bad on the ground that what is now the third claim does not describe what purpose the arrangement there suggested is meant to carry out ; that it is simply, as it were, an unmeaning paragraph. It is this : "The combination of the levers *k* and *l* 5 "arranged and operating substantially as herein shown and described and for "that purpose specified." Mr. *Terrell* says that is a mere idle piece of language not indicating even that this combination is in a dobby, and not sufficiently describing any purpose accomplished by it, and, therefore, it ought to be treated as nugatory and bad. But when one comes to look at that claim it is abundantly 10 clear from the context that this combination is a part of the dobby, and the purpose specified is most clearly set out, it seems to me, in that part of the letterpress which is addressed to the description and explanation of that particular arrangement.

I have referred to those points because Mr. *Terrell* pressed them upon us at 15 the end of the case, but it is quite obvious that they were really altogether a *tabula in naufragio* as Mr. *Bousfield* suggested, and that though the evidence was sufficient to admit of the points being raised they were not serious points in the case, and, therefore, the learned Judge was perfectly right in deciding what was really the main point in the case.

20 But there was one other matter which Mr. *Terrell* relied upon also, which was not discussed or dealt with by the learned Judge, and that was with respect to a particular contrivance, which, he said, had been anticipated by Mr. *Hodgson*, who had, in effect, used and explained a contrivance identical with what is shown in Figure 7 in the Plaintiffs' Specification, and no doubt there was some 25 evidence given on that. Now that really depends on the evidence of the experts ; their opinions were read to us, and it seems to me that there is a clear preponderance in favour of the Plaintiffs on that matter. Mr. *Dugald Clerk* and also Mr. *Jackson*, one of the Patentees, explained what the purpose was, which this particular invention described, and which in Figure 7 was explained. 30 Those gentlemen pointed out that, to begin with, it was not designed to bring about the same end, and, secondly, that the means used were not the same means as those used in *Hodgson's* Patent. No doubt there is the mechanical similarity which must always exist in these cases, where different contrivances, known to mechanicians, are adopted ; and Mr. *Swinburne*, who 35 was the witness examined for the defence, took that view. Speaking, as it seems to me, broadly, and not in connection with the special purpose for which this particular mechanism was required, he gave a general opinion that there was nothing new in the arrangement. That is a general observation, which may be true in a great many cases, where the particular arrangement for the 40 particular purpose involves ingenuity and invention. It is precisely on that point that I think his evidence was outweighed by the evidence of the other experts called for the Plaintiffs, who addressed themselves, not to the abstract question whether this was a combination which might not be put together by any competent person skilled in those matters, but whether, having regard to 45 the particular aim which the inventors had in view, it was not a new invention—that is to say, whether it did not require invention to accomplish the end in view by the means used. It was really, as I have said, a bye-point in the case, and to have gone into it at any great length would have involved, really, trying an independent Patent case, and, although the point was touched upon in 50 argument in the course of the defence before the learned Judge below, it was not emphasised in such a way as to invite the Judge to decide the case on that ground, or to give an opinion about it, and he did not, in fact, give an opinion upon it. But I think there is quite sufficient evidence before us to justify us in saying that the Defendants have failed by their evidence to show that the 55 opinion of the witnesses for the Plaintiffs is not the better opinion of the two. It seems to me they have not displaced the very clear opinion of those gentlemen,

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that there was invention and novelty in that contrivance, and a useful purpose served by it. Therefore, taking the whole case together, it seems to me that the learned Judge in refusing to give effect to the Plaintiffs' claim was wrong, and that his decision must be reversed.

ROMER, *L.J.*—I have come to the same conclusion. In the first place, with regard to the main point that was argued before us, and on which Mr. Justice Kekewich decided this case, I am of opinion that the Appellants are right. The question is one of the construction of the Specification and the claim in the Specification, and in itself it is to my mind a simple question, although possibly it may not be so easy to determine as it appears at first sight; but I cannot say for myself that it appears to me a very difficult question, nor is it one about which I personally feel any doubt.

In my opinion, on the true construction of the Specification, the claim of the Patentees is not for any dobby in which sloping guides are used. Moreover, I think, on the fair reading of the Specification and claim, the Patentees have not committed themselves to the statement or position that sloping guides can be advantageously used with any ordinary form of dobby previously used or known. I think that the Specification shows that Claim 1 is for a dobby with sloping guides shown and described in the Figures which form part of the Specification, and in particular a dobby with what has been called the centreing arrangement which is shown in those Figures. Clearly the Patentees have limited their claim to a dobby with sloping guides, and they have shown that they consider those sloping guides essential and distinguishing features of the invention, but, in my opinion, they have not done more than that or intimated, as suggested on behalf of the Respondents, that nothing in their patent dobby is to be regarded or considered except the guides. As my Lord has pointed out, if you look at Claim 1 as worded in the amended Specification, how does it run in the first place grammatically? What is the claim? It is for a dobby in which the knife guides are inclined towards each other substantially as herein shown and described. To my mind grammatically it is clear that the words "substantially as herein shown and described" apply to the dobby, and do not apply merely to the knife guides. The only generalisation, as it appears to me, that you get in that claim is in the words "substantially as herein shown and described." Of course, we are referred by that to the dobby, which is shown and described in the Specification.

Now have the Patentees shown nothing in this Specification except sloping guides, and left any workman considering this Specification or seeking to make the dobby no intimation how to proceed to make that dobby except by saying he must have sloping guides, and leaving the rest to the workman to ascertain by his pre-existing knowledge. To my mind the Patentees have not done that. After pointing out on page 2 of the Complete Specification what are the defects in an ordinary dobby they proceed to point out, first, that to obviate that they incline the upper and lower guides. But they do not stop there. They proceed, passing over some intermediate passages which are not material to the present point, to state what their invention is on page 3, line 32, in these words: "To fully describe our invention reference is made to the accompanying sheets of Drawings forming a part of this Specification." They then refer to the Figures and say, for example, that "Figure 1 represents an elevation looking towards the front of the loom of such parts of a dobby as are necessary to illustrate the application of our improvements"; and in Figures 2, 3, and 4 to 9 they say are found details referred to in the Specification. Now have they not indicated there that they are going to make the Figures an essential part of the Specification, and essential to fully describing their invention and to enabling their dobby to be made? I think they certainly have. To my mind those Figures, when properly looked at do clearly show all the parts of the dobby essential to enable a

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workman to properly make it, and in particular show that improved centreing arrangement which has been so much discussed in the course of the argument before us. If the Patentees had left their Specification with a mere reference to the upper and lower guides, and with a mere reference to the

5 Figures as showing the position of those guides, I think it is reasonably clear that it would be said that such a Specification would be wholly insufficient. I can well understand how the Specification would have then been attacked from another point of view; but the Patentees to my mind have not been guilty of such folly. Besides pointing out one distinguishing feature, perhaps what the

10 Patentees think the most distinguishing feature in their invention, namely, the sloping guides, they proceed to point out how that general idea is to be worked out in a practical dobby, and they then by the Figures call the attention of the workman who has to form the dobby from the Specification how that dobby is to be made, and how those guides when shaped are to be made part of a workable

15 dobby. To my mind it would be very unfair as against the Patentees of this invention to try and commit them to such a position as that which the Respondents to this appeal urge that they must be held to have taken up by their Specification. As I have said, the grammatical form of Claim 1 is in their favour, and to my mind there is nothing which would justify this Court in

20 cutting down that claim as it stands, or, rather, enlarging it as it stands. It seems to be reasonably clear in itself that what the Patentees claim is the dobby as a whole which they have specified with the sloping guides as shown in the Figures, and what they warn a person he must not take in imitating that is this—he must not substantially take that dobby as shown and described by

25 them. Now I can understand that if the Figures were not in themselves sufficient to enable an ordinary workman acquainted with this class of work to practically form the Plaintiffs' dobby the Patent would fail; but it is common ground here that the Figures are sufficient, and that a person of any intelligence or an ordinary workman taking up this Specification, looking at the Figures and

30 seeking to make a dobby in accordance with the Figures, could and would easily make the patented dobby which the Patentees have claimed by their Specification. The claim then is a good claim, and it is one which a workman can carry out. The Specification is one which a workman can carry out, the utility of the invention is not in substantial dispute; subject to one

35 point I will mention later, and the infringement is admitted practically before us. That being so, on this part of the case it is clear that the Appellants are right.

Before parting with this part of the case, with reference to certain special arguments which were adduced to us, and in particular by Mr. *Moulton*, let me

40 say that I do not find in this Specification any representation that a workman may substantially depart from the Drawings, and that nevertheless if he does so the dobby shown with sloping guides must work or be advantageous. There is no statement to that effect, nor can it be, I think, that any such statement can be implied. The Patentees have not said or represented that if you substantially

45 depart from the dobby shown in the Figures you will get any advantage by using the sloping guides. Further, with reference to another analogous argument used on behalf of the Respondents, that the Patentees have not pointed out the great advantage of the centreing arrangement, that, in my opinion, it was not necessary for them to do more than they have done—point

50 out the centreing arrangement as part of their dobby. They were not bound, to my mind, to do more than that. The centreing arrangement, as I have said, is clearly pointed out in the Figures as part of the dobby, and, as I have already said, it can be made by a competent workman, and, that being so, the Patentees were not bound to further dwell upon the importance of that centreing arrangement

55 any more than they were bound to dwell upon or to use words of great praise with regard to any other portion of their dobby, or even with regard to

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the sloping guides. It is sufficient for a Patentee to say, "That is what I direct a workman to do," and he is not bound with regard to each step that he goes through to call the workman's attention to the particular advantages of each step. All he has to do is to fairly state what his invention is, and, in my opinion, that is what the Patentees have done here. 5

Therefore, as I have said, on the main point argued before us I am clearly of opinion that, on the question of construction, the Appellants' view is the correct one, and that Mr. Justice *Kekewich* has come to a wrong conclusion.

With regard to the minor points suggested, I have very little to add to what the Master of the Rolls has said. With regard to the suggestion that there was no subject-matter in this Patent having regard to the invention of *Lake*, I need only say that, in my opinion, *Lake* was no anticipation of the Plaintiffs' dobby, and that I think, notwithstanding the general knowledge existing at the time, and notwithstanding *Lake's* Specification, there was invention needed to arrive at the Plaintiffs' dobby, and that its utility to my mind is beyond question. On a point of this kind, of course, one would naturally look to see what the expert evidence is, and on this point we have Mr. *Dugald Clerk's* evidence, and no evidence against it. The expert witness for the Defendants was not asked any question on the subject. I know it has been suggested that it may have been through inadvertence, or through a mistake or something of that sort, that that was not done. All I can say is that the Plaintiffs are not responsible for that, nor do I think that any suggestion of that kind is sufficient, under the circumstances of this case, to justify this Court in saying that the case must not be decided on the evidence as it stands. I cannot see that any advantage was taken of the Defendants by the Plaintiffs in any way, or that any mistake, if there was any, has been induced by the Plaintiffs. That being so, it appears to me that the second point taken on behalf of the Respondents fails. 10 15 20 25

As regards the last point, the suggestion that Claim 3 of the Specification as amended was not useful, or if useful was anticipated by *Hodgson*, I can only say that, after having carefully listened and done my best to appreciate the points arising, I come to the conclusion that Claim 3 was good when you bear in mind what it is. It is a claim clearly limited to a special part of a loom, and the claim is limited on behalf of the Patentees as a device for doing a very special kind of work, and as solving a particular problem which they had to consider in inventing their dobby and the application of the working power of that dobby to the loom generally. On the evidence as a whole I should have come to the conclusion, even apart from the expert witnesses, that it did require invention to ascertain that particular device, for the purpose of solving the particular problem that the Patentees had set before them. I quite agree that if you were to consider the claim as one for a device, constituting in itself a mechanical tool,—a claim for the device at large, apart from the loom and the special part of the loom to which it was to be applied and without regard to the special problem which had to be solved by the application of the device—this claim might be bad and could not be supported. Indeed at the present day it is very difficult in any case to support a claim to what is substantially a new tool if you regard it as being claimed at large and not as applied and limited to the solution of a particular problem or applied for a special purpose. To my mind this is not a claim for a device at large, but it is limited in the way I have indicated. 30 35 40 45 50

Then with regard to the expert evidence, you have on the one side the evidence of Mr. *Dugald Clerk* and Mr. *Jackson* clearly supporting and showing that Claim 3 was in substance a thing that required invention and was not anticipated by *Hodgson*. With regard to Mr. *Swinburne*, a witness of great eminence and a very fair witness, I can only say that if you look at his evidence carefully he was really giving his evidence with reference to a 55

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consideration of the device as being claimed by itself—at large as I have said—and was not really considering the question in the limited way in which it really arises—as a limited claim, as I have indicated. He was not considering it, to my mind, with reference to the special problem which the Patentees had
5 in view when they invented the device and claimed it in Claim 3. I think, on the evidence as a whole, the Respondents' case with regard to the third claim also fails, and that the Plaintiffs are therefore entitled to judgment in this action.

MATHEW, *L.J.*—I am of the same opinion. As was said at the commencement of the case, and admitted over and over again, this was a matter of construction. It is a question of fact in every case—a question of fact to be decided by the Judge as to the meaning of the document with which he has to deal.

The case of the Plaintiffs is plain; they complained that the directions contained
15 in their Specification with the accompanying Drawings had been followed by the Defendants, and that they had produced the machine which was the subject of the invention, and the Defendants admitted that, and they admitted the usefulness of the machine. They admitted that the instructions had been followed, and admitted that a similar machine had been produced. Their only defence was
20 that they were justified in what they did because the Patent was bad. Now the way in which that was sought to be made out was this: it was said in the first place, if this Specification is looked at, it claims the application of what the Patentees have described to all dobbies; that it is, therefore, too wide, and upon that ground alone the Patent is bad. It would be a very
25 extraordinary thing if, with the information we have about these machines, any such preposterous claim could be put forward by any Patentee, because it would be manifestly absurd and the Patent would be worth nothing. It was agreed that with all dobbies, so far as the Patentees knew, the application of their machine was not available and only useful as they described it in
30 the Drawings accompanying their Specification. I am entirely of opinion that the Plaintiffs have made out that first point, and that their opponents, the Respondents in this case, are in the wrong. The Patentees have made no such claim, it appears to me, upon the fair construction of the language that was used.

Then, in the alternative, the point was taken: Suppose the claim is to be
35 restricted to that which is described in the Drawings, that is not enough, because you ought to have in the letterpress a specific claim with respect to that which may or may not be adequately described in the Drawings, and, even if it be completely described in the Drawings, it is not enough; and that that
40 is a rule of construction which ought to be applied to all Specifications. I confess when this argument was put forward with the confidence that it was I was prepared to find that there would be some *obiter dicta* cited to us from some previous cases to show that there was some justification for the argument. It is an argument that there is something special about a Specification, and that
45 the ordinary rules of construction ought not to be adopted. There was no reason for it, and, as it turned out, no authority approaching it. We must deal with this document as we should with any important contract, and be guided by its terms without reference to those appeals that have been made to our feelings about the interests of the public in Specifications. We know what a
50 Specification is intended for: it is in accordance with the contract made between a Patentee and the Crown that he shall disclose to people who know about the matter, and to the experienced workmen who will be employed, what it is that he is patenting. If that be the rule to be applied to this case, it seems to me to be manifest that all the Patentees claimed was the invention
55 as described in the Drawings to which they referred in the other portions of the Specification. There is no indication of an intention to apply it to all

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debbies ; on the contrary, every precaution that could be taken has been taken, and it would be because there was reason for considering what was done in reference to this case—every precaution appears to have been taken to restrict what was claimed to what was described in the Drawings. What the Patentees say is : "What we have stated in the letterpress is not enough," so they say : 5: "To fully describe our invention reference is made to the accompanying sheets " of Drawings forming a part of this Specification, in which similar letters of " reference indicate corresponding parts in each of the Figures." Then the next passage has been referred to by Mr. *Terrell* as in his favour, but it favours the construction of the Plaintiffs : "Figure 1 represents an elevation looking : 10: " towards the front of the loom of such parts of a dobby as are necessary to " illustrate the application of our improvements."

As some reference has been made to what has been deleted from this Specification, I should certainly be disposed to excuse the man who did not endeavour to supply what it was said the letterpress ought to contain, having 15 before him the language of that portion of the Specification. It is sufficient without reference to what has been deleted—and of course no reference ought to be made to what has been deleted—to use the language which has been used there to express what the Patentees intended. Now that being my clear construction of what was intended, and being satisfied 20 that that was what was known to be intended, first, by the Plaintiffs, and, secondly, by the Defendants, the construction that has been put upon the Specification by my learned brother Mr. Justice *Kekewich* seems to have been wrong. I should be loth to accept for a moment the suggestion that has been made that, although a Drawing may be sufficient to indicate what the Patentee 25 intended, unless he incorporates in the letterpress what he intended to convey by his Drawing his Patent is invalid. There is no such rule, and I have not the least anticipation that such a rule will ever be laid down. Therefore, I agree that the appeal must be allowed.

The appeal was allowed with costs of the appeal and below. 30

Certificates were given that the Particulars of Breaches were proved and that the validity of the Patent had come in question. Judgment was given for an injunction, an inquiry as to damages, and delivery up of infringing articles.

After considerable discussion it was arranged that the delivery up and the inquiry as to damages should be stayed pending an appeal to the House of 35 Lords.

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IN THE HOUSE OF LORDS.

Present : LORD MACNAGHTEN, LORD DAVEY, LORD JAMES OF HEREFORD,
and LORD ROBERTSON.

April 28th and 29th, and May 19th, 1904.

5 CHEMISCHE FABRIK VORMALS SANDOZ v. BADISCHE ANILIN UND SODA
FABRIK.

Patent.—Action for infringement.—Practice.—Service of notice of writ out of the jurisdiction.—Motion to set aside refused.—Appeal dismissed by Court of Appeal.—Appeal to the House of Lords dismissed.—Order XI., Rule 4.

- 10 *The owners of Letters Patent obtained leave to serve notice of the writ in an action for infringement of the Patent on the Defendants out of the jurisdiction. After service the Defendants moved to set the proceedings aside. In answer to the affidavits filed on behalf of the Plaintiffs, the Defendants filed affidavits stating the course of their business, and they contended that all that they did*
- 15 *within the jurisdiction was to enter into contracts for delivery of the goods abroad, and that that was not infringement, and there was no cause of action. The Plaintiffs, on the other hand, alleged that the Defendants' travellers brought samples of infringing dye into this country and used them in obtaining orders, that the Defendants had extensively infringed, and that six cases of infringe-*
- 20 *ment had come to their knowledge. Held, by the Court of Appeal (affirming Joyce, J.), that, the Plaintiffs having raised a prima facie case of infringement not completely displaced by the Defendants, and there being on the affidavits a conflict of fact, the Court would not try the questions raised at this stage, and the appeal from Joyce, J., who had refused the Defendants' application, was*
- 25 *dismissed, and a stay of proceedings pending an appeal to the House of Lords was refused. The Defendants appealed to the House of Lords.*

Held, that the Orders appealed from should be affirmed, and the appeal was dismissed with costs.

Observations on the evidence required in support of an application to

30 *discharge an order for service out of the jurisdiction.*

Chemische Fabrik vormals Sandoz v. Badische Anilin und Soda Fabrik.

On the 20th of January 1903, the *Badische Anilin und Soda Fabrik* (a Company incorporated according to the laws of the Grand Duchy of Baden, in the Empire of Germany) commenced an action against the *Chemische Fabrik vormals Sandoz* in Basle for infringement of Letters Patent No. 9633* of 1892 (granted to *J. Y. Johnson* on a communication from abroad) for "The 5
"manufacture and production of new basic dyestuffs."

Leave was given to serve notice of the writ on the Defendants at Basle or elsewhere in Switzerland. On the 3rd of February 1903 the Defendants entered a conditional appearance without prejudice to an application to set aside the writ, the Order giving leave to issue and serve, the service thereof and all other 10
proceedings : and on the 10th of February 1903 they served notice of motion to set aside the same.

The evidence consisted of the affidavit of *J. Y. Johnson*, a member of the firm of the Plaintiffs' solicitors, on which the leave to serve out of the jurisdiction was given, an affidavit by *Dr. Ehrhardt*, chemist at the Plaintiffs' works, made 15
on motion for an interlocutory injunction, but in regard to which notice to read was given, and, on behalf of the Defendants, an affidavit of *Werner Stauffacher*, one of the commercial managers of the Defendants, and two affidavits of *Fritz Riecke*, a traveller of the Defendants. Mr. *Johnson* in his affidavit, after stating the nature of the action, said (*inter alia*) that he was advised and believed 20
that the Plaintiffs had a good cause of action against the Defendants for infringement within the jurisdiction of the Patent ; that he was informed and believed that the Plaintiffs were satisfied that the dye manufactured by the Defendants and sold within the jurisdiction under various names was made according to the patented invention, and that the importation and use thereof 25
was an infringement of the Patent ; that the Defendants carried on business as manufacturing chemists ; that he was informed and believed that the Defendants had extensively infringed the Patent ; that great damage had been and would continue to be caused to the Plaintiffs if the Defendants continued to infringe ; that he was informed by the Plaintiffs and believed that for several years past 30
the Defendants had systematically infringed the Patent on a considerable scale, and, although the Plaintiffs had continually done their utmost to detect them, they had been unable to do so until recently ; that the manner, as he was informed by the Plaintiffs and believed to be true, in which the infringements complained of had been carried on by the Defendants was as follows :—"The said 35
"Defendants send to this country a traveller or travellers who call upon dealers "and consumers of dyestuffs in England, bringing with them samples of the "dyestuffs patented under the said Letters Patent No. 9633* of 1892, and specimens "of fabrics dyed therewith. The Defendants or their travellers have used the "said samples and specimens to show the good qualities of the patented dye 40
"and illustrate the effects that can be obtained with it, and left such samples "and specimens with their customers, and by reason of such use of the dyestuffs "patented to the Plaintiffs they have succeeded in obtaining orders and "contracts for the supply of the said dyestuff, whereby the Plaintiffs are 45
"deprived of considerable profit and advantage accruing from the invention "patented to them under the said Letters Patent. The said orders are accepted "and contracts made in England by a responsible representative of the said "Defendants " ; that he was informed by the Plaintiffs and believed that the Defendants had in the above manner, at various times since the year 1896 and previously to the issue of the writ, thus imported into the United Kingdom 50
samples and specimens in large numbers, but had also imported into and sold in the United Kingdom large quantities of the said dyestuff under various names in infringement of the Patent. Dr. *Ehrhardt* stated (*inter alia*) that he had the management of all matters relating to the Plaintiffs' Patents in the United Kingdom ; that a certificate of the validity of the Patent had been granted 55
subject to an amendment which had been made ; that the Plaintiffs manufactured

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according to the Patent a fast red dye known in the trade as "Rhodamine 6 G," which was very valuable; that the Plaintiffs were constantly troubled by infringements of their various Patents, mainly arising through the importation into the United Kingdom of dyes manufactured in Switzerland; that there was always the greatest difficulty in intercepting such infringing dyes or proving importation of the same into and sale in the United Kingdom by reason of the facilities for forwarding small quantities of considerable value; and, after naming numerous Defendants against whom the Plaintiffs had been successful in actions for infringement of the Patent, said that in no fewer than six cases the Plaintiffs had found that the Patent had been infringed by the Defendants on a large scale; that the information enabling the Plaintiffs to commence the proceedings had only recently been received by them; that he was informed and believed that for several years past the Defendants had systematically infringed the Patent on a very considerable scale (the manner of the infringement was in paragraph 10 stated exactly as in paragraph 6 of *Johnson's* affidavit quoted above). Mr. *Stauffacher's* affidavit included the following paragraphs—"5. The Defendants, being owners of Letters Patent in England as aforesaid, have made it a practice to recognise, although not necessarily thereby admitting the validity of the same, the Patent rights of others in England. The Defendants accordingly have always carefully distinguished between consumers and non-consumers in the following respects: There are now produced and shown to me and marked respectively 'W.S. 3,' and 'W.S. 4,' the price lists sent by the Defendants to consumers and dealers respectively. The Defendants' agents in England, who are four in number, and permanently resident in England, regularly visit consumers in England, but never visit non-consumers, that is to say, dealers. The Defendants' said agents have always been instructed not to offer to consumers any dye patented in England, and I believe and am informed that they have always conformed to such instructions. From time to time consumers in England have asked Defendants to supply dyes patented in England, but the Defendants have always refused to supply dyes patented in England, even though delivery at Basle or some place on the Continent was contemplated by such consumer. I verily believe that the Defendants have never sold even unknowingly to any consumer in England any dye patented in England. Non-consumers in England, that is to say, dealers such as dyesalters and exporters, are not visited by the Defendants' agents, and all negotiations between dealers and the Defendants, except as hereinafter mentioned, have been always direct with the Defendants' office in Basle. In every case, except as hereinafter mentioned, the order from such dealers has been accepted by letter written at Basle, and forwarded through the post to the purchaser's address in England, and, as provided, delivery has been made at Basle or elsewhere on the Continent to the order of the purchaser. (6) The exceptions referred to in the last preceding paragraph are the following. I personally visited England in 1901, and had negotiations with two dealers, and from each obtained an order for some of the dye 'Rhodamine 6 G,' claimed to be patented under the Letters Patent No. 9633* of 1892, which I communicated by letter to the Defendants. In the case of one of these dealers the order was for 240 lbs., and the dealer wrote to Basle to the Defendants requiring immediate delivery, which the Defendants made, as provided for in the order, to agents in Basle, Messrs. *Niebergall & Goth*, of the purchaser to the order of the purchaser. In the case of the other dealer the order was for 120 lbs., and the Defendants wrote from Basle to the dealer accepting the order. In this latter case, as provided for in the order, delivery was made to the agents, Messrs. *Jaeky, Summerer & Co.*, in Basle, of the dealer, to the order of such dealer. On the occasion of this visit I had with me neither sample of the dye nor any specimen of fabric dyed therewith, nor did I use such in any

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" way in the aforesaid negotiations. In the case of one of the said orders the
 " Defendants have no knowledge where the goods went to after leaving Basle ;
 " in the case of the other they know that the goods did not come to England.
 " The only traveller the Defendants have is Mr. *Fritz Riecke*, who twice or three
 " times a year visits England. In company with one or other of the aforesaid 5
 " agents he calls upon consumers, and also alone calls upon dealers. He has never
 " had with him any sample of the said dye 'Rhodamine 6 G,' but has had some of
 " the pattern cards hereinafter mentioned. He does not show such pattern cards
 " to dealers because only consumers are interested in seeing the specimens of
 " dyed fabrics. He has never offered to sell to any consumer 'Rhodamine 6 G,' 10
 " and has never obtained any order for such dye from any consumer. He has
 " obtained from dealers orders for 'Rhodamine 6 G,' which he has communicated
 " to the Defendants in Basle. In every case such orders were for delivery at
 " Basle to the order of the dealer, and, where accepted by the Defendants,
 " delivery was so made. The Defendants do not always accept the orders 15
 " transmitted to them by their traveller, but if they accept they intimate their
 " acceptance by letter written in Basle. (7) The Defendants' agents, when
 " calling upon consumers in England, do not have with them samples of any
 " dye patented in England. They do have with them the aforesaid pattern
 " cards of yarn dyed with different dyes, some of which dyes are patented in 20
 " this country. In two series of these pattern cards, namely on wool and
 " cotton respectively, there are one and three specimens respectively showing
 " the effect of 'Rhodamine 6 G' used in dyeing on cotton or wool out of the 96
 " specimens on each such card. These pattern cards are used by the Defendants
 " for all countries, and it would be too expensive to prepare special cards for 25
 " the different countries, excluding for each country all specimens of fabric
 " dyed with any dye patented in such country. In no case, as I verily believe
 " and am informed, have the Defendants' said agents or traveller made any
 " offer or solicited any order in England on the basis of the aforesaid specimens
 " of the effect of 'Rhodamine 6 G.' The Defendants have never offered to sell 30
 " or accepted any order on the basis of such specimens of 'Rhodamine 6 G' in
 " or from England or any country where the said dye is patented." The
 " affidavit went on to deny that, unless on the facts in paragraph 6 it could be
 " held to the contrary, the Defendants had ever within the jurisdiction sold
 " or agreed to sell "Rhodamine 6 G," or infringed the Patent ; it also stated (*inter* 35
alia) that the Defendants had sent by post to England to dealers, but never to
 " consumers, small samples of the dye, but the total value of such samples since
 " 1896 would not exceed ten shillings, and the Defendants had never received
 " any payment for such samples ; also that there was a large business done by
 " English firms in the said dye for export to countries where the dye was not 40
 " patented, as, for example, India and Canada. Mr. *Riecke's* affidavits cor-
 " roborated Mr. *Stauffer's* affidavit in respect of his acts as traveller for the
 " Defendants.

JOYCE, J., refused the motion with costs, holding that there were questions
 of law and fact to be tried, which he declined to try at the then present stage 45
 of the action.* The Defendants appealed. The Court of Appeal held that the
 Plaintiffs had raised a *prima facie* case of infringement not completely
 displaced by the Defendants, that there was a conflict of fact on the affidavits,
 and that the Court was not bound to try the questions raised at that stage.
 The appeal was dismissed with costs.† The Defendants appealed to the House 50
 of Lords.

On the hearing of the appeal, *Asquith*, K.C., *Upjohn*, K.C. and *Colefax*
 (instructed by *G. B. Ellis*) appeared for the Appellants ; *Moulton*, K.C.,

* 20 R.P.C. 416.

† 20 R.P.C. 478.

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Cripps, K.C., and *J. C. Graham* (instructed by *J. H. and J. Y. Johnson*) appeared for the Respondents.

- Asquith*, K.C., for the Appellants.—The Plaintiffs are the owners of an English Patent relating to anilin dyes. The Defendants carry on business at Basle in Switzerland. Both parties are domiciled abroad. The question is whether there has been an infringement of the Plaintiffs' Patent in this country. Leave was granted to serve the writ out of the jurisdiction. A motion to set aside the Order was refused by *Joyce*, J., whose judgment was affirmed by the Court of Appeal. The Defendants in their affidavits have described with great minuteness their method of carrying on business. There is no evidence in reply, and the Defendants' affidavits are not contradicted. The Defendants have thrown all their cards upon the table and are entitled to a judgment now, as to whether what they have done is an infringement of the Plaintiffs' rights. The agents of the Defendants in this country have in their possession pattern cards containing, among others, samples of yarn dyed with the patented dyestuffs. These pattern cards are shown to consumers but not to dealers. No order has ever been taken from a consumer for the patented dyestuff. On a very few occasions orders have been taken in this country from dealers for delivery abroad of quantities of the patented dyestuff. This is not an infringement, *Saccharin Corporation v. Reitmeyer* (17 R.P.C. 606). Occasionally samples of the patented dyestuff have been sent by post to dealers in this country at their request. This also is not an infringement, *Badische Anilin und Soda Fabrik v. Johnson* (14 R.P.C. 919). The Defendants are entitled to do what they have done. The Plaintiffs' affidavits are vague and indefinite, they do not mention name, or place, or date. The Defendants have fully disclosed their methods of dealing, and their evidence is uncontradicted. All that the Crown can grant to a Patentee is the monopoly of the "sole working or making of any manner of new manufacture within the "Realm" (S. 6 of the Statute of Monopolies). The form of grant of Letters Patent in use at the present time grants the monopoly "to make, use, exercise, and vend," but the meaning of these words is limited by the words of the Statute of Monopolies *Holmes v. London and North Western Railway* (Macrory 13).

- Upjohn*, K.C., followed.—An application for leave to serve a writ out of the jurisdiction must be made in accordance with the provisions of Order XI., r. 4. The words "Under this Order" in this rule, refer back to the seven cases (O. XI., r. 1) in which service of a writ out of the jurisdiction is allowed. The Plaintiffs' affidavits do not show that the case comes within the Order. Again, it is not sufficient that the form of the action, and the nature of the relief sought, bring the case within O. XI. The Plaintiffs must show that they have a probable cause of action, and the Court in exercising its discretion will consider the facts; *Société Générale de Paris v. Dreyfus Brothers* (L.R. 37 C.D. 215); *Fowler v. Barstow* (L.R. 20 C.D. 240). Mere possession of an infringing article in this country is not enough, there must be evidence of intention to use it. [Lord DAVEY referred to *Caldwell v. Van Vlissingen* (9 Hare, 415) and *Adair v. Young* (L.R. 12 C.D. 13)]. In any case the Defendants are entitled to a judgment at once upon the facts admitted by them. If there were any conflict of evidence here no doubt there should be a trial, but the Defendants' evidence is uncontradicted.

- Moulton*, K.C., and *Cripps*, K.C., for the Respondents.—There is a conflict of fact on the affidavits, and there is a complicated question of Patent Law to be tried. The Plaintiffs are entitled to have the benefit of discovery, and to go to trial in the usual way. [Lord DAVEY.—You have not given one single instance of what you allege to be an infringement.] Sending samples into this country is a most serious form of infringement. Even in the case of samples sent by post, the post if selected by the sender is the agent

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of the sender. In *Badische Anilin und Soda Fabrik v. Johnson* (14 R.P.C. 919), the addressee specifically requested that the samples should be sent by post, and consequently made the post his agent. [Lord DAVEY.—The Postmaster is at any rate bailee for the addressee, for when once a letter is put in the post the sender loses control over it.] So far as agency is 5 concerned, the post is in the same position as any other carrier. The affidavits of the Defendants are insufficient. The proper answer could only have come from the Defendants' four agents in this country, not one of whom has sworn an affidavit. There were 192 samples sent to dealers; and there is no difference between a dealer and a consumer. The Plaintiffs' affidavits show 10 that the case is a proper one for service out of the jurisdiction. There is a direct conflict of fact between the parties. It is a proper case to go forward, and the questions raised can only be tried in this country.

Asquith, K.C., replied.

Lord MACNAGHTEN.—My Lords, as your Lordships, after a full discussion, 15 have come to the conclusion that the Appellants have not made out a case for disturbing the order under Appeal, it seems to me that the less said about the matter the better. The learned Counsel for the Appellants admitted that the evidence on their side did not completely displace all the grounds upon which permission to serve the writ abroad was sought. Now if the case be reduced 20 to a consideration of the effect of the way in which the Appellants' samples and pattern cards have been used in this country, there would still remain a nice and difficult question of law, and one which it is conceded has never yet been brought forward for decision. Whether the Appellants can do without the use of these samples and pattern cards—which hitherto they have used 25 largely—whether the question is of as little importance to their trade as they represent it to be, or whether it is really of vital importance, as alleged on the other side, those are matters which it is impossible to determine on the materials now before the House. It is at least conceivable that it may be of great importance. I think that the Respondents are entitled to have this question 30 tried, and tried in the usual manner. And on that ground, even if it stood alone, I think they would be entitled to maintain the Order of which they are in possession. Of course, the Court is bound to be careful in allowing a step to be taken which will expose foreigners to the inconvenience and annoyance of litigation in this country. But after all, the foreigners are not much to be 35 pitied in the present case. They have invaded this country, and it is on account of what they are alleged to have done in England that they are impleaded.

My Lords, having said so much I should say no more, but that I think the evidence adduced calls for some observation. Speaking for myself, I must say 40 that I do not think the affidavits on either side altogether satisfactory. One cannot help being struck by the silence of the four agents who manage the Appellants' business in England, and on whose conduct the case will probably turn. Their silence is all the more remarkable, since it appears that one of the Appellants' travellers and their general manager abroad came over to London 45 to make their affidavits. It is to be presumed that they must have had some consultation with the agents in this country; and it certainly would be more satisfactory to know what the agents themselves say about their mode of conducting the business, than to have their action described second-hand by foreign witnesses. The evidence on the part of the Respondents is, I think, 50 open to still greater objection. Assuming that Mr. *Johnson's* affidavit was sufficient in the first instance (as I think it was), and assuming that he was a proper person to make the affidavit required by Rule 4 (as I think he was) a more definite answer ought (as it seems to me) to have been given to the Appellants' counter affidavits. The Respondents' case, according to Mr. 55 *Ehrhardt's* statement, was that their Letters Patent had been infringed by the

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Appellants in no fewer than six instances, and on a large scale, and that they had at last obtained definite proof of infringement, and yet they do not give the Court a single instance in proof of their assertion. I think that under the circumstances sufficient information ought to have been given to make it clear
 5 that the Court was asked to proceed on sure ground. This unwillingness on the part of the Respondents to show their hand, has led to a great deal of unnecessary expense and delay.

On the whole, however, I do not think it would be right to interfere with the Order of the Court of Appeal. It is a matter of discretion, and the Court
 10 appears to have exercised its discretion with great care and consideration. The learned Judges of the Court of Appeal made their Order with some hesitation and reluctance, and with some reluctance, I move your Lordships that the Order appealed from be affirmed, and the Appeal dismissed with costs.

Lord DAVEY.—My Lords, the jurisdiction which has been exercised by the
 15 High Court in the present case is always one of some delicacy and difficulty, and the conditions prescribed by the Orders of the Court do not diminish the difficulty.

Rule 1 of Order XI. enumerates the cases in which the Court may give leave to serve a writ out of the jurisdiction. The present case is alleged to come
 20 under the head lettered (f). An injunction is sought to restrain the Defendants from doing some act within the jurisdiction. Rule 4 of the same Order prescribes that the application is to be supported by evidence stating that, in the belief of the deponent, the Plaintiff has a good cause of action, and no such leave is to be granted unless it be made sufficiently to appear to the Court
 25 or Judge that the case is a proper one for service out of the jurisdiction under this Order.

This does not, of course, mean that a mere statement by any deponent who is put forward to make the affidavit that he believes that there is a good cause of action is sufficient. On the other hand, the Court is not, on an application
 30 for leave to serve out of the jurisdiction, or on a motion made to discharge an Order for such service, called upon to try the action or express a premature opinion on its merits, and where there are conflicting statements as to material facts, any such opinion must necessarily be based on insufficient materials. But I think the application should be supported by an affidavit stating facts
 35 which, if proved, would be a sufficient foundation for the alleged cause of action, and, as a rule, the affidavit should be by some person acquainted with the facts, or, at any rate, should specify the sources or persons from whom the deponent derives his information. A more difficult question is where it is in dispute whether the alleged or admitted facts will, as a matter of law, entitle
 40 the Plaintiff to the relief which he seeks. If the Court is judicially satisfied that the alleged facts, if proved, will not support the action, I think the Court ought to say so, and dismiss the application or discharge the Order. But where there is a substantial legal question arising on the facts disclosed by the affidavits which the Plaintiff *bonâ fide* desires to try, I think that the Court
 45 should, as a rule, allow the service of the writ. The words at the end of the Order do not, I think, mean more than that the Court is to be satisfied that the case comes within the class of cases in which service abroad may be made under the first rule of the Order.

In the present case, if I had been in Mr. Justice *Joyce's* place, I am not sure
 50 that I should have granted the leave for service abroad on Mr. *Johnson's* affidavit alone, but on Dr. *Ehrhardt's* affidavit and the affidavit filed by the present appellants I think there was enough to justify the learned Judge in refusing to discharge the Order. I designedly say nothing as to either, the facts or the law, lest I should be misunderstood, or supposed to express a
 55 premature opinion on the merits.

I am, therefore, of opinion that the Appeal should be dismissed.

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LORD JAMES OF HEREFORD.—My Lords : It is impossible to lay down any general rule as to the measure of proof required by Rule 4 of Order XI. to justify the summoning of a person resident abroad to come within the jurisdiction and here answer to process. In my view that power ought not to be lightly exercised. To bring those who may be foreigners from far away— 5 without knowledge of our language or procedure, and possibly without means of proof at hand,—imposes a burthen and difficulty which ought not to be lightly inflicted. But this power does exist, and the conditions under which it is to be exercised are to be found in Order XI., Rules 1 and 4, as mentioned at the Bar. 10

I quite agree that the Court to which the application is made for service abroad has not to try the question whether a suit can, in the result, be successfully maintained. Such a determination might involve a consideration of complicated facts, of credibility of witnesses, or of the application of legal principles. 15

But, on the other hand, the Court ought, I think, to be convinced by the proof brought before it that the Applicant is in a position to present to the tribunals of the country a substantial case for their determination. I think, also, that before granting the application the Court should afford the proposed Defendant an opportunity of denying categorically the statements relied upon 20 by the Applicant.

Looking at the affidavits used in this case, they appear to me on both sides to be deficient in statement and unsatisfactory in result. For instance, the averment made on behalf of the Respondents, by Dr. *Ehrhardt*, that six cases of infringements have been ascertained is, in my opinion, very unsatisfactory 25 on account of the generality of its nature, as it certainly affords the Appellants no opportunity of categorically denying or explaining the different suggested causes of action. On the other hand, the Appellants certainly could have afforded a fuller reply than is to be found in their affidavits. For instance, the absence of any statements by the Defendants' agents' carrying on their business 30 in this country, and whose conduct is challenged, is remarkable.

Without expressing any opinion as to what my judgment would have been if I had had to determine this case in the Court of First Instance, I have, after great doubt, come to the conclusion that the Appellants have not sufficiently 35 established that the discretion of that Court, and of the Court of Appeal, has in either instance been so erroneously exercised as to justify your Lordships in reversing their judgments. I, therefore, concur in the view that this Appeal should be dismissed.

LORD ROBERTSON.—My Lords : The question before your Lordships is whether the decision of the Court of Appeal should stand. That decision was pronounced 40 on different materials from those which were before Mr. Justice *Joyce*, and I think that the decision can be supported. My view is that the net result of the affidavits on both sides is to disclose, *prima facie*, a question or questions to be tried about the samples and the specimen cards. This conclusion is derived from the special circumstances of the case. From the tone of the Lords 45 Justices' judgments, I infer that there is no danger of the Courts encouraging vagueness and laxity in the statements upon which they will proceed to exercise this exceptional jurisdiction against foreigners. The reserve which is appropriate enough in the early stages of a suit brought by right must be abandoned when the Plaintiff is asking the Court for leave to serve a foreigner. And I agree in 50 the view indicated in the Court of Appeal that mere generalities given from second-hand knowledge ought not to be considered adequate to satisfy the Court.

The Appeal was dismissed with costs.

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IN THE HOUSE OF LORDS.

Present: LORDS MACNAGHTEN, DAVEY, JAMES OF HEREFORD, and
ROBERTSON.

April 29th, May 3rd and 5th, and June 21st.

5 PATENT EXPLOITATION, LD. v. SIEMENS BROTHERS & CO., LD.

Patent.—Action for infringement.—Construction of Specification.—Want of novelty.—Subject-matter.—Action dismissed.—Appeal allowed.—Appeal to the House of Lords dismissed.—Patent held to be valid.

The owners of a Patent for an improvement in galvanic batteries having
10 commenced an action for infringement, the Defendants denied infringement
and alleged that the Patent was invalid by reason of being anticipated, of
want of subject-matter, and of inutility. The Specification, after stating that
the invention related to galvanic batteries constructed and arranged as was
thereinafter described, contained the following passage:—"The materials
15 "mentioned as electrodes and as exciting and depolarising agents and their
"proportions may be varied, as the important feature of the invention is
"the interposition between the positive and negative electrodes of two layers
"of exciting composition, in a semi-solid or plastic state, the one in contact with
"the negative electrode having intermixed with it depolarising agents and the
20 "one in contact with the positive electrode having no such depolarising agents
"in its composition"; and the Patentee claimed: "A galvanic battery having
"the space between its positive and negative electrodes filled with a semi-solid or
"plastic exciting agent in two layers, the one layer in contact with the negative
"electrode having depolarising agents intermixed therewith, and the other layer
25 "in contact with the positive electrode having no such depolarising agents,
"substantially as set forth." The Plaintiffs contended that the width of the
claim was limited by certain limitations which they alleged were contained in
the Specification, and particularly that the depolarising layer was to be
composed of materials finely pulverised. It was proved that the Plaintiffs'
30 battery made under the Patent had been a commercial success. At the trial,
it was held by Buckley, J., that, although the claim should be construed as
embodying some limitations indicated in the body of the Specification, the

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Patentee had not insisted on as necessary or claimed as part of his invention the pulverisation of the ingredients for the depolarising layer; that the claim was too wide; and that the Patent was invalid for want of novelty. The action was dismissed with costs. The Plaintiffs appealed. Held, by the Court of Appeal, that the claim was not for the particular battery described, but 5 for a class of battery, defined by the limitations contained in the Specification; (by Vaughan Williams and Stirling, L.J.J.) that pulverisation was an essential; (by Cozens-Hardy, L.J.) that, although pulverisation was not essential, the combination of materials must produce a semi-solid or plastic mass; that there was novelty and good subject-matter; and that the Patent was valid and had 10 been infringed. The Appeal was allowed with costs, but by consent the injunction granted was stayed pending an appeal to the House of Lords. The Defendants appealed to the House of Lords.

Held, that pulverisation was not a necessary element in the combination claimed; that the words "semi-solid" and "plastic" in the Specification were 15 synonymous; that the Patentee had described and claimed as his invention a galvanic battery in language which was not anticipated by and which did not in terms cover any previous description or any battery previously known or described; that the invention was useful and good subject-matter for Letters Patent; and that the Defendants had infringed. The appeal was dismissed 20 with costs.

On the 21st of January 1890 Letters Patent (No. 1110 of 1890) were granted to Charles Addison Hitchcock, on a communication from abroad by William Burnley, for an invention of "An improvement in galvanic batteries."

The Complete Specification was as follows:—"This invention relates to 25 "galvanic batteries constructed and arranged as I will describe with reference "to the accompanying drawings. Fig. 1 is a vertical central section of the "improved battery. Fig. 2 is a transverse section on the line $x\ x$ of Fig. 1.

"A is a cylinder of zinc or equivalent metal forming the one electrode and "provided with a clamping screw B for connecting a conductor to it; a piece 30 "of carbon C is the other electrode. The cylinder A is lined with an exciting "agent E consisting preferably of the following ingredients *viz.* sal ammoniac "1 part, chloride of zinc 1 part, plaster of Paris 3 parts and water 2 parts, to "which is added a little less than 1 part of a comminuted vegetable material, "preferably flour. For preparing the exciting agent E, the materials are 35 "mixed, forming a semi-fluid which is poured into the cylinder A around a "central core temporarily inserted. The exciting agent soon sets to the "condition of a semi solid and the temporary core is removed. The carbon C "is then inserted centrally in the space left by the withdrawal of the core and "the space around the carbon is filled with a compound F consisting preferably 40 "of the following ingredients: Sal ammoniac 1 part chloride of zinc or other "hygroscopic analogue $\frac{1}{10}$ th part and as depolarising agents pulverised peroxide "of manganese 3 parts with pulverised carbon $3\frac{1}{2}$ parts.

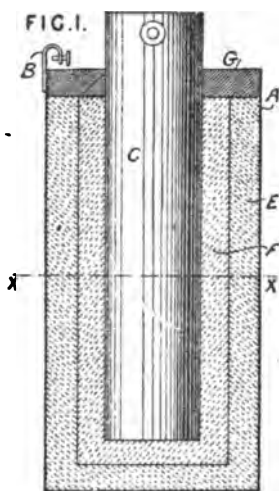
"These are mixed with water two parts to form a semi solid which is packed "in around the carbon c. The top of the cylinder A is then sealed around the 45 "carbon c with bitumen or other suitable material G substantially impervious "to air or moisture. The materials mentioned as electrodes and as exciting "and depolarising agents and their proportions may be varied, as the important "feature of the invention is the interposition between the positive and negative

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"electrodes of two layers of exciting composition, in a semi solid or plastic state, the one in contact with the negative electrode having intermixed with it depolarising agents and the one in contact with the positive electrode having no such depolarising agents in its composition.

- 5 "Having now particularly described and ascertained the nature of this invention and in what manner the same is to be performed, I declare that what I claim is:—

- "A galvanic battery having the space between its positive and negative electrodes filled with a semi solid or plastic exciting agent in two layers, the
10 "one layer in contact with the negative electrode having depolarising agents intermixed therewith, and the other layer in contact with the positive electrode having no such depolarising agents, substantially as set forth."



- On the 7th of November 1900 the *Patent Exploitation Company, Ltd.*, commenced an action against *Siemens Brothers & Co., Ltd.*, for infringement of
15 the Patent, claiming the usual relief.

By their Statement of Claim they alleged that they were the legal owners of the Patent, and that the Defendants had infringed the same.

- The Particulars of Breaches alleged that the Defendants had infringed the Patent by the manufacture at the Defendants' works at Woolwich, in the county of Kent, shortly before the month of November 1900, and by the sale
20 in the said month of November to *Gundry*, of New Malden, in the county of Surrey, and divers other persons, of batteries and cells made in the manner described and claimed in the Complete Specification of the Plaintiffs' Letters Patent, but the Plaintiffs reserved the right to recover in respect of all
25 infringements.

The Defendants by their Defence did not admit that the Plaintiffs were the registered legal owners of the Patent, and they denied infringement, and alleged that the Patent was invalid.

- The Particulars of Objections alleged:—(1) that the alleged invention was
30 not new by reason of (A) prior publication of the invention; (B) prior use of the invention; (C) prior common general public knowledge of the invention as claimed in the claiming clause thereof. Particulars of A and B were as follows:—(A) The alleged invention had been published in this realm prior to the date of the Patent (i) by the deposit in the Patent

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Office. Library of the Specifications of the following Letters Patent,* the whole of each of which was relied upon, viz.:—(A) British: (2) *Newton* (No. 4739 of 1880); (4) *Webb and Jensen* (No. 1998 of 1883); (8) *Castle Smith* (No. 2297 of 1889). (B) French: *Thiébaud* (No. 142,524, dated the 26th of April 1881, and the additions made thereto, dated the 16th of August 1881 and the 3rd of April 1882). (C) German: *Bender* (No. 48,695, dated the 9th of December 1888); (ii) by the publication in England and deposit in the Patent Office Library of *Sylvanus Thompson's* book "Elementary Lessons in Electricity and Magnetism," published in 1882. The parts relied on were paragraphs 172, 173, and 176 of the said book; (iii) by the deposit in the Patent Office Library, England, of *Delahaye's* "L'Année Electrique Deuxième Année," published in France in January 1866; the part relied on was the description of *Thiébaud's* dry cell on page 65 of the said volume. (B) The alleged invention had been in use in this realm prior to the date of the said Letters Patent (i) by the Defendants, who purchased in the year 1889 and used during the same year at their works situated at Woolwich *Gassner* dry cells, which cells were constructed substantially as described in the Plaintiffs' Patent and claimed in the claiming clause thereof; (ii) by the importation by Messrs. *Kemp and Lauritzen*, of Copenhagen, in or about the month of February 1888, and the use by Messrs. *Johnson and Phillips*, of London, by the *Indiarubber Gutterpercha and Telegraph Works Company*, of 106, Cannon Street, London, E.C., and by Messrs. *Woodhouse and Rawson*, of 11, Queen Victoria Street, London, E.C., within this realm of dry cells known as "*Hellesen* dry cells," which cells were constructed substantially as described in the Plaintiffs' Patent and claimed in the claiming clause thereof; (iii) by the common general use of sawdust, plaster, and other suitable materials for fixing the liquids used in galvanic batteries, and by the common general use of a depolarising agent in mixture with the exciting agent in contact with the negative electrode; (2) that the said alleged invention was not the proper subject-matter of Letters Patent. The Defendants would rely thereunder upon common knowledge concerning the construction of liquid and dry primary batteries and upon the matters set out in paragraph 1 thereof; (3) that the alleged invention was not useful; (4) that the Complete Specification of the Patent did not sufficiently describe the nature of the invention and the manner in which the same was to be performed. Particulars: By following the directions given on page 1, lines 24 and 25,† a practical battery could not be constructed.

The alleged infringement will be found described in the judgment of *Buckley, J.*, at the trial, and is referred to in the judgments in the Court of Appeal.

It was proved that the Plaintiffs' battery, made under the Patent, had been a commercial success.

The action was tried on the 21st, 22nd, 23rd, 24th, and 31st of January 1902 by *Buckley, J.*, who held that, although the claim should be construed as embodying some limitations indicated in the body of the Specification, the Patentee had not insisted on as necessary, or claimed as part of his invention, the pulverisation of the ingredients for the depolarising layer; that the claim was too wide; and that the Patent was invalid for want of novelty. The action was dismissed with costs.‡

The Plaintiffs appealed from this decision. The appeal was heard in December 1902. Judgment was reserved and delivered on the 20th of

* Only those Specifications relied upon on Appeal are here referred to, the full list of the alleged anticipations will be found in the report of the trial, 19 R.P.O. 115.

† *Ante*, page 542, lines 45 to 47.

‡ 19 R.P.O. 113.

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December 1902. The Court of Appeal held that the claim was not for the particular battery described, but for a class of battery defined by the limitations contained in the Specification. Lords Justices *Vaughan Williams* and *Stirling* held that pulverisation was an essential element in the combination claimed.

- 5 Lord Justice *Cozens-Hardy* held that although pulverisation was not an essential element, the combination of materials must produce a semi-solid or plastic mass. Held by the whole Court that the invention was new and good subject-matter for Letters Patent, and that the Patent was valid and had been infringed. The appeal was allowed with costs, but by consent the injunction granted was
- 10 stayed pending an appeal to the House of Lords.*

The Defendants appealed to the House of Lords. On the hearing of the appeal, *Moulton*, K.C., *Walter*, and *Hume* (instructed by *Budd, Johnsons, and Jecks*) appeared for the Appellants; *Astbury*, K.C., and *Shaw* (instructed by *James Mellor and Coleman*) appeared for the Respondents.

- 15 *Moulton*, K.C., and *Walter* for the Appellants.—The invention claimed is a dry or unspillable electric battery made as described in the Plaintiffs' Specification. The description in the Specification is indefinite; various materials are suggested, and then it is said that these materials and their proportions may be varied. It is impossible to say that any one of the
- 20 materials mentioned in the Specification is an essential element of the combination claimed. Whenever a material is mentioned the word "preferably" is prefixed to it. Pulverised peroxide of manganese was claimed by the Plaintiffs as an essential element, but these words do not occur in the claim of the Specification, and it is evident that the Patentee did not intend to confine
- 25 himself to pulverised peroxide of manganese. The claim is couched in the widest possible language, and claims any battery composed of two semi-solid or plastic layers of which the layer next to the negative electrode has a depolarising agent intermixed with it. This was old and well known at the date of the Patent, and had been described particularly
- 30 in the Specifications of *Thiébaud* and *Castle Smith*. The Plaintiffs' Patent is dated in the year 1888, and has already expired. It was difficult to obtain precise information as to how batteries were made so far back as 1888. We pleaded the *Hellesen* cell as an instance of prior user, but we could not prove how *Hellesen's* batteries were made. We showed that a
- 35 battery could be made according to *Bender's* Specification, and would work perfectly. *Castle Smith* unquestionably comes within the claim. The only new thing the Plaintiffs could suggest was pulverisation. [Lord DAVEY :—Pulverisation only comes in as an element of plasticity.] There was nothing new or useful in plasticity. It was known before that dry cells could be made
- 40 either solid or porous or plastic. The only object was unspillability. The Plaintiffs' batteries were commercially successful, because the great demand for these cells began at the date of this Patent. The Specification may be a good working receipt, but all the electrical elements are old. The use of depolarising paste was common knowledge. No evidence was given at the trial as to how
- 45 the Plaintiffs' batteries were made, but we found out in a subsequent action that they were made, not out of a semi-solid material, but out of a powdered material well rammed home. [Lord MACNAGHTEN :—We cannot listen to the evidence given in a subsequent action.] If a broad construction is given to the Specification the Defendants infringe, but the Patent is invalid. If a narrow
- 50 construction be given the Defendants do not infringe, and the Specification is insufficient, and the Patent is invalid on that ground. (*Kynoch & Co., Ltd. v. Webb*, 17 R.P.C. 100.)

Astbury, K.C., and *Shaw* for the Respondents.—The anticipations alleged are all paper anticipations. There were the *Gassner* and *Hellesen* cells on the market,

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but there was no evidence as to how they were made. The Plaintiffs' battery was a great commercial success from the moment it was put on the market. The proper construction to put on the Plaintiffs' Specification is neither a very narrow one nor a very broad one. The claim does not cover all two layer cells, but only cells containing two layers composed of the materials mentioned in the Specification or of their equivalents. The Plaintiffs' cell is a closed cell of the zinc-carbon type. The Specification says "the cylinder A is lined," so that the outer material must be something that will "line." When the Patentee uses the word "preferably" he allows a certain amount of latitude but the materials chosen must contain an excitant. They should also contain an hygroscopic such as chloride of zinc. The materials must be something that will "set." The Specification says that there must be an excitant in both layers, because these layers are so solid that there is practically no diffusion. The word "packed" is important as showing that the materials must be sufficiently semi-solid to be packed. Semi-solid or plastic are intended to mean the same thing. [Lord DAVEY :—They are both sufficiently vague.] Lord Justice *Stirling's* definition of "plastic" is correct. The prior Specifications are not anticipations. *Newton* is the nearest, but he has not a non-diffusible depolariser. There was no prior information how to convert a solid into a plastic substance, though it was known that a liquid could be made non-spillable by inserting a spongy substance. *Buckley, J.*, gave judgment for the Defendants, because the Plaintiffs did not claim pulverisation. Pulverisation is immaterial. At the date of the Plaintiffs' Specification there was no instance on the market of a battery having two semi-solid or plastic layers, one of which contained a depolarising agent. The utility of the invention is not denied, and is proved by the great and immediate success of the Plaintiffs' batteries. The improvements are physical improvements, and the claim is to a battery composed of old materials but leading to a new and useful result.

Moulton, K.C., replied.—The Plaintiffs' battery is not a closed battery. All these cells are made with a vent hole for the purpose of letting out the gases : otherwise the cells would burst. There is nothing new or useful in plasticity. All dry cells contain plastic materials, it is only a question of degree. The Specification claims in the widest possible language a two-paste or two-layer cell which was old at the date of the Patent.

Lord DAVEY.—My Lords, for the purpose of this appeal it must, I think, be taken that the Appellants' battery, both in construction and materials, is substantially identical with that of the Respondents. The evidence on this subject is meagre but sufficient, and I need not refer to it at length. Whatever, therefore, be the construction of the Specification it does not affect the question of infringement, and is only material in considering the question of the validity of the Respondents' Patent.

The objection made by the Appellants to the validity of the Patent is that the Specification does not point out with sufficient clearness what the real novelty and merit of the alleged invention consists in, and that the claim is expressed in such wide and vague words as to embrace forms of galvanic batteries which were well known and in use at the date of the Letters Patent. The Patentee, they say, may have invented an improvement in the construction of galvanic batteries, but if so he has not adequately described the nature of it, as required by law, and has claimed a great deal that he never invented.

Now, my Lords, the elements of a galvanic battery were well known. You must have your two electrodes normally of zinc and carbon. You must have your excitant, which must be a liquid or contain liquid. And you must have your depolarising agent to prevent the formation of a film on the carbon which will interfere with and ultimately destroy the efficiency of the battery. The problem was how to combine these elements into a battery, the liquid in which

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will not spill and which is at once portable, capable of being stored in a shop or warehouse for sale, and of retaining its efficiency for a sufficiently long period, whether at work or not. The Respondents' Patent is for a combination in a new manner of the well-known elements already mentioned. In such a

5 Patent there is no room for the common objection that the Patentee has not sufficiently distinguished the old from the new, for, as Lord Cairns pointed out in *Harrison v. Anderston Foundry Company* (1 App. Cas. 574, at page 578), the combination itself constitutes the novelty and merit of the invention. It is sufficient for the validity of the Patent if the combination, being the result

10 of thought or experience, is new, and produces some new result or an old result in a more useful and beneficial way.

The Patent is for "An improvement in galvanic batteries." The Specification is commendably short, clear, and intelligible. The Patentee describes a cylinder of zinc or other equivalent metal forming the one electrode which is

15 lined with an exciting agent consisting preferably of certain ingredients of a well-known description. "For preparing the exciting agent" he says, "the materials are mixed forming a semi-fluid, which is poured into the cylinder around a central core temporarily inserted. The exciting agent soon sets to the condition of a semi-solid and the temporary core is removed." The

20 carbon is then inserted and the space round it is filled with a compound consisting preferably of the following ingredients:—Salammoniac, 1 part; chloride of zinc or other hygroscopic analogue one-tenth part; and, as depolarising agents pulverised peroxide of manganese 8 parts, with pulverised carbon $3\frac{1}{2}$ parts. These are mixed with water 2 parts,

25 to form a semi-solid, which is packed in round the carbon. The top of the cylinder is then sealed. The Specification concludes with the following:—"The materials mentioned as electrodes, and as exciting and depolarising agents and their proportions, may be varied, as the important feature of the invention is the interposition between the positive and negative

30 electrodes of two layers of exciting composition in a semi-solid or plastic state, the one in contact with the negative electrode having intermixed with it depolarising agents, and the one in contact with the positive electrode having no such depolarising agents in its composition." The claim is for

35 a galvanic battery having the space between its positive and negative electrodes filled with a semi-solid or plastic exciting agent in two layers, the one layer in contact with the negative electrode having depolarising agents intermixed therewith, and the other layer in contact with the positive electrode having no such depolarising agent substantially as set forth."

40 It was contended by the Respondents that the use of peroxide of manganese or other depolarising agent in the form of powder was one of the elements of the combination, and a large part of the evidence and argument was taken up in the discussion of the difference between a pounded and a pulverised material. I do not find it necessary to embark on that interesting inquiry or to say

45 whether it is more than a question of degree. I agree with Mr. Justice Buckley and Lord Justice Cozens-Hardy, differing from Lord Justice Vaughan Williams, and (I think) Lord Justice Stirling, that the Patentee has not made the use of the material in a pulverised form a necessary element in the combination which he has claimed, or, in other words, if that be his real invention he

50 has not claimed it. I think, though it is not necessary to decide it in the present case, that the words "substantially as set forth" would cover the use of materials analogous to or having similar chemical or electrical properties to those which he has described as preferable, and the recommendation of pulverised materials may be useful as illustrating the sort of thing he intended

55 by the word "plastic." I do not construe the words "semi-solid or plastic" as alternatives, for they are not true alternatives, but I think that the word "plastic" is meant to be synonymous with and explanatory of "semi-solid."

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and is used with the intention of giving some definiteness to a somewhat vague expression.

The patented battery has achieved a great commercial success. Mr. Gore, an electrical engineer in the service of the *National Telephone Company*, stated that up to the time when the Respondents' battery was introduced to his Company they had only experimentally used any dry batteries. He mentioned the *Gassner* and the *Hellesen*, which are two of the batteries relied on by the Appellants as anticipations. He said it was found that these batteries had not a long life compared with the patented battery. "If they were used immediately they were a very good cell, but if kept in stock for any time they deteriorated; that is to say, if you put them on intermittent work, that is, being used for a short time and then having a long rest, they very speedily gave out." Mr. Gore's Company has bought considerably over 120,000 of the Respondents' batteries, and has also in recent years used the Appellants' battery, which they find equally efficient. It is remarkable that neither of the very eminent electricians who gave evidence in this case could say with certainty to what particular cause the success of the patented battery was attributable. Mr. *Swinburne* was disposed to attribute it to the use of the depolarising agent in a pulverised form, which to him was a novel idea. It is not necessary in the present case for your Lordships to form any opinion on this question, though if the issue were whether an alleged infringer had taken the substance of the patented invention it would be different. This case comes within the first category of infringements described in Lord *Cairns'* well-known judgment in *Clark v. Adie* (2 App. Cas. 215, at page 220). I am of opinion that it is established by Mr. Gore's evidence, as well as by other evidence with which I will not trouble your Lordships, that the Respondents' combination did produce a known result in a more useful and beneficial way. The establishment of this point has a material bearing on the question of subject-matter.

No instance has been produced of any previous battery coming within the exact description of the Patentee's claim. But counsel for the Appellants have endeavoured to minimise and reduce to insignificance the differences between the battery claimed and those described in the previous Specifications which they relied on, either as anticipations, or as included in the Patentee's claim. There is no doubt on the evidence that the exciting agent (solution of sal-ammoniac in the present case) would diffuse itself over the whole mass within the jar, but I hesitate to say that the direction for the two layers, both containing an exciting agent, has no significance. I think the absence of a linen bag or other diaphragm to hold up the depolarising agent is proved to be unimportant, except as assisting the Court to understand what the Patentee means by "semi-solid or plastic." The maintenance of the two layers in that condition is, in my opinion, the important element in the combination by which the validity of the Patent must be tested.

The previous Specifications which are relied on by the Appellants are very fully considered in the judgment of Lord Justice *Stirling*, and as I agree with his criticism I will not repeat it. The two which come nearest to the description in the Specification now before your Lordships are those of a French patentee named *Thiébaud*, dated the 26th of April 1881, with an addition dated the 16th of August 1881, and the English Patent of *Castle Smith* of 1889. In the amended form of *Thiébaud's* Specification the contents of the battery are in two layers, but the outer layer is solid, and, as the Patentee says, a hammer has to be used to destroy it. *Castle Smith's* Patent is a communication from abroad of a Dane named *Hellesen*. Superficially and substantially it is very close to the Respondents'. In one respect it is more complete in that it contains an elaborate provision for the escape of the gas which is inevitably formed. The omission of such a provision, however, was not made a point of against the Respondents' Patent, probably because every workman would know that he must make a vent

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hole. *Castle Smith's* battery also contained two layers round the central carbon electrode. The inner layer is described as a paste made of some depolarising substance enclosed in a porous bag which may, perhaps, be described as plastic. The outer layer, he says, is transferred into a thick sticky, phlegmy substance
 5 by adding gums and similar substances, such as tragacanth. Mr. *Swinburne* describes this substance as a jelly. The dictionary meaning of "plastic" is "easily made to take form," and it is said that in the arts it chiefly applies to the clays fitted for pottery. Lord Justice *Stirling* defines a plastic solid (I think he meant semi solid) as one capable of being made to change its shape at
 10 the will of the operator, and also of retaining the shape into which it is thrown. *Castle Smith's* phlegmy or jelly substance may possibly be described as a semi-solid one, but by no fair use of language can it, in my opinion, be called plastic. It is not a question of degree, but a difference in kind.

Thiébaud's Patent is at best a mere paper anticipation. I do not doubt
 15 Mr. *Ballantyne's* ability to make a workable battery out of it, but there was no proof of a battery made in accordance with *Thiébaud's* directions having been sold or used. The *Hellesen* battery, on the contrary, was on the market, and, as I have mentioned, was compared unfavourably with the Respondents' battery by Mr. *Gore*. It was not, however, proved that the *Hellesen* batteries in use
 20 were made in strict accordance with *Castle Smith's* Specification, and the Appellants, although they included the prior use of the *Hellesen* battery in their Particulars of Objections, did not pursue the subject.

My Lords, I disclaim putting either a benevolent or malevolent interpretation on the Specification, or being astute either to uphold or invalidate the Patent.
 25 I am of opinion that a Specification like any other document should be construed by the Court according to the fair meaning of the language used after being informed by evidence of the nature of the subject-matter, the state of knowledge at the date of the Patent, and the meaning of any scientific or technical words that are found in it. My opinion on this appeal may be summed up in a single
 30 sentence. I find that the Patentee has described and claimed as his invention a galvanic battery in language which is not anticipated by and does not in terms cover or include any previous description or any battery previously known or described, and his battery is proved to have produced useful and beneficial results; and, lastly, I must hold on the evidence in this case that the
 35 Appellants have taken his battery in its entirety. It may be that the invention is a small one, but slight differences in these cases sometimes produce large results. I adopt the words of Sir *George Jessel* in *Hinks v. Safety Lighting Company* (4 Ch. D. 601, at page 615) "where a slight alteration in a combination turns that which was practically useless before into that which is very
 40 "useful and very important, Judges have considered that though the invention "was small, yet the result was so great as fairly to be the subject of a patent, "and as far as a rough test goes, I know of no better." In that case the learned Judge upheld the substitution of a round wick for a flat wick in a lamp as a patentable invention, though he held the patent bad on other grounds. I also
 45 refer to the case of *Vickers v. Siddell** (15 Appeal Cases 496), where this House upheld a patent for an improved mechanical appliance for working large forgings, though as Lord *Herschell* said, no great exercise of the inventive faculty was required for its production.

On the evidence before your Lordships I am therefore of opinion that the
 50 Respondents' Patent is a valid one, and that the appeal should consequently be dismissed with costs, and I move your Lordships accordingly.

Lord JAMES OF HEREFORD.—My Lords, I concur in the view that this Appeal should be dismissed, for the reasons given by my noble and learned friend Lord DAVEY in his judgment.

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Lord ROBERTSON.—My Lords, I have found this a dubious case; but I am satisfied with Lord DAVEY's conclusions, and I concur in his judgment.

Lord MACNAGHTEN.—My Lords, in this case which is one, I think, of considerable difficulty and certainly very near the line, I do not propose to trouble your Lordships with any observations of my own. I desire merely to express my concurrence in the judgment that has been delivered by my noble and learned friend Lord DAVEY, both as regards the proper mode of construing Specifications in general and the construction of this Specification in particular. 5

The appeal was dismissed with costs.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

10

Before MR. JUSTICE WARRINGTON.

May 2nd and 3rd, 1904.

BURGOYNE & CO., LD. and P. B. BURGOYNE v. A. H. GODFREE & CO.

Trade Mark.—Passing-off.—Mark name of Plaintiff.—Sale of goods bearing name.—Estoppel.—Injunction.

15

The Plaintiffs, who are the registered proprietors of the Trade Mark "Burgoyne," for wine, sold by auction wine in casks bearing the inscription "Burgoyne, London." The wine had been consigned to the Plaintiffs on approval and rejected by them, and was sold on account of the growers. The Defendants purchased the wine at the auction, and re-sold it as "Burgoyne's Superior Australian Burgundy." In an action to restrain the Defendants from infringing the Plaintiffs' Trade Mark, and from passing-off the wine in question as being the Plaintiffs' wine, 20

Held, that the wine was not the Plaintiffs' wine, and that the Plaintiffs were not estopped by their conduct from restraining the sale of the wine as their wine. An injunction and an account of profits were granted. 25

Burgoyne & Co., Ltd. and P. B. Burgoyne v. A. H. Godfree & Co.

Peter Bond Burgoyne for many years prior to the incorporation of *P. B. Burgoyne & Co., Ltd.*, carried on in London under the firm of *P. B. Burgoyne & Co.*, the business of growing, importing, and selling Australian wines. In November 1887, he registered the word "Burgoyne" as an old Trade Mark, under No. 62,529, in Class 43 for wines. In March 1903, he assigned to *P. B. Burgoyne & Co., Ltd.*, a Company which was incorporated in January 1903, the goodwill of his said business and certain Trade Marks, including No. 62,529, of which the Company were registered as proprietors, and the Company continued to carry on the said business.

In the latter part of 1903 *P. B. Burgoyne & Co., Ltd.*, and *Peter Bond Burgoyne* commenced an action against *Arthur H. Godfree & Co.*

It appeared that on the 19th and 20th of March 1903, *W. and T. Restell*, wine auctioneers, held a sale by auction, which included certain casks of wine described in the catalogue as "Australian Red Wine, per 'Victoria' from Melbourne, entered by *P. B. Burgoyne & Co.*, 24th January 1903, Monument Vaults." A portion of these casks, which bore upon them the words "Burgoyne, London," were purchased by the Defendants, who bottled the wine therein contained, and advertised and sold it as "Burgoyne's Superior Australian Red Burgundy," at 12s. per dozen. The Plaintiffs, upon seeing in July 1903 a copy of the circular containing the advertisement, demanded that the Defendants should withdraw it from circulation, and render an account of the profits made by the sale of the wine; and they also claimed that the Defendants should pay 100 guineas to a hospital by way of compensation for the use and defamation of the Plaintiffs' name, and insert in the public Press an advertisement withdrawing the statements in the circular. Upon the refusal of the Defendants to comply with this demand, further than by undertaking to issue no more of the circulars of which complaint was made, this action was brought. In their Statement of Claim the Plaintiffs alleged that the wine in question was inferior or damaged, and was sent to the auctioneers to be sold on the shipper's account, and not as the Plaintiffs' wine, and that the name on the casks was "put thereon by the shippers solely as part of direction." They also alleged that the wine, which the Defendants so offered for sale under the name or Trade Mark of "Burgoyne," or as "Burgoyne's," never was the property of, and never was bottled or sold by the Plaintiffs, or either of them.

The Plaintiffs claimed an injunction to restrain the Defendants "from applying the mark or title 'Burgoyne' to any wine sold or offered for sale by them, unless such wine be, or shall have been, the property of the Plaintiffs or one of them, and from selling or disposing of, or offering, or advertising for sale any wine in vessels marked with the Mark or title 'Burgoyne,' unless such wine be, or shall have been, the property of the Plaintiffs, or one of them, and from issuing any bottles or casks, or other receptacles containing wine, upon or in which the Mark or title 'Burgoyne' shall be applied to wine not at any time the property of the Plaintiffs, or one of them, and from issuing, publishing, circulating, affixing, or using any advertisement circular or label containing the word 'Burgoyne,' relating to, or in connection with, any wine not at any time the property of the Plaintiffs or one of them, and from affixing, or applying, or using, or causing to be affixed, applied, or used to, or in connection with any such wine sold, or offered for sale, or supplied by the Defendants, the word 'Burgoyne's' or 'Burgoyne,' or any other word or colourable imitation thereof to represent such wine as having been at any time the property of the Plaintiffs, or one of them; and from selling, supplying, or offering for sale, or otherwise disposing of any wine to which any such Mark, words, or word has been, or shall be affixed, or applied, or used, and which is or has not been the property of the Plaintiffs, or one of them."

The Plaintiffs also claimed an account of profits, and delivery up of bottles, circulars, &c., or in the alternative damages. They also claimed costs.

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The Defendants, by their Defence, contended that the wine was not inferior or damaged, and that they believed it to be the property of, and sold by the Plaintiffs, on account of the presence of the name "Burgoyne, London," branded or stencilled on the casks. They also claimed that if the wine never was the property of, or sold by them, the Plaintiffs were estopped by their conduct in selling the wine under the particulars, and bearing the brands above-mentioned. 5

The action came on for trial before Mr. Justice WARRINGTON.

H. Terrell, K.C., and *T. L. Wilkinson* (instructed by *Hicks, Davis and Hunt*) appeared for the Plaintiffs; *Lawson Walton*, K.C., *Rowden*, K.C., and *R. R. Reeve* (instructed by *Lewin & Co.*) appeared for the Defendants. 10

H. Terrell, K.C., opened the case for the Plaintiffs, and stated the facts substantially as appearing above and in the judgment.

The evidence for the Plaintiffs proved the sale of the wine in the manner above stated, and showed the manner in which the Plaintiffs' trade was carried on. Some of the witnesses also stated that the wine sold by the Defendants was inferior to that sold by the Plaintiffs to their customers under their own name, and that the name "Burgoyne" was put on the casks only as an address to show to whom they were consigned. 15

T. L. Wilkinson summed up the case for the Plaintiffs, and contended that even if the Defendants were misled by the name "Burgoyne" on the casks, they had no right to sell the wine as "Superior Australian Burgundy." 20

A. H. Godfree, the head of the Defendants' firm, in his evidence for the Defendants, said that in his view it was lawful for anybody to use the word "Burgundy" as a generic term descriptive of wines of a certain quality, and the wine in question was excellent wine of that quality. He had never seen a name on a cask used as an address, but considered the name of "Burgoyne" on the casks in question as the shipper's brand, which entitled the purchaser of the wine to sell it under that name. Other witnesses stated that this view was generally held in the wine trade, and the manager of the auctioneers admitted that it was careless of them not to remove the name, since it was not intended to sell the wine as branded wine. 25 30

Lawson Walton, K.C., for the Defendants.—The Plaintiffs' case is that (1) This is not their wine, and (2) the Defendants knew that it was not. The Plaintiffs sold this wine as being their own; in fact it was, for under the contract which they set up, the property in the wine had passed to them until the right of rejection was exercised. If then it is offered by them as "Burgoyne's" wine, they are not entitled to complain if the purchasers sell it as such. Moreover, they omitted to take steps which they might have taken by removing the brand. Consequently there is a clear case of negligence, and the Plaintiffs are not entitled to succeed on that ground. 35 40

Rowden, K.C., on the same side.—The use of the name on the casks amounts to a representation that the wine was that of the Plaintiffs, as appears from the evidence of the Defendants' witnesses, and the entry in the sale catalogue does not contradict the inference to be drawn from the casks. It might have been stated in the catalogue that the wine was being sold on account of the grower, or the name might have been removed from the cask. As it was, all the external *indicia* were consistent with the wine being "Burgoyne's" wine, and the Plaintiffs are responsible for the existence of these *indicia*. 45

No reply was called for. 50

WARRINGTON, J.—In this action the Plaintiffs claim relief, first, in respect of infringement of a registered Trade Mark, and secondly, in respect, independently of Trade Mark, of the sale of certain goods, not their goods, as and for their goods.

The facts of the case are very simple up to a certain point. The Plaintiffs, *P. B. Burgoyne & Co., Ltd.*, are the successors in business of the Plaintiff, *Peter Bond Burgoyne*, and they carry on a very extensive business as growers, 55

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importers, and vendors of Australian wine. The business was established in the year 1871, and in 1887 the name "Burgoyne" was registered, as an old Trade Mark, that is to say, as a Trade Mark used before 1875, and that mark is now vested in the Plaintiff Company. The course of business, so far as it is material to allude to it for the purposes of the present case, appears to be this—

5 that Mr. *Burgoyne*, before the formation of the Company, and the Company, since that time, employed and employ agents in Australia, whose business it is to visit the cellars or vaults, as the case may be, of the Australian growers, or otherwise to receive samples of the wine of such growers and taste it, and that such wine as they approve is then ordered by them to be shipped to

10 England. About fourteen years ago the practice was adopted of placing on the casks of wine so shipped, the words "Burgoyne, London," and, as I understand from the evidence, the object of it was to identify the goods which had been so selected by the agents in Australia. The wine so provisionally selected is

15 consigned to *Burgoynes* here in London, and a part of the purchase-money paid; but the wine is subject to a further testing and tasting here in London, and it is only such of the wine as is, on that second testing and tasting, accepted by the *Burgoynes*, that ultimately becomes their property, is passed into their cellars, and is bottled by them and sold by them to the public.

20 Such wine as they do not approve is usually sold by them at public auction, and the growers are credited with the proceeds, after deducting that part of the purchase-money which, as I have already stated, has been paid by them in Australia. In the early part of 1903 a parcel of wine arrived from Australia in casks marked "Burgoyne, London," and with certain shipping marks upon

25 them. The wine in these casks was tasted by Mr. *Burgoyne*, and a large number of them were rejected as not being fit for their trade. Of the casks so rejected a portion were sold by Messrs. *Restell*, the wine brokers and auctioneers, at a sale which took place on Thursday and Friday, the 19th and 20th of March. We are only concerned directly in the present case with one

30 parcel of such casks, and that parcel is entered in the catalogue as "Australian Red Wine, per 'Victoria' from Melbourne, entered by *P. B. Burgoyne & Co.*, "24th January 1903, Monument Vaults," and then the amount of duty is stated, and then we have the lots 392 to 398, each lot containing a certain parcel of wine: and the shipping marks, M.P. with numbers, are mentioned against

35 the numbers of the lots. That is the whole of the description of the wine in question which is contained in that catalogue. The catalogue was, I need not say, not confined to the wines put into that sale by the *Burgoynes*, but it contained a large variety of wines; in some cases the particular brand is mentioned in the catalogue; in some cases it is not; and, again, in some cases

40 the person in whose name, or by whom the wine is entered at the Customs House is mentioned; in some cases it is not.

I may say in passing, that I think it is clear beyond dispute, on the evidence that has been given before me, that nobody acquainted with the trade would draw any inference from the name being in the catalogue, as that of the person

45 by whom the wine had been entered at the Customs House, as to the ownership of the goods. At the utmost, all that can be suggested is, that the mention of the name in the catalogue suggests some connection of the person whose name is there mentioned with the goods. But I think on the whole, especially taking the evidence given to-day by the Defendants, one must attribute the least possible importance to the mention of the name "*P. B. Burgoyne & Co.*," in the way in which it is so mentioned. At the sale, Messrs. *Arthur H. Godfree & Co.* bought the parcel of wine to which I have referred, described, as I desire to repeat, for a reason which will be seen directly, as

50 "Australian Red Wine." So far as there is any description of the wine, it is described as "Australian Red Wine." At the time when the wine was put up

55 for sale, Messrs. *Godfree* did not know, nor did anybody else, except those behind the scenes, who were the vendors of the wine. The wine, so far as anybody

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knew anything to the contrary, was being sold by the brokers and by nobody else. It does not appear on the face of the catalogue on whose account the wine is being sold. Messrs. *Godfree* bought that wine at 1s. a gallon. They had it home, and on its arrival, Mr. *Godfree* noticed that the casks had on them the name "Burgoyne, London," and I conclude that this was a pleasant surprise to him from the remark which he tells us himself he made to his cellarman, or some other person in his employ, "Oh, now we can sell this wine 5
"as Burgoyne's wine." He concluded, and I do not desire to attribute any evil motive to him, that the wine being so described on the casks, he was entitled to sell it on the market as "Burgoyne's Wine," without any further enquiry, or without any further investigation. I cannot help thinking that 10
Mr. *Godfree* attributed—no doubt it was greatly to his advantage to do so, and he was, I daresay, misled to some extent by that, but I cannot help thinking that he, as certain of the witnesses who have been called here to-day attributed—too much importance to the marking of the casks, as compared with 15
the other circumstances attending the sale. I will come back to that directly. He did conclude that he was entitled to sell this wine as "Burgoyne's Wine." He accordingly had it bottled, he issued circulars, some 9,000 or 10,000 as he told us, in which he advertised this wine, or a part of it, as "Burgoyne's" in large letters at the top, "160 dozen Burgoyne's Superior Australian Red 20
"Burgundy. Very full body, generous and ferruginous wine, of excellent "quality, 12s., the usual price per dozen, 18s." The source from which he got the 18s. appears to be Messrs. *Burgoyne's* price list, and it is, in fact, the price per dozen of certain wine which Messrs. *Burgoyne* sell as "Harvest
"Burgundy." 25

The fact that this wine was being put on the market as "Burgoyne's Wine" came to the knowledge of the Plaintiffs, and they thereupon complained. The result of that complaint was that ultimately, by a letter of the 25th of July 1903, the Defendants stated, "No further circulars will be issued as they" (that is the Defendants) "are not in the habit of practising such frauds upon the public." 30
The words which I have just read—"Such frauds upon the public"—are taken from a letter of the 23rd of July, written by the Plaintiffs' solicitor to the Defendants, in which he had referred to the conduct of which he was complaining, in those terms. Now it will be observed—and I make these remarks particularly in reference to a certain paragraph of the Defence—that all that Messrs. *Godfree*, through their Solicitors, there offer to do is, not to issue any further circulars. They make no offer to stop the sale of the wine, or not to continue to sell it as "Burgoyne's wine"; but it is fair to them to state that Mr. *Godfree* has informed me, and I accept his statement without hesitation, that they have not, in fact, since the time Messrs. *Burgoyne* 40
complained, sold any of the wine as "Burgoyne's wine." But he did say he considered himself entitled, under the circumstances, to sell it, but that he had abstained from doing it from feelings of courtesy towards Messrs. *Burgoyne*. I mention that because the Defence sets out, in effect, that a sufficient undertaking had been offered, and that there was no claim of a right; and that on 45
that ground the Plaintiffs were not entitled to an injunction. That Defence has not been insisted upon at the Bar, but I think it right to mention it. I think that Defence is disposed of by the circumstances I have mentioned. Those were the facts.

Now, on those facts, the first conclusion I come to on any disputed question of fact, is that I hold that the wine was never the property of Messrs. *Burgoyne*. 50
I do not know exactly what the contract was between Messrs. *Burgoyne* and the growers of the wine, but on the facts as I know them, I come to the conclusion that the wine was not Messrs. *Burgoyne's* wine; that it would not become theirs until it had been further tested in England, and that all that had 55
happened was that a provisional contract for sale and purchase was entered into between Messrs. *Burgoyne* and the Australian growers. Whether the wine was

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at any time the property of Messrs. *Burgoyne*—whether or not I am right in the conclusion I have come to on that point—this at all events is clear, that at the time it was sold it was not the property of Messrs. *Burgoyne*, but it had been rejected by them, and it was being sold by them on account of the growers, and under a liability to account to the growers for the purchase-money, subject, of course, to the deduction of what they had paid, and any expenses connected with the sale. So that it was certainly not Messrs. *Burgoyne's* wine when it was sold, and in my view it never had been. That being so, it is beyond dispute that the Defendants have sold wine, not Messrs. *Burgoyne's* wine, under their Trade Mark. It is also beyond dispute that they have sold as “*Burgoyne's* Wine” wine which was not “*Burgoyne's* Wine.” The result is that *prima facie* the Plaintiffs are entitled to succeed on both heads of their claim.

The difficult part of the case is caused by the Defence. The Defence really resolves itself into this, that what the Defendants have done has been induced by the conduct of the Plaintiffs, and that they are therefore not entitled to come to this Court and ask for relief in respect of an act which, in that view of the case, has been done by the Defendants under a *bona-fide* mistake, brought about by the Plaintiffs' conduct. The onus on that part of the case is, in my opinion, on the Defendants, and what I have to determine is, whether the Defendants have discharged themselves of that onus. Now, it really amounts to this :—Were the Defendants justified under all the circumstances of the case in assuming, without further inquiry or investigation, that the wine which had been sold at this sale, and had been bought by them, was sold under such circumstances that the right to use the Trade Mark, and the right to pass off the wine under the name of *Burgoyne*, passed with that sale—were they justified in coming to that conclusion? Now, I put aside the price which was paid for the wine; the 1s. a gallon. Some question arose yesterday as to whether I was justified in allowing Mr. *Terrell* to put to the witnesses a question involving the consideration of the price paid. I thought, and still think, I was justified in allowing that question to be put, but I do not attribute any importance to the answers. Now, putting that aside, what do we find? We find at the sale the wine described, as I have already mentioned, merely as “Australian Red Wine” by a certain ship entered by *P. B. Burgoyne & Co.* We find in the same catalogue brokers of experience advertising other wines for sale, some branded and some not branded, and some marked as branded and some marked without the brand. I think it is admitted that, taking the catalogue by itself, Mr. *Godfree* concluded that the wine he was buying was not a branded wine—that is to say, it would never occur to him, from the mention of Messrs. *Burgoyne's* name in the catalogue, that he would be entitled to sell the wine as “*Burgoyne's* Wine.” On the contrary, the conclusion that I come to is, that he thought he was buying certain Australian Red Wine, and he did not know who the seller was, but simply, as he said, he was buying it on its merits, not from any value which might attach to it as a branded wine. So far for the sale.

Now, does the fact that he found the name “*Burgoyne*” on the casks carry it any further? I will accept the statement of the witnesses for the Defendants, that those words are what they call a brand. What it implies is another matter; and I do not think that was very clearly present in the mind of any witness. But I will take it that it is a brand; that is to say, that it indicates that the wine is either shipped by, or imported by, or put on the market by, the person whose name it bears. It certainly, I think, cannot be supposed that anybody of experience in the trade would treat it as the address of the consignee. Anybody who knows anything about shipping would know that, except, as some of the witnesses said, in isolated cases, parcels of goods like these would not have the name of a consignee upon them; the name would be on the bill of lading, and the marks which are on the casks would be the corresponding number and letters. Now, assuming I cannot come to the conclusion that Mr. *Godfree* was

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justified in assuming that he was entitled to sell that wine as "*Burgoyne's Wine*," there is a certain conflict of evidence on the subject, though not, I think, so serious as on the mere words might appear. As I have already put to Mr. Wallon, I cannot help thinking that the witnesses for the Defendants addressed themselves more particularly, and almost exclusively, to the name on the cask, 5 without sufficiently bearing in mind what, in my view, is a very important consideration indeed, the circumstances under which the wine had been originally bought—circumstances which undoubtedly, by themselves, satisfied Mr. Godfree that the wine which he was buying was not a branded wine.

There is a further point which I do not think Mr. Godfree sufficiently appreciated, and that is the extreme improbability that a person entitled to a valuable brand, which he himself admits would, if mentioned in connection with the wine, tend to increase the price of it, would deliberately have that wine advertised in the catalogue without the brand. I am not attributing any importance to the unlikelihood of Messrs. *Burgoyne* selling certain wine by auction. I do 10 not think much of that, because, for anything anybody knew to the contrary, the Defendants included, this wine might have been put on the market by a purchaser from Messrs. *Burgoyne*, but on the whole, notwithstanding the very forcible way in which Mr. Rowden especially put the Defendants' case, I cannot come to the conclusion that the Defendants were induced by anything that was 15 done by the Plaintiffs to put this wine on the market in the mode in which they did put it on the market. I admit that it is stated by some of the witnesses that Mr. *Burgoyne*, or those who represent the Company, were guilty of some carelessness in not taking the name off the cask, but carelessness in their own interest, and not, I think, carelessness in the performing of any duty which they 20 owed, under the circumstances which have been proved here, to the purchaser of these goods. 25

I would also allude to one fact which has had some influence on my mind, and that is the description of the wine as "*Burgoyne's Superior Australian Red Burgundy*." There was nothing in the catalogue to indicate the quality under 30 which the vendors were selling that wine; it was merely called "*Australian Red Wine*." I do not mean to say that Mr. Godfree was entitled to call it "*Burgoyne's Australian Red Wine*," but certainly nothing was done by the Plaintiffs to induce him or even to lead him, under a mistake as *bonâ fide* as it can be described to be, to sell the wine under the title which I have just read. 35

On the whole, I come to the conclusion that the Defence has not been made out, and, therefore, that the *prima facie* case established by the Plaintiffs ought to succeed, and the injunction will go as asked by the Statement of Claim.

Rowden, K.C.—I: is rather elaborate, but I see nothing wrong in it if my friend wants to take it in that form. 40

Terrell, K.C.—I think it would be better in that form. It is an injunction to restrain infringement of the Trade Mark and passing-off.

WARRINGTON, J.—The Plaintiffs must have the costs of the action up to and including trial, and the costs of the account will be reserved.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE WARRINGTON.

May 18th and 19th, 1904.

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5 *Patent.—Action for infringement.—Construction of Specification.—Infringement not found.—Judgment for Defendant.—Certificate of validity coming in question given to the Plaintiff.*

M., the Patentee of a new and improved machine for breaking up the surfaces of roads, commenced an action for infringement, in which one Defendant denied
10 infringement and the validity of the Patent, but at the trial relied principally on infringement, and only alleged that the Patent was invalid if it were so widely construed as to include what he did. The third claim of the Specification, which was chiefly relied on by the Plaintiff, was as follows:—"In a road
15 "breaking machine in combination with a pivoted tool holder, carrying tools
"at either side, a frame in which said tool holder is pivoted arranged to slide
"vertically in guides substantially as described and illustrated herein." The machine complained of had no pivot, the frame of the tool holder resting loosely
20 on a washer above a nut; the frame was capable of being raised or lowered by means of a screw, and was also capable of being raised or canted by reason of
its loose fitting, but that movement was controlled partly by springs and was limited by the outer sides of the machine; subject to these the tool holder was during working free to swing, whereas in the Plaintiff's machine there was a locking lever to fix the angle of the tools to the ground; there were also differences
25 in the arrangement for vertical adjustment. The second Defendant had been added as a Defendant by amendment, and at the trial no evidence was given of infringement by him before the date of the Writ.

Held, that the Patentee claimed a combination, and that Claim 3 was a claim for the frame in combination with the pivoted tool holder, and that the machine complained of had no pivot or the mechanical equivalent of a pivot; and that
30 the arrangement for vertical sliding was different from that described in the

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Specification ; and that the machine complained of was not an infringement of the Patent, and that no evidence had been given against the second Defendant of any infringement or intention to infringe at the date of the Writ. Judgment was given for the Defendants with costs, with a Certificate that certain of the Particulars of Objections were reasonable and proper ; but a Certificate was 5 given to the Plaintiff that the validity of the Patent came into question.

On the 5th of February 1895 Letters Patent (No. 2500 of 1895) were granted to *Harry Morrison* for an invention of "A new and improved machine for breaking up surfaces of roads and other hard surfaces."

The Complete Specification was as follows :—"My invention consists of a 10 machine for breaking up the surface of Macadam roads or other hard surfaces. "The parts of the said machine being constructed and combined and used "substantially in the manner hereinafter described. My improved road "breaking machine is principally useful for the purpose of breaking up the "surfaces of roads, preparatory to laying down stones or new material for 15 "repairing the said roads, but the machine may also be used for breaking up "other hard surfaces. My improved road breaking machine consists essentially "of a heavy block or blocks of iron carrying at opposite sides, a set of tools or "pointed teeth for operating on the roads to be broken up. The two sets of "teeth are inclined in opposite directions, one set to be used when travelling 20 "in one direction, and the other set to be used when travelling in the opposite "direction.

"The block or blocks carrying the two sets of tools is mounted upon an axle "or pivot, so, that the said block, or blocks can be rotated or rocked sufficiently "so that one set of tools can be raised from the ground and out of action, and 25 "the other set be lowered down into position for operating upon the road in "the opposite direction.

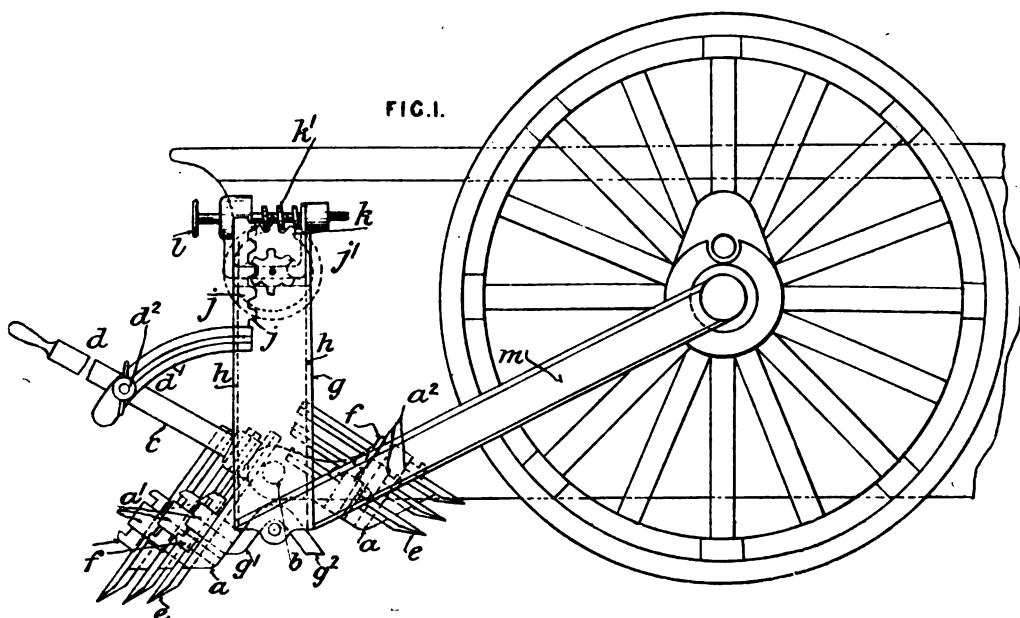
"The rocking block or blocks to have proper sockets or tool holders cast on "or secured to it for the purpose of securing the tools or teeth, the said teeth to "be adjustable to length by means of set screws, wedges, or other suitable 30 "fastening. The axle of the rocking block is to be carried in a frame, having "at its lower end a solid block or stops to support the rocking block at the "proper angle on either side when in action upon the road. The rocking block "is turned upon its axle, to a proper angle, so as to raise one set of teeth, and to "depress the other set by means of a lever, screw & nut, or other suitable 35 "means, the said lever to have a proper arrangement for locking same to frame "when in position.

"The frame carrying rocking block is to work vertically in guides, having at "their upper end a crossbar connecting them together. The said crossbar to "have a strong vertical screw in conjunction with a nut in the top of frame of 40 "rocking block or other suitable means of raising & lowering said block "vertically, for the purpose of adjusting the depth to which the surface of the "road is to be broken or for raising both sets of teeth simultaneously out of "action for travelling or for passing over any obstruction or part which may "not require to be broken. The machine may be secured to the side of or 45 "behind any road roller or road engine and may require a guide wheel to "prevent the teeth from entering the ground too deeply or it may be mounted "upon a suitable heavy carriage to be hauled by steam or other traction power.

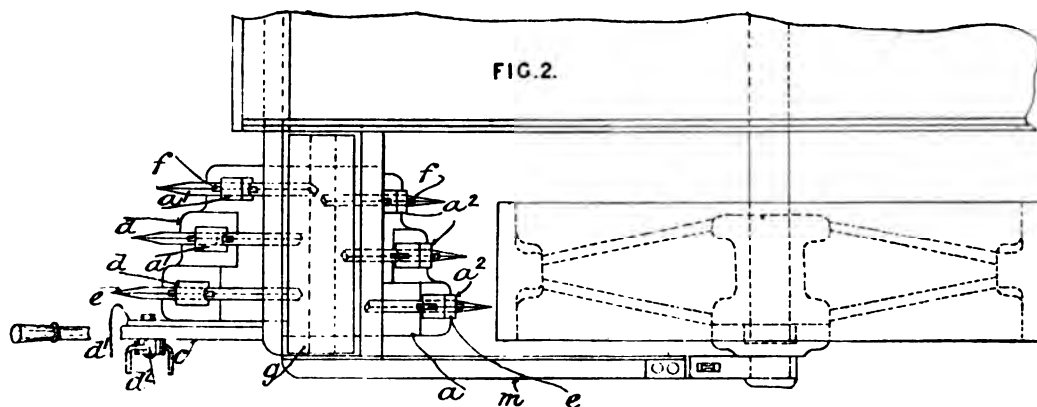
"Referring to the annexed drawings, Figure 1 is a side elevation showing my "invention applied to a road engine or steam road roller. Figure 2 plan view 50 "of same. *a* is a rocking block, carrying the tool holders *a*¹ & *a*² and is "pivoted at *b*, *c* is a lever, by means of which the block *a* may be rocked upon "its pivot *b* and *d* is an arrangement for locking the lever *c* consisting of a "curved slotted plate *d*¹, screw & nut *d*² in any desired position. *e. e* are the

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"tools for breaking up the road, and are set as shown, so that one operates in
 "advance of the other. *f. f.* are the wedges, by means of which the tools *e. e*
 "are secured to the tool holders *a¹* & *a²*. *g* is the frame in which the block *a* is
 "pivoted and carries at its lower end the stops or beds *g¹* *g²* for supporting the



- 5 "block *a*. with the tools *e. e.* at the proper angle on either side when operating
 "upon the road. *h, h* are the guides in which the frame *g* works, and the
 "raising and lowering of the said frame is worked by any suitable means, such
 "as the rack *j* into which is geared, the pinion *j¹* being keyed to the same axle



- 10 "as the worm wheel *k*, the worm wheel *k* being worked by the worm *k¹* by
 "means of the hand wheel *l*. By this means the tools *e, e* may be raised or
 "lowered, and the depth of the cut regulated, without altering the angle of
 "the tools. *m, m¹* are strong connecting bars by means of which the strains

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"when working are communicated to the main axle of the roller and the cross strains are taken from the tender part of the said roller.

"The machine as described may be attached to any road roller or traction engine or carriage & may be drawn or propelled by steam or any kind of power."

The Patentee claimed:—"1. The combined road engine and road breaker substantially as described and illustrated herein. 2. In road breakers a pivoted tool holder carrying tools; beds or supports upon which said tool holder bears, said beds or supports and tool holder being vertically adjustable substantially as described. 3. In a road breaking machine in combination with a pivoted tool holder, carrying tools at either side, a frame in which said tool holder is pivoted arranged to slide vertically in guides substantially as described and illustrated herein. 4. In a road breaking machine in combination with a pivoted tool holder and sliding frame, blocks, beds or supports for supporting said pivoted tool holder at the required angle for working upon a road substantially as described and illustrated herein. 5. In a road breaking machine a frame carrying tool holders, arranged to slide vertically in guides substantially as herein described and illustrated."

On the 30th of June 1903 the Patentee commenced an action against *Bernard Asplen* for infringement of the Patent, claiming the usual relief. On the 21st of November 1903 the Writ was, pursuant to an Order of the Master, amended by adding as Defendants Messrs. *A. and B. Hanson*, under which name *H. G. Hanson* was sued.

The Statement of Claim, as amended on the 7th of December 1903, alleged—(1) that the Plaintiff was the registered owner of the Patent; (2) that the Patent was valid; and (3) that the Defendant *Asplen*, who was a mechanical engineer carrying on business at Southall, in the County of Middlesex and elsewhere, had infringed the Patent as set forth in the Particulars of Breaches, and threatened to continue to infringe the same by the manufacture and sale of machines known as *Bernard Asplen's New (Patent Springs) Trench Cutter and Scarifier No. 1 and No. 2 Machines*, which were made according to the invention in respect of which the Plaintiff's Patent was granted, and that the Defendants *A. and B. Hanson* had infringed, and threatened to continue to infringe, the Patent by the use and sale of such machines as aforesaid.

The Particulars of Breaches as amended alleged—(1) that the Defendant *Bernard Asplen* had at divers times subsequently to the date of the Patent and previously to the commencement of the action infringed the Patent by making, using, letting out on hire, selling and offering for sale at Southall, in the County of Middlesex and elsewhere, road breaking machines or scarifiers made in the manner described and claimed in the Complete Specification; that the Plaintiff complained in particular of—(i.) the sale or supplying by the Defendant *Bernard Asplen* to Messrs. *A. and B. Hanson*, of Southall, in the County of Middlesex, of a machine infringing the Patent in or about the month of April 1903; (ii.) the manufacture of or procuring the manufacture of prior to and offering for sale at the Builders Trades Exhibition, held at the Agricultural Hall, Islington, in the County of Middlesex, on the 13th and 15th days of June 1903, and subsequent days down to and including the 20th day of June 1903 of a machine made in infringement of the Patent known as *Bernard Asplen's New (Patent Springs) Trench Cutter and Scarifier No. 2 Machine*; (2) that the Defendants *A. and B. Hanson* had at divers times subsequently to the date of the Patent and previously to the commencement of the action infringed the Patent by the use for road breaking and sale and offering for sale at Southall aforesaid and elsewhere of a machine or machines made in the manner described and claimed in the Complete Specification; that in particular the said Defendant from about the month of April 1903 used a machine known as *Bernard Asplen's New (Patent Springs) Trench Cutter and Scarifier* made in infringement of the Patent, and since that date had sold and offered for sale machines similar to the

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said machine, and the Plaintiff reserved the right to recover from the Defendants and each of them full compensation in respect of all such infringements for which they were respectively liable.

The Defendant *Asplen* by his Defence (1) denied the validity of the Patent, 5 and (2) denied infringement.

By his Particulars of Objections he alleged—(1) that the Plaintiff was not the first and true inventor; (2) that the alleged invention was the mere application of means previously well known for raising and regulating the points of scarifiers, and was not the proper subject matter of Letters Patent; 10 (3) that the alleged invention was not new; (4) that the alleged invention was published in this realm in the following Specifications:—(a) *G. G. Rutty*, No. 8338 of 1884; (b) *A. A. Voysey* and *H. H. Hosack* (No. 18,843 of 1890); (c) *H. H. Lake* (No. 5503 of 1891); (d) *R. Bomford, B. Bomford, and H. Evershed* (No. 15,214 of 1893); (e) *G. G. Rutty* (No. 4089 of 1894); 15 and (f) *W. E. Gedge* (No. 1554 of 1870); the whole Specification being relied on in each case.

The Defendant, *H. G. Hanson*, sued as *A. and B. Hanson*, denied infringement, and that he had threatened to continue to infringe, and alleged that he did not use or sell or offer for sale the machine or machines as alleged.

20 A drawing of the Defendant's machine is shown on p. 562; the amount of movement or spring was a matter of controversy.

Moulton, K.C., J. C. Graham and *M. D. Warmington* (instructed by *Fullilove & Co.*) appeared for the Plaintiff; *T. Terrell, K.C., and R. F. Colam* (instructed by *Bowkers*) appeared for the Defendant *Asplen*; *C. C. M. Plumptre* 25 (instructed by *A. L. Houlder*) appeared for the Defendant *Hanson*.

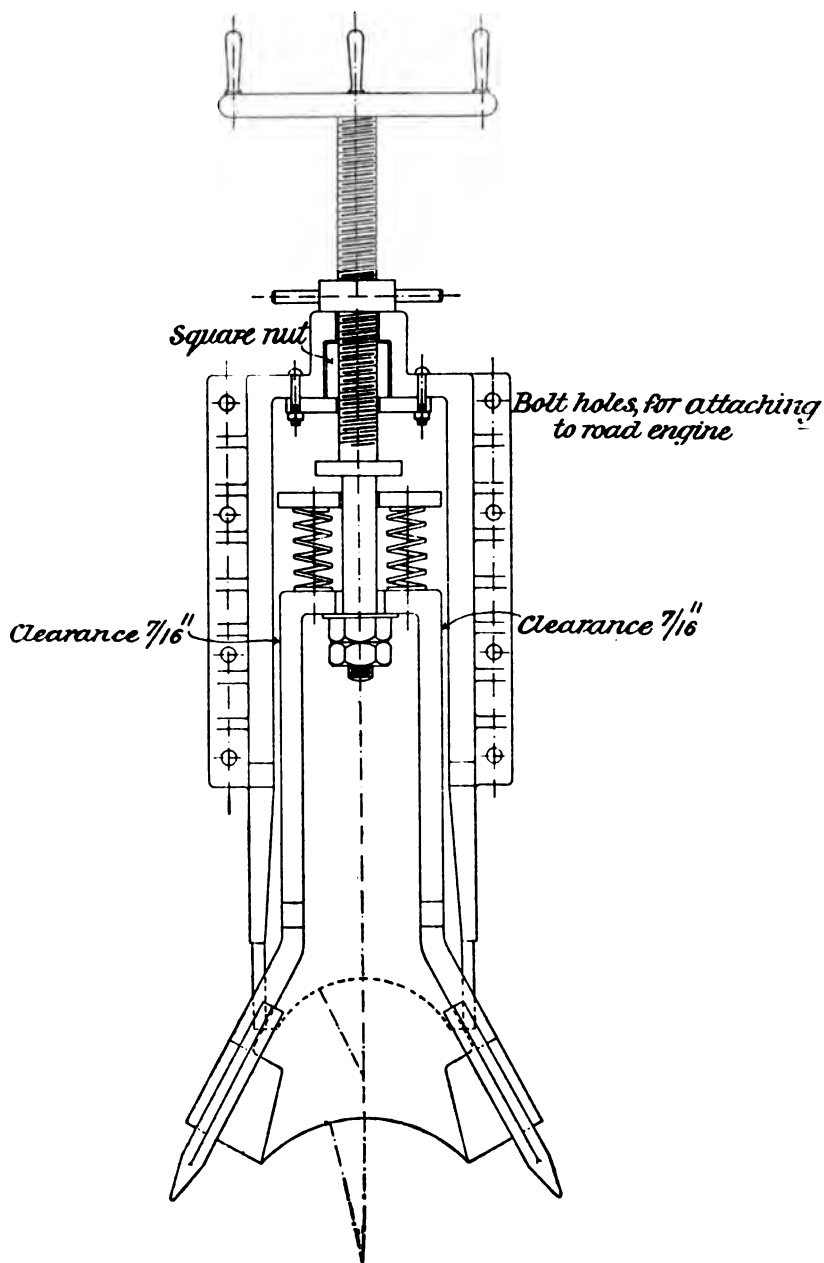
Moulton, K.C., opened the Plaintiff's case.—The Patent is for a road scarifier for breaking up macadam roads preparatory to the repair of the roads. It has had a great success, and is practically the one now universally used in England. [The Pleadings were referred to.] Road-making machines are designed for 30 and must be able to stand very hard work; they must work quickly and well and must therefore be adjusted to different kinds of cut and must be simple. The patented machine is *de facto* novel, and is efficient and simple. The evidence will show that nothing so successful, even approximately, has been put on the market. In fact before it was brought into use the work was 35 practically all done by hand. Utility is not denied; and if one can show a great want, and that it has been satisfied, that is some evidence of novelty. The machine must be able to go forwards and backwards, and on going forwards the back prongs must be raised and *vice versa*, so there is a pivoting action also. The great advantage of the patented machine is that it is adjustable vertically; 40 this is necessary for lifting over manholes or other obstructions. There was only one mechanical scarifier in use before the Patent, and it had only a small sale. The Plaintiff has sold 700 machines. [The Complete Specification was read.] As to the claims, there is not much difference between them. The Defendant's machine has a block vertically adjustable in guides, but instead of 45 having a proper pivot it rests on the flat upper surface of a nut and can swing from side to side. [*Terrell, K.C.*—We dispute the correctness of the model in that respect.] The Defendant's machine fixes itself in working. It takes the subordinate integer, the vertical adjustment, which was a novel point in the Plaintiff's machine. It is within Claims 4 and 5.

50 The Plaintiff gave evidence, and the following further witnesses, namely, *W. H. Fisher*, an engineer in the employment of *Aveling and Porter*; *A. T. Snell*, consulting engineer; *Ernest Van Putten*, Associate of the Institute of Civil Engineers; *T. N. Fullilove*, and *T. N. A. Heyward* also gave evidence on his behalf.

55 During the cross-examination of the witnesses the Specifications referred to in paragraph 4 of the Particulars of Objections under letters (b) (d) and (e) were referred to.

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Terrell, K.C., for the Defendant Asplen.—If a construction is put on the Specification which covers what the Defendants do, the Patent is anticipated. On the natural construction of it I do not say that there is anticipation. The



Patentee in evidence mentioned two great advantages of his machines, one the quick working up and down; but the model is different from the Drawing, 5 and on the Drawing it is a matter of gearing; but there is nothing referring to

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that in the description. His second point was that in the machines shown in *Rutty* and *Bomford's* Specifications the tines, when they entered the ground, were not at the proper angle, but neither were they so in the Plaintiff's Specification. Now it is admitted that five degrees is the most that the angle can vary in
 5 *Rutty*, and that that makes no difference. One must construe the Specification with regard to the state of knowledge. [*Moulton*, K.C.—In *Clark v. Adie* (L.R. 2 App. Cas. 215) Lord *Cairns* said that, after instructing one's mind, one must construe the Specification like any other document.] Claim 1 is a narrow claim for the whole machine, combined road engine and road breaker. In
 10 Claim 2 "substantially as described" applies to each item and the combination. Taking the alleged infringing machine, it has not a pivoted tool holder, therefore the second claim is not taken. Also it is not vertically adjustable "substantially as described." When one comes to a hard piece of ground a slight cant is given, and the springs compress and the teeth ride over. As to Claim 3,
 15 the Defendants have not a frame in which the tool holder is pivoted, nor any pivoted tool holder. As to Claim 4, the sliding frame must be one in which the tool holder is pivoted; besides the Defendant's machine has no blocks, beds, or supports for supporting a pivoted tool holder. It is said that the Defendant's frame acts as a bed or support, which sets a limit to the movement, but it is
 20 quite different from what is shown in the Specification. Practically all the claims in the Specification mean the same thing and claim the whole combination. A wide construction ought not to be put on the Specification. The Courts have established two classes of cases, and this is a *Curtis v. Platt* case. To find out what the invention is, one has to bear in mind the
 25 state of knowledge.

R. E. Royston, an engineer and a Member of the Institute of Patent Agents, was the only witness called for the Defence. There being a difference between the witnesses as to the amount of swing possible in the machines complained of Messrs. *Snell* and *Royston* made some measurements after the adjournment
 30 of the Court on the 18th May. These are referred to in the judgment.

Plumptre for the Defendant *Hanson* called no evidence.

Terrell, K.C., summed up the Defendants' case.—Substantially my case is non-infringement. All the claims of the Specification are for the same combination. The pivoted tool holder is claimed substantially as described, and as described
 35 it is rigid when once set, and the beds and supports are intended to make it rigid. In Claim 2, "said beds or supports and tool holder" are to be vertically "adjustable"; if the sides of the frame of the Defendants' machine, which give a limit to the swing are the "beds or supports", then there is no vertical adjustment of them.

40 *Plumptre* for the Defendant *Hanson*.—No evidence has been given of any infringement by this Defendant before the date of the writ, which is the material date (*Tottenham Local Board v. Lea Conservancy Board*, 2 T.L.R. 410).

Graham in reply. [WARRINGTON, J.—If the Specification is fairly construed I do not think that anticipation has been shown.] As to infringement,
 45 some of the differences are immaterial, e.g., the worm wheel and screw, and the substitution of one for the other makes no real difference. As to the springs in the Defendant's machine, the machine is not the less an infringement for having an improvement; the introduction of that only would not prevent infringement. When the springs are not called into action there is infringement.
 50 The real point is whether the Patentee confined himself to what he describes as a pivot. A Patentee is not bound to describe in words all possible infringements. He is only bound to show the best way, but he may so describe his invention as to say that he does not claim anything more than the thing actually described. One must look at the object of the pivot. Here the
 55 effecting a certain purpose was the invention, a pivot was the obvious way of giving the swing—not merely a loose fitting such as the Defendant has. The result of the pivot, and not the pivot itself, is the essence of

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the invention. The object of it was merely to have mechanism for rocking. [WARRINGTON, J.—Did not *Rutty* provide for rocking to some extent?] That was special and in a peculiar kind of machine, and was not accompanied by any vertical movement. The Patentee might have said an “axle or pivot or its “equivalent.” [WARRINGTON, J.—The Defendant says that he really has no rocking motion.] There is sufficient to take the tines out of contact with the ground; that is the object of the rocking. It does not matter at which part the beds or supports are. There is in each case a rigid block giving a limit to the movement. But the essential feature of the invention is the sliding frame; in this respect the patented machine differs fundamentally from all previous ones. Claims 3, 4 and 5 are all infringed. I agree that Claim 2 is not infringed because the beds or supports are not vertically adjustable in the Defendant's machine. The Patentee has not confined himself to the specific devices so as to exclude obvious mechanical equivalents. (*Clarke v. Adie*, L.R. 2 App. Cas. 315.) I put this case in the same way; the real question in dealing with a mechanical combination is not whether every part is taken, but whether the pith and marrow is; here the pith and marrow is the moving frame. As to the Defendant *Hanson*, we allege in the Pleadings an intention on his part to infringe. Also Order XVI., Rule 11, applies.

WARRINGTON, J.—In this action the Plaintiff seeks for an injunction and damages in respect of the infringement of a Patent (No. 2500 of 1895), which is for “A new and improved machine for breaking up the surfaces of roads or “other hard surfaces.” There are two Defendants to the action—*Bernard Asplen* and *H. G. Hanson*. The action was originally commenced against *Asplen* alone, the Writ being issued on the 30th of June 1903. The Writ and the Statement of Claim were subsequently amended, the Writ being amended on the 21st of November 1903, and the Statement of Claim and Particulars of Breaches being amended on the 7th of December 1903, the amendment consisting in adding the Defendant *Hanson* as Defendant, and the amendment of the Particulars of Breaches alleging a breach by *Hanson* at divers times and subsequently to the date of the Letters Patent and previously to the commencement of the action. With regard to the issues which I have to try, the Defendant *Bernard Asplen* raises the issue of the invalidity of the Patent on the ground of anticipation, and also on the ground of want of subject-matter, but that I have heard nothing about, and therefore I neglect that issue. The Defendant *Hanson* simply denies infringement, and does not raise any other issue. As between the Plaintiff and *Asplen*, therefore, I have to consider, first, the issue of anticipation, and, secondly, the issue of infringement.

The Plaintiff's machine is very well illustrated by the model which has been put in; and it happens, fortunately for me, to be a very simple machine. It consists of what is called in the Specification, a tool holder—that is a contrivance of iron, on which are fixed on either side three sets of tools intended to dig into the road or hard surface, which is to be ploughed up, and then, the machine being either attached to or hauled by a traction engine, it is forced forward, and the tools being set at a suitable angle, tear up the surface of the road. That tool holder in the Plaintiff's machine is set on a pivot which is itself fastened at either end to an iron frame, and the tool holder rocks, or revolves on the pivot, and the amount of rock is controlled, first by a lever which can be locked at any particular place in the middle or at any part of its play; and also (and this is the important part for the present purpose) the rock is absolutely stopped on either side by a rigid bed or support, as it is called in the Specification, which is found in the actual machine immediately under the tool holder and attached to the frame. With regard to the tool holder, the Plaintiff says in his Specification, that his object in contriving it was to have the rocking motion, which would allow the set of tools not in work to be raised above the road, and would at the same time stop the tools which are at work

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from being pressed further backwards by the pressure of the hard substance which they have to work.

The other part of the Plaintiff's machine consists of a contrivance which is a common mechanical contrivance, of a wheel with a worm attached to its axle; this worm works on a cogwheel which again operates on a rack, and so raises, or lowers, the tool holder in the sliding frame with supports at the side, so that the whole machine—the tool holder itself with the two sets of tools—may be raised quickly and easily if a part of the road is arrived at where it is necessary to cease working, the example given being a manhole cover, or something in the road, which it is not desired to disturb. By acting on this wheel the machine can be raised or lowered.

It is necessary now to look at the Specification. It begins by saying :—" My invention consists of a machine for breaking up the surface of macadam roads or other hard surfaces. The parts of the said machine being constructed and combined, and used substantially in the manner hereinafter described." Then the Patentee says what it is used for, and the purpose for which it is principally useful. That I need not read. Then he goes on :—" My improved road breaking machine consists essentially of a heavy block or blocks of iron, carrying at opposite sides a set of tools or pointed teeth for operating on the roads to be broken up. The two sets of teeth are inclined in opposite directions, one set to be used when travelling in one direction, and the other set to be used when travelling in the opposite direction. The block or blocks carrying the two sets of tools is mounted on an axle or pivot, so that the said block or blocks can be rotated or rocked sufficiently so that one set of tools can be raised from the ground, and out of action, and the other set be lowered down into position for operating upon the road in the opposite direction." So far it will be observed that the Patentee states, as the essential part of his invention, the block or blocks of iron carrying on opposite sides a set of tools, one for operating in one direction and the other for operating in the other direction, and the pivoted block so contrived that one set of tools may be lowered to work in one direction and the other set of tools lowered to work in the opposite direction. Then he goes on and says this :—" The rocking block or blocks to have proper sockets or tool holders cast on, or secured to it, for the purpose of securing the tools or teeth"—there is nothing in that; that is merely a common mode of attaching teeth to such a contrivance—" the said teeth to be adjustable to length by means of set screws, wedges, or other suitable fastening. The axle of the rocking block is to be carried in a frame, having at its lower end a solid block, or stops to support the rocking block at the proper angle on either side when in action upon the road. The rocking block is turned upon its axle to a proper angle so as to raise one set of teeth and to depress the other set by means of a lever, screw and nut, or other suitable means, the said lever to have a proper arrangement for locking same to frame when in position."

Pausing there for a moment, the description of the invention up to that point is confined solely to the rocking block carrying the tools. Then the Patentee goes on : " The frame carrying rocking block is to work vertically in guides having at their upper end a cross-bar connecting them together, the said cross-bar to have a strong vertical screw in conjunction with a nut in the top of frame of rocking block, or other suitable means of raising and lowering the said block vertically, for the purpose of adjusting the depth to which the surface of the road is to be broken, or for raising both sets of teeth simultaneously out of action for travelling, or for passing over any obstruction or part which may not require to be broken." That is the first reference in the Specification to the contrivance which I have described in the earlier part of my judgment, as the second part of the Plaintiff's machine, that is to say, a contrivance for raising and lowering the blocks. It goes on : " The machine may be secured to the side of, or behind, any road roller or road engine, and

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" may require a guide wheel to prevent the teeth from entering the ground too deeply, or it may be mounted on a suitable heavy carriage to be hauled by steam, or other traction power."

That is the general description of the machine. The rest of the Specification, until you come to the claiming part, consists merely of references to the Drawings, which I do not think I need trouble about. It is enough to say that the Drawings are substantially the same as the model which we have had here. Then comes the claiming part. The first claim is: "The combined road engine and road breaker substantially as described and illustrated herein." I take it, that refers to that part of the Specification in which the Patentee describes the mode in which the machine may be used, namely, secured to the road engine. Then he proceeds to claim some of the details of the machine. Claim 2 is this: "In road breakers a pivoted tool holder carrying tools; beds or supports upon which said tool bears, said beds or supports and tool holder being vertically adjustable substantially as described." Now, to pause there for one moment, Mr. *Graham* really, in reply, throws over those first two of the three claims, so far as the issue of infringement is concerned, and bases his case on the third claim, to which I am now going to call attention. "In a road breaking machine, in combination with a pivoted tool holder, carrying tools at either side, a frame in which said tool holder is pivoted, arranged to slide vertically in guides substantially as described and illustrated herein." To pause there for one moment, it is to be observed that the claim there is not to the vertical sliding frame; it is to the vertical sliding frame in combination with a pivoted tool holder; and I cannot avoid the conclusion, taking the description in the descriptive part of the Specification and comparing it with the third claim, that what the Patentee really regarded as the essence of his invention was the rocking tool holder—what he calls the pivoted tool holder—and not the vertical sliding frame, except so far as that vertical sliding frame was in combination with the pivoted tool holder.

Then there is a fourth claim, which is in these terms: "In a road-breaking machine in combination with a pivoted tool holder" the Patentee now adds to the pivoted tool holder, which appears in Claim 3, the sliding frame which he has claimed in Claim 3, and says: ". . . . in combination with a pivoted tool holder and sliding frame, blocks, beds or supports for supporting said pivoted tool holder at the required angle for working upon a road substantially as described and illustrated herein." It will be seen, therefore, that in this Claim 4 he has claimed a third element of combination, namely, the blocks, beds or supports. Of course it is obvious that he could not claim every kind of block, bed or support for supporting a pivoted tool holder at the required angle, and he therefore limits himself to "the blocks, beds or supports for supporting the said pivoted tool holder at the required angle substantially as described and illustrated herein." Then the fifth claim is in these terms: "In a road-breaking machine a frame carrying tool holders arranged to slide vertically in guides substantially as herein described and illustrated." There, there is a claim for the frame by itself, but again qualified by the words "substantially as herein described and illustrated." I think I must read the fifth claim in the claiming part of the Specification in conjunction with the describing part, in which, as I have already pointed out, the Patentee says that the machine consists essentially of the block carrying the tools made to rotate for the purpose which he describes, namely, of lowering the working tools on the one side and raising the non-working tools on the other side.

The construction which I think I must put upon this Specification is that which I have already indicated, namely, that the Patentee claims a combination. I do not think any one part of it can be said to be new in itself. It is a combination of several old mechanical contrivances, the essential object of which is to allow the working tools to be lowered on one side and the other tools

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to be raised on the other side, combined with another common mechanical contrivance for raising the whole body with the tools on both sides of the tool holder together.

Now, I think, if I were to hold that the Plaintiff's Specification claimed every
5 means by which the pivoted tool holder could be raised vertically, I should be, in effect, holding that the Specification was such that it would have been anticipated by some of the previous Specifications which have been referred to. But I do not think I am driven to construe the Specification in that way. I think I can construe it more favourably to the Patentee, and in such a way as
10 will make the Patent a valid Patent. I need not trouble much about that, because Mr. *Terrell* has really not alleged that, properly construed, the invention has been anticipated; but I think I ought, for the Plaintiff's sake, to say, that I have while the case was being discussed yesterday, with the assistance of the witnesses, carefully considered the several Specifications that were referred to.
15 There were only three; *Rutty* of 1894, *Bonford*, and *Voysey*, and it seems to me that not one of those Specifications is an anticipation of the Plaintiff's machine. The idea, I take it, in all these machines was that the whole machine—so far as it bears at all on the present question—should work on an axis and on a wheel. There was no vertical arrangement, and it seems to me that the real
20 difference between the Plaintiff's machine and the alleged anticipations is, that the Plaintiff's machine is what one may call a vertical machine, as distinguished from a rocking or rolling machine. I hold, therefore, on that part of the case, that, construed as I think the Specification ought to be construed, the Patent has not been anticipated, and is a valid Patent. The issue of utility was not
25 really raised, but I think there can be no doubt, judging from the evidence I have heard, and particularly from the amount of use to which this machine has been put, that it was a very great improvement on all previous road-breaking machines.

Now I come to the Defendant's machine. The Defendant's machine is also a
30 vertical machine; of that there can be no doubt. Therefore, in that respect it is like the Plaintiff's machine. It is vertical, as distinguished from those in which the tools are set more or less on the periphery of a circle, as was the case in the other anticipating machines. The Defendant's machine is of this nature. It consists, first, of an outer frame of iron with a cross-bar or cross-piece
35 at the top, through which is inserted a vertical screw operated by a horizontal wheel, not a vertical wheel like the Plaintiff's, but the ordinary horizontal wheel by which it is turned on the top; and to the bottom of the screw, attached loosely, is an iron frame, first of all, with straight sides, then widening out into a roughly pyramidal shape, and at the bottom of that frame on either
40 side are fixed the tools. That frame is hung from the vertical screw in such a way that it is loose. It is not attached to it in the sense that it and the screw together form one rigid piece. It is hung on a washer and nut at the bottom of the screw; it is capable of being raised and lowered by the operation of the screw, which itself runs through a worm hole in the frame. But it seems
45 to me that the essence of the Defendant's machine is that that frame or contrivance which carries the tools is not rigid. That non-rigidity is achieved by two means; first, that it is hung, as I have said, loosely on the washer and nut at the bottom of the vertical screw, so that it is capable, without the raising or lowering of the vertical screw, of itself being raised up and down upon
50 it like, as somebody said, a cylinder with a loose fitting piston, and that raising and lowering is controlled in two ways, first, by spiral springs which tend to keep the frame down, and, secondly, by the two sides of the outer part of the machine which keep this frame or tool holder from being forced out of the perpendicular beyond a certain space. Now the machine has been care-
55 fully examined and measured, and it is found that the result of the springing action is this: that the total swing of one of the machines which was seen in the yard, the total arc of swing so to speak—the total space through which

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the tool holder can be swung within the frame is $\frac{1}{8}$ ths of an inch, with the result that when the working tools are resting on the surface of the road, the non-working tools are an inch above the surface. That is automatic in the Defendant's machine. It is not fixed by the operator at a certain angle, as is done in the Plaintiff's by moving a lever and placing the tools either on the bed 5 or support on that side, or on the bed or support on the other side, but it simply acts of itself. The pressure—I mean in the Defendant's machine, the pressure of the road on one side forces the other side against the side of the frame, and so, to the extent I have mentioned, raises the tool above the road; but it seems to me that the object which the Defendant had in 10 view in making this non-rigid machine was certainly not the object which the Plaintiff had in view. I think the object which the Defendant had in view was to do that which, according to the uncontradicted evidence of Mr. *Royston*, he attained. It may be a good object, it may be a bad one; I do not know anything about that; but I think the object he had in view 15 was to allow the machine automatically to yield when it came to some rather harder substance than usual, in fact, that he intended to leave it free, whereas, if the Plaintiff had any intention at all, it was to have his machine rigid, to fix it at a particular angle and leave it there.

Is the Defendant's machine an infringement of the Plaintiff's machine? 20 Mr. *Graham* says it infringes Claim 3, and I will confine myself to that. He says it infringes Claim 3, because it has a frame in which the "tool holder is pivoted; arranged to slide vertically in guides substantially as described and "illustrated herein." In my opinion it does not infringe that claim. The claim, as I have already pointed out, is a claim for the frame in combination 25 with the pivoted tool holder. Now, is there a pivoted tool holder in the Defendant's machine? In my opinion there is not. There is certainly no pivot; that is quite plain; but is there the mechanical equivalent of a pivot? In my opinion there is not the mechanical equivalent, and I think it is sufficient, in order to explain what I mean by that, to refer to what I have 30 already said, namely, I think that whereas the pivot effects the rigidity of the tool holder when it is placed at the required angle, the Defendant's contrivance avoids rigidity, and, I think, purposely avoids it. I think, therefore, it cannot be said to be a mechanical equivalent, because it seems to me to be aiming at an object, and to attain an object which is not contrary to, but materially different 35 from, the object sought to be attained by the Plaintiff's machine. Nor do I think—I do not like to pass it by, although Mr. *Graham* has not made so much of it—that Claim 5 is a claim for the frame alone, but it is for a frame arranged to slide vertically in guides substantially as herein described and illustrated. In one sense, no doubt, the Defendant's frame is arranged to slide vertically in 40 guides, that is to say, that it is so contrived as to move up and down, but I do not think it is arranged to slide vertically in guides in the manner mentioned in the Plaintiff's Specification. Again, on this part of the case I think if I were to hold that the Defendant's machine was an infringement of the Patent, I should be bound to hold that the Patent was one for every contrivance by which 45 a machine of this kind can be made so that the tools can be raised and lowered, and I am afraid if I did that, I should be driven to hold that the Plaintiff's Patent was invalid.

I am of opinion, therefore, that the Defendant's machine does not infringe the Plaintiff's machine, and it would be unnecessary to say more about the case of 50 Mr. *Hanson*; but as the point has been raised, I ought to mention that I have already pointed out that Mr. *Hanson* was not an original Defendant, but was added by amendment on the 21st of November 1903, and the Plaintiff alleges infringement against him prior to the commencement of the action, which, of course, he was bound to do. The only evidence that I can find put 55 in by the Plaintiff—and the Defendant *Hanson* elected not to put in any evidence on his own behalf—consisted of certain correspondence beginning in

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July after the issue of the Writ, and of certain conversations which were said to have been held with Mr. *Hanson* in November shortly before the amendment, the correspondence and these conversations being said to amount to admissions on the part of Mr. *Hanson* that he had used, or was intending to use, the
 5 invention. Now those admissions do not refer to any date at which the alleged user is said to have taken place, and I cannot on these materials hold that there is any evidence against Mr. *Hanson* of infringement or of an intention to infringe the Patent at the date of the issue of the Writ. Therefore, on that
 10 ground, as well as on the main issue of fact, I think Mr. *Hanson* is entitled to succeed. There must, therefore, be judgment for all the Defendants, with the costs of the action. Notwithstanding that, I give a Certificate that the validity of the Patent came in question.

As to the Particulars of Objections, a Certificate was given that in respect of the three Specifications of *Voysey*, *Bomford*, and *Rutty* of 1894, they were
 15 reasonable and proper.

IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER and COZENS-HARDY.

June 1st and 2nd, 1904.

NEOSTYLE MANUFACTURING COMPANY, LD. v. ELLAM'S DUPLICATOR
 20 COMPANY.

Passing-off.—Trade name of goods.—Description of accessories for use in connection with Plaintiffs' machine.—No exclusive right in Plaintiffs to name in connection with accessories.—Judgment for Defendants.—Appeal by Plaintiffs dismissed.

25 The Neostyle Manufacturing Company, which traded in duplicating machines and manufactured and sold accessories for use therewith, which machines and accessories they sold under the name "Neostyle," commenced an action to restrain another Company from passing off ink, paper, and stationery not of the Plaintiffs' manufacture or merchandise as and for the goods of the Plaintiffs by the
 30 use of the word "Neostyle" or otherwise, and from infringing their Trade

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Mark "Neostyle," registered in Class 39 in respect of paper, stationery, and bookbinding. Before the trial the Trade Mark was ordered by the Court of Appeal to be removed from the Register on the ground that the Plaintiffs had not an exclusive right to the word "Neostyle" for such goods (Neostyle Manufacturing Company's Trade Mark, 20 R.P.C. 803). The Defendants 5 alleged inter alia that the term "Neostyle" was not distinctive of the Plaintiffs' goods, and that, as applied to paper, ink, and accessories, it meant that such paper, ink, and accessories were suitable for use in the "Neostyle" machine. The Defendants had described their accessories as being "for the Neostyle," and had used the term "Neostyle Ink" in a catalogue meant for the trade, and two 10 cases of sale of "Neostyle Ink" were proved. At the trial the Plaintiffs adduced evidence to establish a case of passing-off by means of the tins in which the Defendants sold their "ink for the Neostyle," which tins had not in all cases the Defendants' name on them. It was held at the trial that, although the word "Neostyle" had become identified in England with the 15 Plaintiffs' duplicating machines, they had never had any exclusive right to the word in connection with duplicator accessories; that the Defendants might sell ink and paper for use on the "Neostyle" machine, and so describe them, provided that they did not by words or get-up represent their goods as those of the Plaintiffs; that there had been no passing-off by the Defendants; 20 and that the Plaintiffs had failed to establish a case entitling them to an injunction; but the Court suggested that the Defendants' name should always appear on the tins of ink sold by them. The action was dismissed with costs. The Plaintiffs appealed.

Held, that the conclusion of fact arrived at on the trial ought not to be 25 disturbed, and the appeal was dismissed with costs.

On the 15th of July 1902 the Neostyle Manufacturing Company, Ltd., commenced an action against Ellam's Duplicator Company claiming an injunction to restrain the Defendants, their servants and agents, from in any manner passing off any ink, paper, stationery, or other requisites not of the 30 Plaintiffs' manufacture or merchandise as or for the Plaintiffs' goods, whether by the use of the name under which the same was sold or otherwise howsoever; and from selling, or offering, or exposing or advertising for sale, or procuring to be sold, any such goods as aforesaid under the name "Neostyle," or under any other name which, by colourable imitation of such name or otherwise, was 35 calculated to represent or lead to the belief that such goods were the Plaintiffs' goods; and from in any way infringing the Plaintiffs' registered Trade Mark No. 241,492, and for other relief.

The Plaintiffs by their Statement of Claim alleged—(1) that they were a limited Company, which carried on business as manufacturers and vendors of 40 stationery and similar articles; (2) that the various articles manufactured by or for the Plaintiffs and sold by them were distinguished by them from all goods of a similar character by the Trade Mark and trade name "Neostyle," which was specially invented for and had for several years past been used by them and their predecessors in business for that purpose, and such name 45 indicated exclusively that the inks, paper, and other articles of stationery sold thereunder had been manufactured by or for the Plaintiff Company, and the

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same carried their guarantee of excellence in respect of the make, quality, and style of the goods; (3) that in October 1901 the Plaintiff Company obtained registration of the said invented and distinctive word "Neostyle," as their Trade Mark No. 241,492 in respect of paper (except paper-hangings), stationery, and bookbinding in Class 39, and the same was standing on the Register in their name*; (4) that the Plaintiffs had expended large sums of money in advertising their said goods under the name and Trade Mark aforesaid, and by reason of the excellence or such goods, and of the novelty and distinctiveness of the said word "Neostyle," and of the Plaintiffs' energy and expenditure, such goods had become and were well known to the public under such name and Trade Mark as aforesaid, and anyone who asked for or ordered "Neostyle" ink, paper, stationery or the like, intended and expected to receive the goods of the Plaintiff Company and no others; that the said name and Trade Mark were of great value to the Plaintiffs, and it was of extreme importance to them that the same should not be copied or imitated by others; (5) that the Defendants, who carried on in London a business of a similar character to the Plaintiffs, had recently begun to offer for sale and sell and invoice articles of stationery such as ink, paper, and the like under the said name "Neostyle," and thereby to cause such goods to be passed off and sold as and for the goods of the Plaintiff Company; that previously to their commencing to do so the Defendants were in the habit of selling similar articles under other names, and the adoption and use by the Defendants of the said name "Neostyle" in manner aforesaid had taken place with full knowledge on their part of the Plaintiffs' rights, and could only have originated in a desire to imitate the Plaintiffs' goods; and (6) that the use by the Defendants of the said name "Neostyle" in manner aforesaid was calculated to pass off their goods as the goods of the Plaintiffs, and that the Plaintiffs had suffered damage.

The Defendants by their Defence alleged—(1) that the term "Neostyle" was in the year 1889 invented by and had been continuously used by *David Gestetner* to indicate pens, ink, paper and other stationery manufactured and sold by him both in this realm and in the United States; (2) that *David Gestetner* was not the predecessor in business of the Plaintiff Company, and the term "Neostyle" was adopted by the Plaintiff Company without the leave or license of *Gestetner*; (3) that the term "Neostyle" was not distinctive of the goods of the Plaintiff Company as alleged or at all; (4) that there were no predecessors in title of the Plaintiff Company; that one *Klaber*, who was for several years in the employment of *Gestetner* in the United States, and was afterwards in the employment of the *Neostyle Company* of America (a Company formed to deal in the goods of *Gestetner* in the United States) left the employment of the said Company in the year 1899, and came to this country and purported to convey to the Plaintiff Company the right to use the name "Neostyle"; that *Klaber* had no business in connection with the term "Neostyle" or any business at all, and had no power to grant to the Plaintiff Company the right to use the term "Neostyle" and no business to convey in connection with such term; (5) that the word "Neostyle" was wrongly registered by the Plaintiff Company as its Trade Mark; that it was not invented by or for the Plaintiffs, but was a word in common use in the trade to describe the goods of *Gestetner*; (6) that the said word "Neostyle" was improperly placed upon the Register by the Plaintiff Company and should be removed, and that a motion to the Court was pending in which *Gestetner* was moving to rectify the Register by the removal of the said mark; (7) that if the

* This mark was, however, before the trial ordered by the Court of Appeal to be removed from the Register (see *Neostyle Manufacturing Company's Trade Mark*, 20 R.P.C. 803) on the ground that *David Gestetner* had certain rights in the word and the Plaintiffs were not exclusively entitled to the use of it.

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Plaintiff Company had by reason of Trade Mark or user acquired any right to the term "Neostyle," which was wholly denied, the said right had been so acquired in connection with the use by the Plaintiff Company of the said term to describe a particular kind of copying machine manufactured and sold by them and no further or otherwise; (8) that in connection with the said copying machine paper of a suitable size and quality, and ink of a suitable quality, and other stationery of a suitable size and quality was used; (9) that the Defendants, who were manufacturers and sellers of paper, ink, stationery and copying accessories suitable for all classes of copying machines, described the ink, paper and accessories, so sold by them for use with each different kind of copying machine, as paper, ink or accessories for such and such machine, and *inter alia* paper, ink and accessories for use in the "Neostyle" machine was so described, or, shortly, was described as "Neostyle" paper ink or accessories, the term "Neostyle" being the abbreviated title by which the Plaintiffs' copying machine was commonly known; (10) that the term "Neostyle" as applied to paper, ink and accessories did not mean that such paper, ink or accessories were manufactured by the Plaintiff Company, but that such paper ink and stationery were suitable for use in the "Neostyle" machine; (11) that the use of the term "Neostyle" in connection with paper, ink and stationery, in the meaning set out in the preceding paragraph, was common to the whole trade in typewriting and copying machine accessories, and such term was used by the whole trade with such meaning, and the use of the said term in the said connection was so understood by the whole trade and public, and no person had or could be deceived into believing that by such use of the term "Neostyle" the goods manufactured by the Plaintiff Company were intended, nor could, nor had the goods of the Defendants been passed off as the goods of the Plaintiffs by any such use of the term "Neostyle"; (12) save as therein admitted the Defendants denied each and every of the facts alleged in the Statement of Claim, as if the same were specifically denied.

The action was tried by *Byrne, J.*, who, on the 21st of December 1903, delivered judgment, holding that, although the word "Neostyle" had become identified in England with the Plaintiffs' duplicating machines, they had never had any exclusive right to the word in connection with duplicator accessories; that the Defendants might sell ink and paper for use on the "Neostyle" machine, and so describe them, provided that they did not by words or get-up represent their goods as those of the Plaintiffs; that there had been no passing-off by the Defendants; and that the Plaintiffs had failed to establish a case entitling them to an injunction; but the Court suggested that the Defendants' name should always appear on the tins of ink sold by them. The action was dismissed with costs (*ante*, p. 185).

The Plaintiffs appealed.

Astbury, K.C., and *L. B. Sebastian* (instructed by *C. Urquhart Fisher*) appeared for the Appellants; *T. Terrell, K.C.*, *P. O. Lawrence, K.C.*, and *A. J. Walter* (instructed by *Pritchard, Englefield & Co.*) appeared for the Defendants.

Astbury, K.C., for the Appellants, stated the facts, and continued:—Our case is that the Defendants have fraudulently passed off their goods as ours; if this is so, it does not matter that the Plaintiffs have not the right to the exclusive use of the term "Neostyle," but we contend that in this country "Neostyle" means the Plaintiffs' goods. In *Neostyle Manufacturing Company's Trade Mark* (20 R.P.C. 803) the Trade Mark was struck off on the ground that under it the Plaintiffs might have stopped *Gestetner* doing what he was entitled to do. We admit that he has sold extensively in England, though not under the name "Neostyle." The evidence is that "Neostyle" in England means the Plaintiffs' goods, and the Defendants' witnesses admitted that "Neostyle" goods mean the Plaintiffs' goods. The

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mere fact of *Gestetner* having put the caution referred to in the judgment of *Byrne, J.*, on his paper, but without selling it as "Neostyle," paper does not prevent the Plaintiffs' succeeding if "Neostyle" means in the trade the Plaintiffs' goods. *Gestetner* sold "Cyclostyle" paper, not "Neostyle." The

5 "Neostyle" caution was only put on by *Gestetner* for the purposes of America. The Defendants' machine is *Ellam's Duplicator*, and they sell paper for that and also "for the Neostyle." [VAUGHAN WILLIAMS, *L.J.*—This is an action for passing-off alleged to be effected by means of certain similarities, what are they?] The substantial case is that of similarity of name, the

10 Defendants are selling their goods as "Neostyle" goods; the part of the case as to the ink tins is for the purpose of showing fraud; if the Defendants are fraudulently passing off their goods as the Plaintiffs' by whatever means they do it the Court will restrain them. [The evidence was referred to.] In his evidence *Ellam* claimed the right to sell "Neostyle" paper and "Neostyle"

15 ink, but said at first that he did not sell it. [ROMER, *L.J.*—*Byrne, J.*, found in his judgment that he does not so sell it.] At least one case of sale by the Defendants of "Neostyle" ink was proved. The judgments of the Court of Appeal (20 R.P.C. 803) had a great deal of effect on the mind of *Byrne, J.*, but the question is one of fact whether the word "Neostyle" in this

20 country means the Plaintiffs' goods. *Ellam* could not have got our mark struck off. *Gestetner* was in fact under contract to export his "Neostyle" paper to America; no actual sale of it in this country by *Gestetner* was proved in the Trade Mark case. [The judgments in the Trade Mark case were read.] The decision in that case does not prevent the Plaintiffs succeeding here. The

25 Trade Mark was taken off the Register because it would prevent *Gestetner* making and exporting under the name. The Plaintiffs are not attempting or claiming to stop him from so doing. The only effect of the Trade Mark decision was that there was a certain limitation of the Plaintiffs exclusive right which prevented registration. It in no way prevents the Plaintiffs from

30 succeeding in this action. [The judgment of Lord *Herschell* in *Reddaway v. Banham*, (13 R.P.C. 218) was referred to.] It is immaterial how the Defendants pass off their goods as the Plaintiffs, if they do so. Here the conduct of the Defendants in relation to the tins shows fraudulent intent; why did they not put their own name on the tins? [ROMER, *L.J.*—*Byrne, J.*,

35 deals with that point in his judgment.] It was only one way in which they might have distinguished, and it was not for us to suggest it. [ROMER, *L.J.*—There is no evidence of actual deception.] Yes, the witness *George* gave evidence on that point; and also the witness *Hanger*. [ROMER, *L.J.*—If there is no actual passing-off, is not your only point that they are selling

40 goods which third persons may pass off as those of the Plaintiffs?] The Defendants have followed what the Plaintiffs do in several steps, and we contend that their conduct is fraudulent. Also the evidence shows that "Neostyle" means the Plaintiffs' goods, and that the Defendants claim to sell their goods under that name. The Defendants sell as retailers as well as

45 being manufacturers, and in one case they offered to give a better discount for "Neostyle" goods than the Plaintiffs would give. We do not say that the Defendants cannot use the word "Neostyle," but they must sufficiently distinguish. "Neostyle" without the Defendants' name may deceive. Substantially the Plaintiffs succeeded as to that, but have been made to

50 pay all the costs. The Plaintiffs were as of right entitled to the terms which *Byrne, J.* suggested.

Counsel for the Respondents were not called on.

VAUGHAN WILLIAMS, *L.J.*—Mr. *Astbury* has addressed us at some length, I not say at unnecessary length, in a very difficult case. People who have put a

55 Trade Mark on the Register and then have to submit to have that Trade Mark removed from the Register, because it ought never to have been there, not

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unnaturally find themselves in a somewhat difficult position. I entirely agree with Mr. *Astbury* that there is no ground for saying that because the word "Neostyle" has been removed from the Register at the instance of Mr. *Gestetner*, it follows that the word "Neostyle" is not identified more or less with the goods of the Plaintiff Company. On the contrary, I think it is quite open to the Plaintiff Company to show that, notwithstanding the removal of the word "Neostyle" as a Trade Mark from the Register, "Neostyle" has come in the trade to be understood as referring to goods of the Plaintiff Company's manufacture, and, indeed, I understand Mr. *Ellam* to say that that is so. But it would be utterly wrong to say that the position of the Plaintiff Company is that they have an exclusive right in the word "Neostyle" of such a character that they could prevent anybody else using that word in connection with this class of goods. That is not their position, but they have a right, which is a common law right, that no one shall rob them of their trade by passing off his goods as the goods of the Plaintiff Company, and the more the word "Neostyle" is identified with the Plaintiff Company's goods the stronger is the inference to be drawn from the user of that word as a piece of evidence going to establish a case of passing-off. That is the case that Mr. *Astbury* had to cope with. There is not an exclusive right in the Plaintiff Company to this word "Neostyle"; the word "Neostyle" is no longer on the Register, but, on the other hand, the word "Neostyle" must not be used by any rival trader as part of a scheme to rob the Plaintiff Company by representing that the goods of this trader are the goods of the Plaintiff Company, and so passing them off.

I am not at all inclined to say here that there is no evidence in support of Mr. *Astbury's* case; I think that there is some evidence in support of it. That evidence consists of the evidence of a man and a boy. I wish to say something about what it is necessary to prove in a passing-off action. At common law deceit was always the basis of the action, but it is not necessary, and never was necessary, even at common law, that the Plaintiff should at the trial of the action prove the extent to which there had actually been a passing-off. He could always do that by a reference to Chambers afterwards. It was sufficient that he should prove before the Jury a course of business which was calculated, to the knowledge of the defendant, to cause his goods to be passed off in his business as if they were the Plaintiff's goods. I do not think, therefore, that the mere fact that there is only the evidence of these two witnesses prevents the Plaintiffs having a case.

What is the state of things here? Having regard to the evidence about the connection of the word "Neostyle" with the Plaintiffs' business, it seems to me that the word "Neostyle" was a word which the Defendants must have known when they used it might mislead unless they were very careful. The word "Neostyle" as used is an ambiguous word. It might mean that the goods were goods intended to be used with a Neostyle machine, a Neostyle pencil, or it might mean that the goods were manufactured by the *Neostyle Company*; and when an honest trader is dealing with a word of that sort he must know that there is some risk, and if he wishes to do his business fairly he will try and avoid that risk as much as he can; and it has been suggested here that the Defendants ought to have added "Manufactured by *Ellam & Co.*," or some words of that sort, which would have prevented any possibility of deception. They seem now, through their Counsel, to recognise that fact, and they say that they had done so for some time before the trial, and that they expressed their intention to do so at the trial to Mr. Justice *Byrne*, and now they say that they have done so, that they have really ceased to sell anything that includes in its description the word "Neostyle" at all. If they really have done that they have done it very handsomely. I cannot conceive, however, that if they issue catalogues now and in their catalogues do not mention the word "Neostyle" at all, they are

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laying themselves out very much for that particular line of business. But there it is.

- I have already stated that it is impossible to say that there is no evidence in favour of the contention of the Plaintiff Company, but after all this was a question of fact, a question to be tried by Mr. Justice *Byrne*. He saw and heard the witnesses; he had, according to Mr. *Astbury*, the enormous advantage of hearing the evidence of Mr. *Ellam*, who Mr. *Astbury* says was a witness who really gave his evidence in such a manner that it was not easy to place much reliance upon it; and the learned Judge who had all that to take into consideration has come, on the whole, to the conclusion that the Plaintiffs' case has not been made out. I can quite understand the way the learned Judge looked at it. Really, so far as the carrying on of the business is concerned, there is nothing but the fact of the user of this box (a box which has been got up in form, at all events, if not in letter, very like the Plaintiff Company's box) and there is also the evidence of those two witnesses. Is that sufficient to make out that the Defendants so conduct their business that they are likely to mislead those who deal with them into thinking that the goods that they buy from the Defendants are the goods of the Plaintiff Company's manufacture? The learned Judge thinks there is not sufficient here, and one cannot help bearing in mind that, although the box of the Defendants has not the distinguishing name on it which Mr. *Astbury* suggests it ought to have, it has a great deal to distinguish it. I cannot suppose myself that any man who was in the habit of buying this tin of the Plaintiff Company "Remove the lid and substitute hinged cover. Always stir thoroughly when dipping brush. Purple. *Neostyle Manufacturing Company, Ltd.*, 29, Queen Victoria Street"—could easily suppose that he was buying the same thing when he bought a box, although of the same shape, with the label "Ink for the Neostyle. Blue. Best quality. Odourless." The two labels are very unlike each other. At all events, be that how it may, in my judgment there is evidence on both sides here, and in these cases, as in any other case when there is, with regard to a mere question of fact, evidence on both sides, one ought not to differ from the conclusion of the Judge who has seen and heard the witnesses unless there is a very strong case made out independently of the question of the credibility of the witnesses on the one side or the other. So that on the whole I think that we ought not to disturb the conclusion of fact of Mr. Justice *Byrne*.

ROMER, *L.J.*—I also do not see my way in this case to differ from the conclusion arrived at by Mr. Justice *Byrne*. It is clear that the Defendants are entitled to sell paper and ink, manufactured by them, described as being "for the Neostyle" provided that by the get-up of those goods the Defendants do not represent such goods as having been made by the Plaintiffs.

On the whole, all I need say is that I think the Plaintiffs have not established that the goods themselves, as they are sold by the Defendants, are calculated to deceive merely because those goods are not marked with the Defendants' names as manufacturers, seeing that the get-up of the goods is distinct.

- The only other remark I need make is this, that I do not think the evidence of the two witnesses referred to by Mr. Justice *Byrne* in his Judgment is sufficient to justify this Court in inferring that the Defendants have in fact sold their goods as and for goods made by the Plaintiffs. In the result that is really what the whole case comes to. I think the Plaintiffs have failed in establishing such a case as would justify this Court in giving them relief against the Defendants.

COZENS-HARDY, *L.J.*—I agree.

Terrell, *K.C.*—The appeal will be dismissed with costs?

VAUGHAN WILLIAMS, *L.J.*—Yes.

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In the Matter of the Trade Mark "Hæmatogen."*

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE WARRINGTON.

June 8th, 9th, 10th, 11th, and 13th, 1904.

HOMMEL (trading as NICOLAY & CO.) v. GEBRÜDER BAUER & CO.

IN THE MATTER OF THE TRADE MARK "HÆMATOGEN."

5

Action for infringement of Trade Mark and for passing-off.—Motion to rectify by striking the Trade Mark off the Register.—Passing-off not established.—Descriptive word.—Invention.—Action dismissed.—Order made for rectification of Register.—Stay refused.

In 1890 Hommel, the Plaintiff in the action, first sold in Germany a proprietary medicine which he called "Hommel's Hæmatogen" (later "Hæmatogen prepared by Dr. Hommel"), the name "Hæmatogen" having been suggested to him by a friend in the previous year. The word appeared to have been applied in 1883 to a similar but non-commercial product by a physiological chemist, but this fact was not known to the Plaintiff, although he admitted that prior to 1890 he had heard of the word used (in German) as an adjective but not as a substantive. In 1893 he introduced his product on the English market, since when the sales had rapidly increased without a rival. In 1899 he registered the word "Hæmatogen" as a Trade Mark. In 1902 a Hamburg firm commenced to sell a similar product under the name "Hæmatogen," and this was introduced on the English market by the Defendants. The Plaintiff commenced an action for infringement of his Trade Mark and for "passing-off," his complaint being confined to the word "Hæmatogen" and not extending to the "get-up" of the goods. The Defendants moved to rectify the Register of Trade Marks by striking off the word.

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Held, on the Motion, that the Trade Mark was not an "invented word" within the meaning of section 64 of the Patents &c. Act, 1883 to 1888, and must therefore be struck off the Register.

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Held, in the Action—(1) that there had been no actual or attempted "passing-off" by the Defendants; and (2) that, even if there had been, the word "Hæmatogen" had not acquired such a secondary meaning as, in the absence of registration, to entitle the Plaintiff to relief. Action dismissed accordingly.

- 5 Cellular Clothing Company v. Maxton and Murray (16 R.P.C. 397; L.R. (1899) A.C. 326) followed.

Dr. Adolf Hommel, trading as Nicolay & Co., at Zurich, in Switzerland, was the manufacturer and proprietor of a preparation of the substance known as "Hæmoglobin," and which he had for many years sold under the name
10 "Hæmatogen," and, on the 4th of May 1899, he registered as a Trade Mark, in Class 3 in respect of medicines for human use, the word "Hæmatogen." He commenced an action against *Gebrüder Bauer & Co.*, trading in London, for an injunction to restrain them from infringing his registered Trade Mark, and to restrain them from "passing-off" a preparation not manufactured by the
15 Plaintiff as and for the Plaintiff's. The Defendants subsequently gave notice of a Motion to rectify the Register of Trade Marks by expunging therefrom the Plaintiff's Trade Mark "Hæmatogen," on the ground that it was neither invented nor distinctive, but was a word describing the goods.

The following statement of the facts of the case is substantially taken from
20 the judgment of Mr. Justice Warrington, who tried the action:—

With regard to the history of this word it appeared that in the year 1883 a German doctor—a chemist—named *Bunge*, by certain experiments, discovered that the yolk of egg contained a certain organic form of iron which he rightly concluded was that which in food tends to the formation of the red corpuscles
25 of the blood. In the year 1885 his discovery, in the shape of a pamphlet, appeared in a German publication called the "*Zeitschrift für Physiologische Chemie*," and in that, in announcing his discovery, he stated that he proposed to call the substance which he had thus discovered "Hæmatogen," at the same time pointing out that he was not quite accurate in so doing inasmuch as it did
30 not produce blood but produced the red corpuscles of the blood, and it would therefore more properly be described as "Hæmoglobin," but he thought that "Hæmoglobin" was so long and cumbersome a word that he preferred to call it "Hæmatogen." That book was circulated in Germany and came over in a German form to England. In the year 1887 he published, in Germany, a book
35 which he called "*Text Book of Chemical Physiology*," in which he repeated, in a rather more elaborate form, the discovery which he conceived he had made, and again stated that he proposed to call that substance which he had discovered "Hæmatogen." That book was translated into English by Dr. *Wooldridge*, and appeared in the English form in the year 1890. That was the first trace in
40 that physiological form in which the word "Hæmatogen" is found in England, although it had appeared earlier in a journal of the Chemical Society which was published in the year 1885. Subsequently to that date of 1890 the word frequently appeared in books devoted to physiological science; for example, in 1891, in Dr. *Foster's* "*Illustrated Encyclopædic Medical Dictionary*," and in
45 Dr. *Halliburton's* "*Text Book of Chemical Physiology and Pathology*," also in 1891; and in the year 1893 in Dr. *Halliburton's* "*Student's Handbook of Physiology*," which had a very large circulation; it appeared also in *Kirk's* "*Manual of Physiology*," edited by Dr. *Halliburton*, and, in 1894, in an American book in the glossary at the end containing a list of uncommon
50 names; and it appeared subsequently in several books devoted to physiology and to *Materia Medica*. From its first appearance in England it appeared to have been used by physiological lecturers in their lectures, and, in particular,

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in a lecture which Dr. *Halliburton* gave in the Royal College of Physicians in 1891.

The Plaintiff's goods in question, which were first sold in Germany in 1890, were first sold in England in 1893, and the sales, which were small at first, increased year by year as a result of the outlay in advertisement and energy on the part of the Plaintiff. His own name appeared on the labels of the bottles and on the cartons in which they were sold, in conjunction with the word "Hæmatogen" until 1902, when "*Hommel's Hæmatogen*" was altered to "Hæmatogen prepared by Dr. *Hommel*." With regard to the adoption of the word the Plaintiff deposed that in 1889, when he had never heard of *Bunge's* user of it, it was suggested to him as a title for his goods by a friend named *Walter* (for further facts as to this see the judgment below).

In 1902 a German firm named *Kohr*, of Hamburg, introduced a cheaper form of "Hæmatogen" in the market, their product containing a smaller quantity of hæmoglobin than the Plaintiff's, but being made and sold for the same purpose. The Defendants *Gebrüder Bauer & Co.* were London dealers, who took up an agency for the sale of the product, and secured the orders referred to in detail in the judgment.

The action came on for trial before Mr. Justice WARRINGTON on the 8th of June 1904.

H. Terrell, K.C., and *Sebastian* (instructed by *J. and M. Solomon*) appeared for the Plaintiff; *F. C. Norton*, K.C., and *F. Watt* (instructed by *Arthur Wintle*) appeared for the Defendants.

Terrell, K.C., opened the Plaintiff's case, and the witnesses on both sides were then heard.

For the Plaintiff evidence was given by *Julius Link*, of *Hedley & Co.*, and *W. J. Patey*, of *Roberts & Co.*, the London firms of chemists who by the Plaintiff's instructions had given orders to the Defendant; *Dr. Otto Hehner*, who had analysed the two products, and stated that the Defendants' contained five per cent. less albumen than the Plaintiff's; and a number of medical witnesses, including *Dr. David Walsh*, editor of the "Medical Press and Circular"; *Dr. William Murrell*, physician to the Westminster Hospital; *Dr. E. G. Younger*; *Dr. Bertram Abrahams*, lecturer at the Westminster Hospital; and *Dr. S. Sunderland*. The trade witnesses included *Sir Thomas Robinson*, of *Hayes, Cunningham, and Robinson, Ltd.*, of Dublin; *E. Pickering*, manager of *Francis Newbery & Sons*; and *W. H. Thomas*, of *Wilcox, Jozeau & Co.*, trading as *Foreign Chemists, Ltd.*

The witnesses called by the Defendants included *Dr. W. D. Halliburton*, professor of physiology at King's College, London; *Dr. H. W. Lyall*, lecturer at the same College; *Dr. R. W. E. McIvor*, director of the Technical Research Laboratories, London; *Dr. Victor Ryan*, and *Miss C. Thomas*, a teacher of Swedish physical exercises; also *T. E. Lescher*, a director of *Evans, Sons, Lescher and Webb, Ltd.*, wholesale druggists, London and Liverpool. References to the evidence of these witnesses will be found in the judgment.

At the close of the evidence the Defendants' Motion to rectify the Register was taken as opened.

Terrell, K.C., for the Plaintiff.—First, as to the Motion; since the decision in the "*Solio*" case a trader may choose between inventing a word within subsection (d) of section 64 (1) of the Act and taking a word which, within subsection (e), has no reference to the character or quality of the foods—*Re Eastman Photographic Materials Company's Trade Mark* ("*Solio*"), 15 R.P.C. 476; L.R. (1898), A.C. 571; *Re Linotype Company's Trade Mark* ("*Tachytype*"), 17 R.P.C. 380; L.R. (1900), 2 Ch. 238; and *Re Burroughs, Welcome's Trade Mark* ("*Tabloid*"), 21 R.P.C. 217; L.R. (1904), 1 Ch. 736. In this case "Hæmatogen" is an "invented" word. [*Norton*, K.C.—In the

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"Solio" case the Lord Chancellor said that an invented word must not be purely descriptive; it must not be only a description.] It is enough if it is "invented." [WARRINGTON, J.—But at any rate it must have been invented by the person seeking registration or his predecessors in title?] Not necessarily, as is pointed out by *Cozens-Hardy*, J., in *Re Linotype Company's Trade Mark* ("Tachytype") (*ubi supra*). Here the Plaintiff was the first to apply to a commercial product a word which previously had been applied by a scientist to an obscure museum-product, and so was known only to a few physiologists. [WARRINGTON, J.—But to a large number of people the word of itself, and quite apart from *Bunge's* experiments would mean a "blood-forming substance."] The evidence is that they only so knew it from what *Bunge* had done. What the Plaintiff did was, in 1888, to take the name which before had been used in an adjectival sense and use it as a substantive, when he himself had never heard of *Bunge*. [WARRINGTON, J.—Suppose that a man invents a word and delays bringing his product under that name into the market, so that before he introduces it, it has become common, can he then register it as "invented"?] Without going so far as that, the question is as to the state of knowledge at the time when he invented it; there must be knowledge of traders and "men in the street," not merely of a few expert scientists. Here the Plaintiff has not merely presented his invented word to the public, without himself using it, but has used it himself from the start and continuously, so as to acquire a property in it which is not created by registration—(*Mouson & Co. v. Boehm*, L.R. 26 Ch. D. 398, 405; and *Re Hudson*, 3 R.P.C. 158; L.R. 32 Ch. D. 311, 325). This is a good registrable mark, and, if it is a case of doubt, the Plaintiff is entitled to the benefit of having been on the Register for many years (*Re Chesebrough's Trade Mark* ("Vaseline"), 19 R.P.C. 352; L.R. (1902) 2 Ch. 1, approved on this point by *Vaughan Williams*, L.J., in *Re Burroughs Wellcome and Co.'s Trade Mark* ("Tabloid"), *ante*, 217, 225; L.R. (1904) 1 Ch. 736, 750). Secondly, as to the passing-off, the Plaintiff is entitled to relief, even if he fails on the Defendants' Motion, although the injunction may be awarded in a different form. [WARRINGTON, J.—Your difficulty seems to me to be that your reputation has been obtained in great degree by obtaining an improper registration.] That can hardly be when the word registered is the name of the article sold under it; moreover, the fact of there having been registration of a Trade Mark, since expunged, does not affect the case as to passing-off (*Thompson v. Montgomery* ("Stone Ales"), 6 R.P.C. 409; L.R. 41 Ch. D. 35, 42; 8 R.P.C. 361; L.R. (1891) A.C. 217; *Powell v. Birmingham Vinegar Brewery Company, Ltd.* ("Yorkshire Relish"), 14 R.P.C. 720; L.R. (1897) A.C. 710, 722, 727), in which latter case *Lindley*, L.J., observed that it mattered not that the injunction might give a better monopoly (13 R.P.C. 235, 253; L.R. (1896) 2 Ch. 64); and in that case the injunction went, notwithstanding a clear distinction in colour between the two labels; see also *Faulder v. Rushton* (20 R.P.C. 477), and the observations of *Vaughan Williams*, L.J., in *Neostyle Manufacturing Company v. Ellam's Duplicator Company*, *ante*, p. 569. The result of the Plaintiff's well-advertised and increasing trade for ten years is that anybody else who comes to sell a blood-producing medicine in England under the name "Hæmatogen" is doing that which is calculated to deceive. As to the trade for India, the only evidence is that "Hæmatogen" there means the Plaintiff's product, and it is immaterial whether the goods are meant for India or for England (*Orr-Ewing & Co. v. Johnson & Co.*, L.R. 13 Ch. D. 450, 7 A.C. 219).

Norton, K.C., for the Defendants, was not called upon as to the Motion to rectify. As to the passing-off, the Plaintiff has not affirmatively established that the word "Hæmatogen" has a secondary meaning within such cases as *Siebert v. Findlater* ("Angostura Bitters"), L.R. 7 Ch. D. 801, and *Cellular*

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Clothing Company, Ltd. v. Marton and Murray, 16 R.P.C. 397; L.R. (1899) A.C. 326. The "Yorkshire Relish," "Stone Ales" and "Silverpan" cases are distinguishable because in them there was a reputation establishing the secondary meaning before the registration of the Trade Mark and there were no rivals; here there is no evidence of such prior reputation and the rivals were kept away by an improper registration. Finally, there is no evidence of fraud whatever. 5

Terrell, K.C., in reply.—This word has acquired a secondary meaning, like "Camel-hair Belting" in *Reddaway v. Banham* (13 R.P.C. 218; 1896 A.C. 199). [WARRINGTON, *J.*—But in that case it was as against the particular Defendant.] No, against all the world; for the word was held not to be open to the trade. 10

WARRINGTON, *J.*—In this case the Plaintiff claims relief against the Defendants under two heads: first, he seeks relief as the proprietor of a Trade Mark which he says the Defendants have used; and secondly, he alleges that the Defendants are seeking to pass off goods in which they are interested as the goods of the Plaintiff, and he seeks relief on that ground. 15

I propose to deal separately with these two questions. The Defendants, in order to put themselves right with regard to the Trade Mark part of the case, have moved to rectify by striking the Trade Mark off the Register, as having been wrongly inserted therein on the ground that the word "Hæmatogen" constituting the Trade Mark was not invented by the proprietor of the same, or by any of the other persons under whom he claims; that the word was not first used by him, or any other person under whom he claims; that the word is not invented and distinctive; that the word is in common use in Germany and elsewhere, and preparations so called are sold by various persons; that the word is an English word meaning a preparation made from, or producing blood, or is such English word with a slight change of termination; and that the only part for which registration is claimed is a common English affix. 20 25 30

The Trade Mark which is claimed in this case by the Plaintiff is the word "Hæmatogen." The goods in respect of which it is used are a patent or proprietary medicine, the object of which is to encourage the formation of the red corpuscles in the blood, and the main constituent of which is an organic form of iron found in many food stuffs, but which in this particular instance is derived from bullocks' blood. 35

I will now turn to the Act of Parliament in order to consider from that what it is that I really have to decide. The material section in this particular case is section 64 of the Act of 1883, as amended by the Act of 1888. Before I read the section I will just mention this: that the date of application, and therefore the date which it is material to bear in mind in considering these questions of registration, is the 4th of May 1899. The 64th section of the Act of 1883, as amended by the Act of 1888, so far it is material for the present purpose, is as follows:—"For the purposes of this Act a Trade Mark must consist, or contain, "at least one of the following essential particulars." Then, passing over (a), (b), and (c), is "(d) an invented word, or invented words," or "(e) a word, or words, "having no reference to the character or quality of the goods, and not being a "geographical name." I get rid of subsection (e) at once. It has not been contended, and if it had been I think it would have been contended without success, that the word "Hæmatogen" is not a word having reference to the character or quality of the goods. It seems to me, dealing, as we are here, with a patent medicine intended for use in particular diseases in which there is a defect in the colouring corpuscles of the blood, the word "Hæmatogen" has reference to the character or quality of the goods; and, in fact—and that was admitted by all, I think, of the scientific witnesses who were called on behalf 40 45 50 55

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of the Plaintiff—so far as the word was concerned, the signification of the word is a blood former, and the formation of blood is the object of the particular patent medicine. I therefore dismiss that subsection, and come to consider subsection (d), that being the subsection under which, if at all, the Plaintiff was entitled to register the mark.

Now what is the meaning of "an invented word?" The Act itself throws no light on that question. It simply uses the expression "an invented word" without any explanation. Therefore one has to consider it outside the Act, and as far as one can, to arrive at some meaning. In the first place it means a word having that particular qualification "invented." A vast number of words—we might say, putting the extreme possible case, all the words in the language—were at some time or other invented. It is therefore necessary to limit the use of that word in some way. I think that is clear. Some light is thrown upon the question by the remarks of two of the learned Lords in addressing the House in the case of the *Eastman Photographic Materials Company, Ltd., v. Comptroller-General of Patents, Designs, and Trade Marks* (15 R.P.C. 475; L.R. (1898) A.C. 571). There Lord *Herschell*, and I think Lord *Macnaghten*, both used the expression "newly coined" as an equivalent expression to "invented." Lord *Herschell* said this:—"With regard to words which are truly invented—words newly coined—which have never theretofore been used, the case is, as it seems to me, altogether different; and the reasons which required the insertion of the condition are altogether wanting." The condition which is referred to there is the condition which would prevent one man from appropriating common words in the language and making a monopoly of them. Then he said:—"If a man has really invented a word to serve as his Trade Mark, what harm is done, what wrong is inflicted, if others be prevented from employing it, and its use is limited in relation to any class or classes of goods to the inventor?" Lord *Macnaghten* used this expression in discussing what is meant by an invented word. He said "the word must be really an invented word. Nothing short of invention will do. On the other hand nothing more seems to be required. If it is an invented word, if it is new and freshly coined (to adapt an old and familiar quotation), it seems to me that it is no objection that it may be traced to a foreign source, or that it may contain a covert, and skilful allusion to the character and quality of the goods." Therefore, so far and to the extent to which I have referred, I think the expression used in the speeches of these two learned Lords throws a little light on what I have to decide, but in one way they raise a fresh difficulty. By substituting "newly coined" for "invented" one gets in the element of date—at what time is the word to be newly coined? I will deal with that directly; but dealing, first of all, with the expression "newly coined," what must one find in order to hold that the word is an invented word? I think one must find this: that the word did not exist before. I do not mean to say that because by searching in a number of dictionaries you might find there was such a word in some obscure corner—that by great industry you might discover that such a word could be found that would prevent a word from being an invented word; but substantially it must be a new word, "newly coined," as Lord *Herschell* and Lord *Macnaghten* said.

Now that leads one step further. If that is the true meaning of the word "invented," and I think it is, it must not be an old word which is now used for the first time in a new sense; it must not in my opinion be an adjective which is now for the first time used as a substantive. That is not inventing a new word, but is merely using an old word in a new sense.

Again, this seems to me to follow from the fact that we are dealing with the part of the Statute which relates to the registration of Trade Marks, that the word must be invented for the purpose of being used as a Trade Mark. To

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talk about an invented word in the abstract does not seem to me to be what is meant in this Act of Parliament. This Act of Parliament is intended to be a code regulating Trade Marks; this particular part is that part of the code which regulates the registration of Trade Marks. I think therefore the word referred to there as an invented word is a word which a man invents for the purpose of applying it as a Trade Mark to his particular goods. 5

Now I come back to the expression "newly coined," which was used by both Lord *Herschell* and Lord *Macnaghten* in the *Eastman* case, commonly referred to as the "Solio" case. What is meant by "newly coined"? I think it must mean, at all events, this—coined for the first time for the purpose of being applied to the goods in question. I think it must mean that at all events, if it does not mean more. My doubt is whether it ought not to be held further that it means newly coined, and here again I say substantially newly coined at the date of the application for registration. I do not mean to decide that; because I think it will be inferred from what I have already said when I come to deal with the history of this word, that I have quite sufficient material before me to hold that the word was not an invented word without going so far; but my present inclination is, if I had to decide it, that the word must be newly coined at the date at which the application for registration was made; and again I say substantially. I do not mean to say that it must be invented on a particular day, or even within a week, or a month or two, or even a year. I do not mean to lay down any time, but substantially coined for the purpose of being registered as a Trade Mark. And I make that observation for this reason: it occurs to one at once that if the other view were to prevail a man might adopt his word, and it might get into common use not merely as applied to the goods, but it might get into common use between the time that he first used it and the time when he applied for registration; and inasmuch as registration, though it does not create a monopoly, does do that which enables the person who claims the monopoly to enforce it by legal proceedings, one might be enabling a person in that way to establish a legally enforceable monopoly, in a word, which had become part of the common stock of the English language. However, I do not mean to decide that. It is quite sufficient for my purpose if I am right in saying that the word must be adopted for the purpose of application to the particular goods, or in other words for the purpose of its use as a Trade Mark. And when I say for the purpose of its use as a Trade Mark, I mean for the purpose of its use as a Trade Mark in this country. 10 15 20 25 30 35

[His Lordship here stated the facts as to the invention of the word, which are above set out, and continued]:—The Plaintiff's goods were first sold in England in the year 1893, although the first actual record in figures of sales produced at the trial is in the year 1894. 40

There is another fact which is, it seems to me, a most important fact to notice. Dr. *Hommel* stated that he first invented the word in the year 1889 for use with the patent medicine in question which he had discovered about that time, and that it was suggested to him by a friend, Dr. *Walter*, and he admitted that the word had long been used as an adjective in German before; the adjective uninflected and the form of the substantive being in German identical. Therefore, when it was first used, it was used as a German word; and it was identical with the word which, according to Dr. *Hommel's* own statement, had been long known as an adjective. He says he consulted Dr. *Walter*. [His Lordship here read from the evidence.] "He proposed to me the word 'Hæmatogen,' because 'Hæmatogen' is a very long-known name; not invented by *Bunge*, but known only in an adjectival sense, not as a noun substantive." Then in answer to the question, "*Bunge* in 1883 used the word 'Hæmatogen'?" he replied, "As a substantive; but it is an old word as an adjective." Now, therefore, when it was "invented"—I am 45 50 55

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using that word in inverted commas—I mean when it is alleged that it was invented—it was a German word, and an old German word. Was it invented as an English word? I agree that in England the same remark does not apply, that except for the use of which I have referred to there was no common word of another part of speech corresponding with the word "Hæmatogen." But if I am to look at its introduction into the English language, the earliest date of invention that one can take is the year 1893. If I am to regard its invention as an English word that would be the year 1893. Now by the year 1893 it seems to me it had become a word extensively used amongst physiologists, amongst persons who had to do with the particular science to which this class of goods was directed, and I think that being so I am entitled to say, without going so far on as the year 1899 when the application for registration was made, that if invented at all for the purposes of this Trade Mark it was first invented in the year 1893, and not at the time that the Plaintiff first used the German word in another sense, and if one takes the year 1893 there was sufficient use of the word in England before that date to justify me in holding that it was not at that date an invented word within the meaning of the Trade Marks Act of 1883.

I do not think it is necessary for me to go through any of the authorities which were cited on this part of the case. I have referred to the "Solio" case. There was another case which was cited to me called the "Tachy-type" case, before Mr. Justice *Cozens-Hardy*, and I do not think a word that I have hitherto used is in the least inconsistent with anything that he said in that case. In each case the Judge who has to determine the question must determine it for himself on the facts that he has before him, and in the general remarks with which I began on the construction of the Act I do not think I have said a word which was inconsistent with anything which Mr. Justice *Cozens-Hardy* said in the "Tachytype" case, and I have endeavoured to make what I have said not only consistent with but based upon what was said by the two learned Lords in the House of Lords.

I hold, therefore, that the Plaintiff's Trade Mark fails and ought not to have been registered, on the ground that it does not contain, within the 64th section, that which is the essential particular for the purpose of this Trade Mark, namely, an invented word.

Now comes a part of the case which has given me perhaps more difficulty, if anything, than the question as to the Trade Mark. It is said that the Defendant has passed off and is threatening and intending to pass off goods not the Plaintiff's as the Plaintiff's goods. That arises in this way. The Plaintiff's Trade Mark was registered in 1899. He began to push the sale at about the same time. He has advertised it very largely and his medicine has, I gather, become very widely known. He makes it up in what are commonly called cartons, which have on the one side the Trade Mark "Hæmatogen" with a label underneath it on which until recently were the words "Doctor of Medicine—*Adolf Hommel's Hæmatogen*," and more recently "Prepared by Dr. *Adolf Hommel—Hæmatogen*," but in either case the name of Dr. *Hommel* appeared prominently on the labels. On the back there are these words "Directions for using Dr. *Hommel's Hæmatogen*." That appears on the later cartons as well as on the earlier ones. The bottle has a label upon it with "Directions for using *Hæmatogen*"; and it has also embossed "*Dr. Adolf Hommel's Hæmatogen*." Dr. *Hommel* advertised his goods in England. I have not had a copy of any advertisement put before me, but it is admitted that the advertisements were also under the name of "*Dr. Hommel's Hæmatogen*." Dr. *Hommel*, therefore, did his best to connect his name with the product. The sales have steadily increased, and in the year 1902 it seems to have occurred to a German firm named *Kohr* of Hamburg, and to their agents, the Defendants *Gebrüder Bauer*

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& Co., that they might usefully introduce into this market the cheaper form of "Hæmatogen" manufactured by themselves. This also is manufactured out of bullocks' blood containing the "Hæmoglobin" preparation, or the iron constituent rather, of blood in a more or less pronounced degree and made into a coloured fluid very much as Dr. Hommel's fluid is made, and in June 1902 an order for a sample of this cheaper form of "Hæmatogen" was given to Messrs. Bauer by a firm of chemists named Hedley & Co.

There is some dispute as to what took place at the interview between Mr. Link, who represented Hedley & Co., and the Defendant Mr. Bauer. But I think this at all events is certain, that Hedley & Co. knew perfectly well that what they were going to have, if they ordered the "Hæmatogen" in this instance, was not the Plaintiff's "Hæmatogen," but the "Hæmatogen" manufactured by the firm of Kohr & Co. The way in which the order was carried out was that the case of "Hæmatogen" containing a dozen bottles was invoiced to Hedley & Co. by Kohr in Hamburg free on board at Hamburg. The invoice itself was sent to Hedley & Co. by Bauer, the agent, but Bauer never saw the goods, they being despatched direct from Hamburg to Hedley & Co. Those goods consisted of a dozen bottles of Kohr's manufacture. Each bottle was enclosed in a carton which had on it a label which had on one side on a blue ground printed in white in rather eccentric characters, the word "Hæmatogen" with some German writing above and below. It is enough to say that it was a label, not resembling the Plaintiff's label in the slightest particular—as different as any label containing the word "Hæmatogen" could well be. Now that order was followed by a second which was fulfilled in the same way. In those two cases as I have already observed, beyond transmitting the order to Hamburg and receiving the invoice and transmitting the invoice to Hedley & Co., the purchaser, the Defendant Bauer had nothing to do with the delivery of the goods. In the year 1903 by which time Bauer had ceased to be the agent of Kohr & Co. and was merely acting as a merchant on his own account, he received on the 1st of January an order from a firm named Roberts & Co., chemists, in Bond Street asking him (I am rather amplifying the words) to send by bearer one dozen "Hæmatogen" unstamped. It is agreed on all hands that unstamped meant not having the stamp required for a patent medicine, and therefore that the bottles of "Hæmatogen" sent according to that order could not have been legally disposed of as whole bottles in this country until the stamp had been affixed. Now that order was fulfilled by Mr. Bauer. He first obtained the goods from Kohr & Co., sending to them a letter in which he asked them to "send us promptly a case containing one dozen bottles 'Hæmatogen' 16 per cent."—which, by the way, means 16 per cent. of "Hæmoglobin"—"at your lowest quotation. These are intended for a large wholesale chemist, who states that he could buy large quantities of your 'Hæmatogen' if your goods are absolutely identical with Hommel's product." He obtained the goods from Germany and they sent them with a letter in these terms: "Herewith we have pleasure in handing you the invoice of 12 bottles 'Hæmoglobin' your order of the 1st of January 1903, amounting to 15s. 6d. against which remittance will oblige. As you are no doubt aware the name 'Hæmatogen' is registered in England, and we therefore send you labels separately, without any responsibility on our part. But we guarantee the 'Hæmoglobin' to be equal in quality to the product of Dr. Hommel." He then states what discounts he will give for large quantities and he concludes by saying, "Awaiting the favour of your esteemed orders." Now, if I had to decide whether, assuming that he was not entitled to sell the goods under the name of "Hæmatogen" the Plaintiff was entitled to an injunction, I should have some difficulty with regard to the first two sales, because, according to the authorities, the sale was not by the Defendant at all, but was completed by the delivery by Kohr & Co. the

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foreign manufacturers at Hamburg, and with regard to the sale to Messrs. Roberts. I should also have some difficulty, because it might be that the Defendants thought that as the goods were ordered unstamped were not to be sold as whole bottles in England, but were intended either for dispensing
5 purposes or for export. As at present advised, if I had to decide the point I should come to the conclusion that the Defendants did at that time intend, if they could properly use the word "Hæmatogen" to use it, and I think they did intend to enable Roberts & Co., if so minded, to use the word themselves; and if I had to come to the conclusion that the use of the word "Hæmatogen" was
10 improper, I should have to grant relief against the Defendants. But that is merely my present impression. I did not call upon Mr. Terrell upon it nor did I hear Mr. Norton very fully upon it, because it becomes immaterial, inasmuch as in my opinion, taking the most unfavourable view possible of the facts of the three sales to which I have referred, I do not think there was any passing-off,
15 or attempt to pass-off, the Defendants' goods as the Plaintiff's.

In the first place, there is no similarity of label; in the second place, there is no pretence of saying that the immediate purchaser intended to pass off the goods. He made it as plain as a man could make it plain that the goods which he was selling were not Hommel's. If there was any passing-off at all it must
20 be by putting into the hands of the immediate purchaser the means of deceiving an ultimate purchaser, and the only means of deceiving an ultimate purchaser which could be alleged in this case would be the word "Hæmatogen." In my opinion, it is a question of fact, and the conclusion of fact which I have come to is, that I cannot properly hold that the sale of another drug under the word
25 "Hæmatogen" would of itself lead to the belief that that which was being so sold was Dr. Hommel's "Hæmatogen."

Now, I must inquire a little more closely into the facts relating to this product. Of course it is said (and that is the crucial point in all these cases) that the word "Hæmatogen" has acquired a secondary meaning, and that is
30 really the question I have to decide. But can it properly on the evidence before me be held to mean, a blood-producing medicine, or does it of necessity to people who are dealing in it mean Dr. Hommel's blood-producing medicine. Much reliance has been placed on the fact that various persons in the trade have told me that the word "Hæmatogen" by itself means Dr. Hommel's "Hæmatogen."
35 Of course it does. Up to the present time, there has been no rival "Hæmatogen" in the market, and of necessity therefore the word "Hæmatogen" means Dr. Hommel's. But the word "Hæmatogen," I am told by those who say it means Dr. Hommel's "Hæmatogen," is a descriptive word. It is a word, I think, denoting a blood-producer. Dr. Hommel himself has endeavoured to connect
40 it with his name.

Doctors who prescribe it prescribed it under his name until the last two or three years, when, by its increased use apparently, it has become better known, though some of them—those who have been called as witnesses—have taken
45 occasionally to prescribing it by the name "Hæmatogen" alone, one of them telling me, I think, that he used "Hommel" if he had time and inclination, and when he had not he used the word "Hæmatogen" alone; but there has been no uniform practice; they have sometimes described it as "Hommel's
"Hæmatogen" and sometimes they have described it as "Hæmatogen" alone.

It seems to me that this part of the case raises exactly the point which was
50 dealt with by Lord Davey in the "Cellular Clothing" case. The only difference I can find between the "Cellular Clothing" case and the present case is that the word "Cellular" in that case was probably descriptive amongst a larger number of people than in this present case. But in the present case it is sufficient to say it is descriptive of the medicine with those who have to do with it,
55 because chemists know what it is; they know that it means a blood producer;

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the invalids who are suffering from anæmia have it prescribed for them as a remedy for that disease; and the doctors who prescribe it know that it means a blood former. I will just read a passage or two from Lord Davey's judgment in the House of Lords in the *Cellular Clothing Company v. Marton and Murray* (L.R. (1899) A.C. 326), where he says this after stating the question 5 which he has to decide:—"But there are two observations which must be made; one is that a man who takes upon himself to prove that words, which are merely descriptive or expressive of the quality of the goods, have acquired the secondary sense to which I have referred, assumes a much greater burden —and, indeed, a burden which it is not impossible, but at the same time 10 extremely difficult, to discharge—a much greater burden than that of a man who undertakes to prove the same thing of a word not significant and not descriptive but what has been compendiously called a 'fancy' word. The other observation which occurs to me is this: that where a man produces or invents, if you please, a new article, and attaches a descriptive name to it—a 15 name which, as the article has not been produced before, has, of course, not been used in connection with the article—and secures for himself either the legal monopoly or a monopoly in fact of the sale of the article for a certain time, the evidence of persons who come forward and say that the name in question suggests to their minds and is associated by them with the Plaintiff's goods 20 alone is of a very slender character, for the simple reason that the Plaintiff was the only maker of the goods during the time that his monopoly lasted, and therefore there was nothing to compare with it, and anybody who wanted the goods had no shop to go to, or no merchant or manufacturer to resort to except the Plaintiff. And on this point I adopt what was said in 25 felicitous language by Fry, L.J., in *Siebert v. Findlater* (L.R. 7 Ch. D. 801). That is, my Lords, a matter of express decision in the case of a Patent. If a man invents a new article and protects it by a Patent, then, during the term of the Patent, he has, of course, a legal monopoly; but when the Patent expires all the world may make the article, and if they make the article they may say that they 30 are making the article and for that purpose use the name which the Patentee has attached to it during the time when he had the legal monopoly of the manufacture. But the same thing in principle must apply where a man has not taken out a Patent as in the present case, but has a virtual monopoly because other manufacturers, although they are entitled to do so, have not in fact com- 35 menced to make the article. He brings the article before the world, he gives it a name descriptive of the article: all the world may make the article, all the world may tell the public what article it is they make, and for that purpose they may *prima facie* use the name by which the article is known "in the market." Now, that seems to me to express the principle. It is 40 intended I think to, and it does express a principle, and very nearly every word of that would apply to the present case. The Plaintiff in this case makes an article, he selects for it a name which is avowedly descriptive of it, nobody else makes the article during the time the Plaintiff has been selling it in England, and it is further called amongst persons who deal in it by the name which is descriptive of it; there is no other evidence except that of 45 the name here having acquired a secondary meaning, and it seems to me that unless I am to refuse to adopt the principle laid down for us in the House of Lords by Lord Davey I cannot hold that in this case the word has acquired a secondary meaning. 50

There are one or two authorities that were very much pressed upon me on the Plaintiff's part, in particular the "Stone Ale" case of *Thompson v. Montgomery* (6 R.P.C. 409; L.R. 41 Ch. D. 35), the "Yorkshire Relish" case of *Powell v. Birmingham Vinegar Company* (14 R.P.C. 720; L.R. (1897) A.C. 710), and *Faulder v. Rushton* (20 R.P.C. 55

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477), as well as the more recent case of *Neostyle Manufacturing Company v. Ellam's Duplicator Company* (21 R.P.C. 569), which was merely cited for some remarks made by Lord Justice *Vaughan Williams*. Those cases were mainly relied on by Mr. *Terrell* in answer to a suggestion that the Plaintiff's
5 was even a more unfavourable case than usual in the particular circumstances, because the monopoly which he enjoys has been enjoyed by means of and in consequence of the registration of the Trade Mark. I should like to point out on that part of the case that I think that consideration has some bearing. Really the reputation of this medicine, to judge from the evidence of the
10 doctors, which is the part of the evidence to which I attach the greatest importance, has been acquired since the date of registration of the Trade Mark in the year 1899, and the registration of the Trade Mark has naturally deterred other persons from using the name. We see it in the present case. Messrs. *Kohr* were not sure whether the name had been registered in England,
15 and were not sure whether *Bauer*, therefore, could sell the goods under that name here. *Bauer* himself upon inquiry found that he could not, and accordingly took the steps which I have already described in his dealings with *Roberts & Co.* I think I am quite at liberty to infer that the registration of the Trade Mark has deterred people from selling the article under that name.

20 I think, therefore, that it has some bearing upon the question whether I can rightly hold in this case that the name has obtained a secondary signification. If it has so obtained a secondary signification it has done so by reason of other people having been deterred from selling goods in consequence of the fact that the name was registered as a Trade Mark. In this view of the case neither the
25 "Stone Ale" case, nor the "Yorkshire Relish" case, nor the "Silverpan" case, in each of which the Trade Mark consisting of the name in question had been previously taken off the Register, has any bearing upon this case; because in each of those cases the reputation had been obtained many years before it was thought of registering the mark. In fact the reputation and secondary meaning
30 had nothing to do with the registration of the Trade Mark at all. It seems to me that, therefore, those authorities, except so far as they are authorities for a perfectly indisputable proposition, and one which certainly would not be repudiated by me, namely, that if a word has obtained a secondary meaning it cannot be used without clearly distinguishing the Defendant's goods from those
35 of the Plaintiff, have no bearing on this case.

The conclusion I come to on the facts is that in this case the word "Hæmatogen" has not obtained the secondary meaning which has been alleged: that it means a preparation for forming blood; and that I cannot regard the statements of the doctors and the other skilled witnesses, who alone
40 state that the name means Dr. *Hommel's* product, as sufficient evidence to establish the secondary meaning in face of the remarks of Lord *Davey* and, I may add, of the other noble Lords, in the "Cellular Clothing" case in the House of Lords.

The result is that there will be judgment for the Defendants in the Action,
45 and there must be an Order on the Motion removing the Trade Mark from the Register; and the Defendants in the Action and the Applicants on the Motion must have the costs of the proceedings.

Norton, K.C.—In June last the Defendants gave an undertaking not to continue the sale, and got the usual undertaking as to damages. I do not suppose that
50 they will proceed with an inquiry, but I think I ought to ask for it.

WARRINGTON, J.—I must grant the inquiry, but, if you ask for it, it will be at your own risk.

Terrell, K.C.—I ask your Lordship for a stay of execution and likewise to stay the rectification of the Register. It is often granted in these cases, and
55 it is an important question.

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WARRINGTON, J.—I have been thinking of this, and I was prepared for your application. Supposing I suspend the rectification of the Register, you ought not to be allowed to bring any action against the present Defendants in respect of anything done while the Order is suspended.

Terrell, K.C.—No, certainly not. I will undertake not to bring any action 5
for infringement of the Trade Mark. Of course the other point is another matter.

WARRINGTON, J.—Is there any form of Order suspending rectification?

Terrell, K.C.—A stay was granted by Kekewich, J., in *Harrison v. Woodroffe*, as reported in 7 R.P.C. page 29. It is not an unusual application, and of course 10
if the mark is once removed the damage may be very serious, because, supposing we get it restored, in the meantime it will be known throughout the world that our Trade Mark has been expunged from the Register, whereas allowing the Order to be suspended on the terms suggested cannot do serious damage to anybody. I ask for a stay. 15

Norton, K.C.—I submit that the rectification ought not to be suspended without the Comptroller being heard, because he is bound to represent the public.

Terrell, K.C.—Does Mr. Bauer intend to go on selling "Hæmatogen" in England? 20

The Defendant.—Certainly I do.

WARRINGTON, J.—I think on the whole I shall do less harm by refusing to suspend the Order than by suspending it. I do not mean to say that harm will not be done one way or the other, but I think I shall be doing less harm by refusing to suspend. 25

King & Co., Ltd. v. Gillard & Co., Ltd.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE JOYCE.

December 11th, 1903.

Before MR. JUSTICE KEKEWICH.

5

June 16th, 1904.

KING & CO., LD. v. GILLARD & CO., LD

Action for passing-off.—“Get-up.”—Soup-packets in steel boxes.—Points of resemblance common to the trade.—Injunction refused.—Successful Defendant deprived of costs by reason of false statements as to medals and awards.

- 10 *The Plaintiffs and their predecessors for upwards of fifteen years had made and sold three varieties of a special preparation of dried materials for soup in packets of certain size, shape, and printing, and these packets were put up in steel boxes of a peculiar kind. They claimed that their goods had become and were known and recognised and distinguished from all other prepared soups*
- 15 *by means of their mode of packing and get-up. In 1903 the Defendants, who had been pickle manufacturers for many years, began to make and sell similar preparations of soup which were put up in a series of similar packets and boxes, and their name “Gillard’s” appeared where “Edwards’” appeared on the Plaintiffs’ goods. The wrappers of the Defendants also contained untrue*
- 20 *statements as to medals and awards in the same position as accurate statements of the Plaintiffs.*

Held—(1) that the get-up of the Plaintiffs’ goods was not distinctive of goods of their manufacture; (2) that the Defendants’ goods only resembled the Plaintiffs’ in points common to the trade; (3) that no case of actual deception

25 *had been proved; (4) that the Defendants’ goods were not calculated to deceive even an unwary purchaser. The action was dismissed, but judgment was given for the Defendants without costs by reason of the untrue statements as to medals and awards made on their wrappers.*

Per KEKEWICH, J.—“Deception is not always the deception of the person who

30 *“purchases, not proceeding from his or her mind, but is the deception of the*

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"person who sells; and where you can see that the person who sells has been enabled by the resemblance of the goods to practice deception, that is quite as conclusive as any deception that is really entertained by the mind of the person buying."

The Plaintiffs in this action, *Frederick King & Co., Ltd.*, and their predecessors, were old-established manufacturers of and dealers in provisions, and for upwards of fifteen years had made and sold a special preparation of dried materials for soup, which from the outset they designated "*Edwards' Desiccated Soup*." This preparation had for many years been made up, advertised, and sold in three varieties, viz., brown soup, white soup, and tomato soup, and, except for slight alterations in the colour of the paper covers of the packets of the brown soup, which had been gradually made during the last three or four years, there had not been for at least seven years past any variation in the manner in which the three varieties had been made up and sold in the wholesale and retail markets, whether as to size or shape of packets or boxes, colouring, design or letterpress of coverings or wrappers, or as to any other features. The three varieties were packed in small oblong rectangular packets of uniform size under coloured wrappers, in the cases of the brown soup and the white soup bearing letterpress printed longitudinally on the face, and statements as to prices and directions for use on the back and sides, and in the case of the tomato soup under white wrappers bearing letterpress and ornamentations in green and red, printed vertically on the face, and statements as to prices and directions for use on the back and sides. Each of the packets contained a reference to Exhibition Awards actually gained for the goods. These packets were packed in dozens (in two layers of six each) in steel boxes of a special shape and size which the Plaintiffs alleged that they first designed, and with a peculiar mode of folding the paper cover at the ends. The three varieties were also made up and sold in round tin canisters containing 1 lb., $\frac{1}{2}$ lb., and $\frac{1}{4}$ lb., and even larger quantities.

By their Statement of Claim the Plaintiffs alleged with regard to the sales of their goods as follows:—(10) The popular and more common sale of the said preparation is in the packet form, ordinary retail customers usually buying one or at most a few of the packets at a time. The boxes of packets are commonly displayed opened in the windows or on the counters of the retail shops, so that the packets themselves are exposed to view, and it is an ordinary practice for the packets themselves to be taken out of the boxes by the shopman and placed on trays or in any convenient box or basket from which the customer can take and does in fact take what is required. A large proportion of the retail shop trade is done under artificial light when the differences in colours are not readily discerned. (11) The Plaintiffs' said goods have become and are known and recognised and distinguished from all other prepared soups by means of the said mode of packing and get up, and they have attained a high reputation in association therewith. The business in the said goods is of great value to the Plaintiffs who have expended very large sums in advertising and developing the same."

The Defendants, *Gillard & Co., Ltd.*, were sauce and pickle manufacturers, who, in September 1903, began to manufacture and introduced upon the market a dried soup preparation in the same three varieties of brown soup, white soup, and tomato soup, retailed at the same prices, but sold wholesale at a larger discount. The sizes, quantities, and mode of packing in steel boxes were identical with those of the Plaintiffs. The wrappers of the separate packets corresponded closely in the range of the three varieties with the corresponding preparations of the Plaintiffs, including the longitudinal and vertical printing, but the colourings were not the same, and the name "*Gillard's*" appeared instead of the name "*Edwards*" in clear letters in front of the words

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"Desiccated Soup." The Defendants' wrappers included reference to Exhibition Awards purporting to be, but not in fact, gained by the Defendants for their soup preparations. The paper wrappers of the steel boxes were folded in the same way, and in the case of the white soup were closely similar to those of the Plaintiffs'.

On the 21st of November 1903 the Plaintiffs commenced the action for an injunction to restrain the Defendants "from selling, offering for sale, or advertising any dried soup preparation or similar goods of their manufacture in packets, boxes, tins, or canisters, so printed, lettered, coloured, labelled, or otherwise prepared or got up, or by colourable imitation of the Plaintiffs' packets, boxes, tins, canisters, or otherwise as to be calculated to represent or lead to the belief that the goods therein contained are the Plaintiffs' goods, or in any manner passing off, or enabling or assisting others to pass off, any dried soup preparation or similar goods not of the Plaintiffs' manufacture as or for the Plaintiffs' goods," and for consequential relief.

On the 11th of December 1903, the Plaintiffs moved before Mr. Justice JOYCE for an interlocutory injunction. After argument,

JOYCE, J.—I think the Defendants have distinctly and obviously copied their labels in certain respects, and it strikes me that there is a good deal of probability of deception. I cannot understand why respectable people do this sort of thing. But the Defendants will keep an account till the trial, and the motion will then stand over, with liberty to apply to expedite the trial.

The action came on for trial before Mr. Justice KEKEWICH on the 16th of June 1904.

Stewart Smith, K.C., and Waggett (instructed by Neish, Howell and Haldane) appeared for the Plaintiffs; Lewis Edmunds, K.C., and Vernon (instructed by H. W. Christmas), appeared for the Defendants.

Stewart Smith, K.C., opened the Plaintiffs' case, and pointed out that neither "common get up" nor "common user" were pleaded by the Defendants. He contended that the Plaintiffs were entitled to relief on two grounds, viz.:—(1) evidence of intention to deceive to be inferred from the get-up of the goods, and (2) insufficient distinction between the goods.

The evidence was then taken. For the Plaintiffs the following witnesses were examined:—John McDowell, manager in Ireland and secretary of the Plaintiff Company, and Robinson Geeson, London manager of the Plaintiff Company; the following retail dealers—J. E. Morton, Greenwich; C. C. Streatfield, Maidstone; A. Edwards, Highbury; H. Shaw, Hackney; and H. Curson, Bush Hill Park; and the following customers—E. B. Bell; Mrs. Ada Wackett; Mrs. Elizabeth Westlake; Mrs. Mary Sweeney; and Mrs. Lena Allan. The Plaintiffs had more witnesses ready to give evidence to the same effect, but it was agreed that the evidence offered could be multiplied indefinitely. At the close of the Plaintiffs' evidence, the Defendants tendered the evidence of witnesses who had sold both kinds of soups but had known no case of confusion.

KEKEWICH, J.—I do not require it. The Plaintiffs have not proved a single case of actual deception; if there had been one, it would probably have been sufficient.

For the Defendants only two witnesses were called, viz., S. W. Gillard, managing director of the Defendant Company; and F. W. Feaver, of Feaver & Co., tinware makers.

Stewart Smith, K.C., for the Plaintiffs.—The evidence establishes that the Plaintiffs' goods are known and distinguished from all other goods of the same kind by the mode of their get-up, and that there is such a close resemblance in the Defendants' goods as to induce deception. It is well established that in cases of this kind the Court will consider all the surrounding circumstances of the sale of the goods (*Thompson v. Montgomery* ("Stone Ales"), 8 R.P.C. 361; L.R. (1891), A.C. 217; *Seizo v. Provezende*, L.R., 1 Ch. 192). The particulars of the

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get-up, including the identity of the termination of the two names, "ards," even if accidental, are such as to be calculated to deceive a purchaser buying with ordinary caution, and a less severe test of standard of caution is to be applied where the commodity is one purchased frequently and rapidly by uninstructed people. The actual deception in this case is like that proved in *Lever v. Goodwin* (4 R.P.C. 492; L.R. 36 Ch. D. 1; affirmed in 4 R.P.C. 504; L.R. 36 Ch. D. 3). In any event the false statements on the Defendants' goods as to medals and awards will be taken into account by the Court.

Counsel for the Defendants were not called upon.

KEKEWICH, J.—This is one of the numerous cases which frequently come before the Court in which there is no really defined principle because the circumstances of each case differ so much from every other. But it seems to me there are to be found in the authorities some guiding rules which, expressed at the time in different language, do not I think vary in substance. I propose to read a short passage from the judgment of Lord Lindley, who was then Master of the Rolls, in *Payton v. Snelling* (17 R.P.C. 48), a case about coffee tins in which I myself was induced to go wrong by not only the strong resemblance of the coffee tins of the Plaintiffs and the Defendants, but also by what I considered the manifest intention of the Defendants to sail as near the wind as possible, and, if they could, to induce persons to buy their goods as the goods of the Plaintiffs. I say that was a case in which I myself was induced to go wrong, although *Payton v. Snelling* was not before me, but before Mr. Justice Byrne, but *Payton v. Titus Ward* was before me, and Mr. Justice Byrne and I came, with very similar facts before us, to the same conclusion. Then both cases were appealed, and in both cases the appeal was allowed, but in Mr. Justice Byrne's case only was there a further appeal to the House of Lords.

On page 52, Lord Lindley said this: "After all said and done, what have we to consider? What is it that the Plaintiffs must make out in order to entitle them to succeed in this action? They must make out that the Defendants' goods are calculated to be mistaken for the Plaintiffs', and where, as in this case, the goods of the Plaintiff and the goods of the Defendant unquestionably resemble each other, but where the features in which they resemble each other are common to the trade, what has the Plaintiff to make out? He must make out not that the Defendant's are like his by reason of those features which are common to them and other people, but he must make out that the Defendant's are like his by reason of something peculiar to him, and by reason of the Defendant having adopted some mark, or device, or label, or something of that kind, which distinguishes the Plaintiff's from other goods which have like his, the features common to the trade. Unless the Plaintiff can bring his case up to that he fails." These remarks of course were made with special reference to the case before him—the case of the resemblance of coffee tins. But I have been again reminded of that case during the progress of this, because, really—except that there I was dealing with tins, and the contents were coffee and here I am dealing with desiccated soup contained in paper wrappers—the two cases really run very much upon the same lines. There is one observation in the same case which I quote from the Report in the House of Lords of a more general character and of less immediate application to the case then before the House, although of course it was made with reference to that case, which I think it is desirable that I should bear in mind. That case in the House of Lords is reported in 17 R.P.C. at page 628. Nothing was said, so far as I been able to find, and I have not read the case for the first time this morning, about the observations of the Master of the Rolls, either by way of approval or disapproval, but the appeal was treated as a hopeless one—Counsel for the Respondents were not called on, and I think it is a fair inference from the way in which the case was dealt with, that generally speaking the House agreed

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with what was laid down by the Court of Appeal, including the Master of the Rolls. Lord *Macnaghten*, on page 634, said this :—" Now when a person comes forward to restrain a colourable imitation of this sort in a case like this, and when he cannot prove that the Defendants have tried to steal his trade, he
 5 "has to make out beyond all question that the goods are so got up as to be calculated to deceive. The principle is perfectly clear—no man is entitled to sell his goods as the goods of another person. The difficulty lies in the application, and when it is a case of colourable imitation I think it is very desirable to bear in mind what Lord *Cranworth* said on one occasion—that 'no
 10 "general rule can be laid down as to what is a colourable imitation or not. 'You must deal with each case as it arises and have regard to the circumstances 'of the particular case.'"

I start with these guiding rules before me, and the first thing to which my attention is called is the allegation in paragraph 11 of the Statement
 15 of Claim. "The Plaintiffs' said goods have become and are known and recognised and distinguished from all other prepared soups by means of the said mode of packing and get-up, and they have attained a high reputation in 'association therewith.' It is contended on behalf of the Plaintiffs that they have established that proposition. I do not agree. I do not think there is any
 20 real proof that the Plaintiffs' goods have been recognised and distinguished from all other prepared soups by means of the said mode of packing. They have been known to some extent by their mode of packing—that is to say, when no other soup of this kind was on the market, or was sold by those persons who deal in the Plaintiffs' soup. Then the peculiar mode of packing,
 25 the colour, the white ends of the packets, and the other small features which are dwelt upon as being distinguishing had been recognised by those who from time to time had purchased the Plaintiffs' goods. But not only have they not established, but I think there is no evidence before me, that there has been any distinction of the Plaintiffs' goods from all other goods either by mode of
 30 packing or get-up, or by anything of the kind.

I have then to consider how far the Defendants' goods are calculated to deceive. I find (not by any means for the first time) that the Defendants, being minded to put desiccated soup on the market, and therefore to compete with the Plaintiffs in their trade, which seems to be a successful one, have
 35 thought it right to sail as near the wind as possible ; to pack their goods in tin boxes of precisely the same size and shape that is used by the Plaintiffs, to make parcels of precisely the same size and shape, to fasten up those parcels in precisely the same manner ; and in fact with the intention that there shall be, if possible, a confusion between the two, in this sense that it shall be difficult to
 40 distinguish between the one and the other, but yet to escape anything like a really colourable imitation. That is to say they trust, and probably trust with wisdom, to the folly of the purchaser, who they suppose will not buy desiccated soup unless it is contained in packets like those used by the Plaintiffs who have got a large trade, and unless those packets are packed in the same manner, and
 45 in the same sort of tins. To an outsider that seems an excess of folly, to an outsider it might reasonably occur if he wanted to put a new article on the market the first thing would be to avoid any resemblance to that which is already on the market. Of course the Defendants intend to make and sell a very far superior soup to that which is manufactured and sold by the Plaintiffs.
 50 An outsider might say : " Well, the first thing to do is to call attention to the difference. If the goods already on the market are in square tins, by all means let us have oblong or round tins ; if they are in packets of a certain shape let us have another shape," and so forth. That is, I think, the common sense view that an outsider would take ; but it is not the view of the trade. In
 55 all these cases, as in the coffee tin case, so here, the great desire is to put on the market something, as nearly as possible, resembling that which is already

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there. It must be good business because I observe it is done again and again. I have nothing to do with that, nor have I to do with questions of good taste, and on that I make no observation. But the question is whether really so long as they avoid confusion—so long as they really avoid calculation to deceive—traders are not entitled to do what may be a matter of good taste or 5 not, but which they consider to be good business.

In taking these packets together and applying Lord *Lindley's* rule, it seems to me there is no question whatever as to being calculated to deceive. Their resemblance is entirely and solely in those particulars which are common to the trade in the sense of being open to the trade—not being appropriated to one 10 particular manufacturer and not only common to these two persons, but no doubt to many others. I have had some general evidence on that point. There really is nothing here to show that these packets are like one another except in those matters which are, as I say, common to the trade. Whether the packets are yellow, or blue, or brown in colour is perfectly immaterial; whether they 15 have white ends or not is perfectly immaterial; anybody may have packets of those colours, and they may have white ends. Even when they are turned, as I hear they are sometimes, face downwards, there is a distinction, and I need not dwell upon that. When you turn them face upwards to be looked at, one is “*Edwards' Desiccated Soup (Brown) Registered. Frederick King & Co., Ltd.,* 20 “*Sole Manufacturers.*” The other is “*Gillard's Improved Desiccated Soup. Sole makers Gillard & Co., Ltd., Purveyors by Appointment to His Royal Highness the Prince of Wales.*” There is really no resemblance at all in that sense. Now I must guard myself against being supposed to attribute exclusive weight to the name. The name is a matter of very great importance 25 and much weight must be attributed to it, but again and again one has learnt, and there are cases in the books which teach the lesson, that you must not rely only on the name if there are other circumstances which are calculated to deceive.

Here I find the name distinct and I do not find any other circumstances 30 calculated to deceive except such as are necessarily common to the trade. I have compared the orange of the Defendants with the red of the Plaintiffs. There is apparently at first sight a little more resemblance in the tomato soup packets, but there the colour, upon which it would be foolish to dwell, is slightly different; a very cursory observation, however, shows you that there is 35 also there a distinction in matters of importance, and only resemblance in matters common to the trade. Not only have you the name perfectly clear but there is on the Plaintiffs' packet a large figure of a tomato most prominent, whereas on the other there is a Prince of Wales feather in the centre, and there is a sort of garnishing of tomatoes in small type. It seems to me that looking at it with 40 my own eyes, and judging from my own experience of what is calculated to deceive, and what is not, there is no room for a second opinion about it; there is nothing there which ought to induce even an unwary purchaser—certainly not a purchaser of ordinary intelligence—to think that in taking one from the counter he was really taking the other. 45

But then I am met with this, that it is said there is actual deception. Now if I had one proved case of actual deception I should be strongly disposed to abandon my own opinion and to say that my eyes have failed me, that such knowledge as I have of the world is amiss; and that where one person had been deceived another person might very well be deceived, and that the 50 Defendants must be responsible for the possibility of deception. And if instead of the one case I had two or three of the same kind, I should without hesitation conclude in that direction. But I have no case of actual deception at all. What has happened is this: persons (they are all the same, and it is agreed that the evidence might be multiplied indefinitely) accustomed to buy 55 *Edwards' Desiccated Soup*, and knowing no other, call at the shop at which

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they are accustomed to buy it and ask for "a packet of desiccated soup," and are given, or take up from the counter a packet of desiccated soup. Such a person puts it in his pocket, he knows it is the same sort of packet—the same size; it feels the same and he pays no attention to it whatever and goes away
5 content.

It is extremely important to stop there to consider whether there is any deception at that point, because deception is not always the deception of the person who purchases, not proceeding from his or her mind, but is the deception of the person who sells; and where you can see that the person who sells has
10 been enabled by the resemblance of the goods to practice deception, that is quite as conclusive as any deception that is really entertained by the mind of the person buying. If I thought that I had any evidence here of a tradesman or an assistant having been enabled to practice deception, that would be as useful, if not more useful, than evidence to show that persons had been
15 deceived. The two run, of course, together, but the power of deceiving has been dwelt upon in many cases as exceedingly valuable evidence in a case of this kind.

I think there is one case in which Lord *Lindley* (I believe) used the term "fraudulent dress"—if the goods are dressed up so that a person can pass off
20 one instead of the other, there you get at once distinct evidence of fraud upon which you can act. In this case there is nothing of the kind. The shopmen were asked for desiccated soup. As one gentleman told us, if it were an old customer and the customer had been in the habit of coming in again and again for *Edwards'* Desiccated Soup and knew no other, he would give that person
25 *Edwards'* Desiccated Soup, not because he had been asked for it in so many words, but because he would know that the particular customer wanted *Edwards'* Desiccated Soup—that which he had been accustomed to receive when asking before for "desiccated soup." But when an ordinary customer simply puts down a penny and asks for a penny packet of desiccated soup there
30 is nothing wrong in the shopman handing him *Gillard's*, or any other desiccated soup. And that is what has happened: the customers went away quite content, believing they had got what they wanted. In almost all cases the ladies went away and put the packets in their pockets and then had their attention called afterwards to the fact that they had not got *Edwards'*. One lady wanted
35 to have *Edwards'*, she did not know *Gillard's*, and she did not want to have *Gillard's*, and therefore she went back and asked for an exchange which was effected; but there was no deception—she never supposed at any moment that *Gillard's* was *Edwards'*, she supposed that what she had got was *Edwards'*, and that is entirely a different matter. There was no deception on the part of the
40 shopman, and the lady herself was not deceived. I do not think it is possible to deceive any person of ordinary intelligence who took the pains to use their eyes to see that she got the article she intended to buy and which she had been accustomed to buy.

There was one gentleman who went upon the colour and tried to make out a
45 little stronger case, but unfortunately for him it turned out he was colour blind, and therefore that altogether broke down.

The result is, taking the broad view appealing to my own eyes, there is no case made out here; the evidence has made no case, and the Plaintiffs fail in my opinion to establish what they came here to establish, and the result is that there
50 will be judgment for the Defendants.

Now I come to the question of costs, and upon that I think I am bound to make some strong observations. On a packet of *Gillard's* Desiccated Soup I find printed "Highest Award at the Coolgardie Exhibition, Western Australia, 1902," and again "Highest Award at another Exhibition," and "10 Gold Medals
55 "awarded." The Defendants only started this business last September, and the Coolgardie Exhibition was long before that. They never had these

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Awards and it is untrue. The answer made is: "It is customary to put
 "upon any goods sold by a firm notice of the awards which they have received
 "in the shape of prizes in respect of other goods." Custom of course in the
 legal sense there cannot be. I suppose it is meant that it is usual to do that,
 and I am extremely sorry to hear that it is usual to be dishonest, for this is dis- 5
 honest. There can be no possible object in putting this statement on goods of
 this kind, except to induce the purchaser to believe that these Awards have
 been granted for these particular goods, and, therefore, to enhance the value in
 the purchaser's eyes, and it is intended to be used of course as an advertisement.
 That seems to me distinct dishonesty, which the Court ought to reprobate. 10
 Therefore, in giving judgment for the Defendants I shall give it without costs.

IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, and COZENS-HARDY.

June 22nd, 1904.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

15

Before MR. JUSTICE WARRINGTON.

July 1st, 1904.

E. M. BOWDEN'S PATENTS SYNDICATE, LD. *v.* HERBERT SMITH & CO.

*Patent.—Action for infringement.—Legal owner of Patent at the date of
 commencement of action held at the trial not to be before the Court and to be a 20
 necessary party.—Leave to amend applied for and Order made giving leave
 to the Plaintiffs.—Appeal by Plaintiffs from decision as to parties dismissed.—
 Application to Judge to vary Order dismissed.*

This was an action for infringement of a Patent, which came on for trial
 before Mr. Justice Warrington on the 4th and 5th of May 1904. The pro- 25
 ceedings at the trial are reported *ante*, page 438. An objection was taken to
 the Plaintiffs' title to maintain the action, they being at the date of the writ
 only the equitable owners of the Patent, and the legal owners at the date of the
 writ not being before the Court. For the Plaintiffs it was contended that the

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Plaintiffs could maintain the action, but, if not, leave to amend was asked for. The learned Judge held that the Plaintiffs could not maintain the action alone, and that the legal personal representatives of *E. M. Bowden*, the former legal owner, who was dead, must be added as parties, and that the case must stand
5 over that they might be added, and that the Plaintiffs should be allowed to amend upon terms as to costs.

The Order which was drawn up was, subject to provisions as to costs, as follows:—"This Court doth Order that the Plaintiffs be at liberty to amend
10 "their writ in this action and Statement of Claim by adding the legal personal "representatives of *E. M. Bowden*, deceased, as Plaintiffs or otherwise in "relation thereto as they may be advised, and that the Defendants be at liberty "to amend their Statement of Defence and Particulars of Objections as they "may be advised."

The Plaintiffs gave notice of appeal from this Order. On the hearing of the
15 appeal,

Moulton, K.C., *T. Terrell*, K.C., and *E. F. Lever* (instructed by *A. Withers*) appeared for the Plaintiffs; *A. J. Walter* and *Sinclair* (instructed by *Phillips and Boyle*) appeared for the Defendants.

It was contended for the Appellants that there was a mistake in the form of
20 the Order, as it was intended that the Plaintiffs should be in a position to appeal on the question of parties.

The Court intimated that, even assuming that was the intention, the Order had not been so drawn up as to give effect to it. The action would have to go
25 back for trial to Mr. Justice *Warrington*, and when it came before him, if there had been any slip, an application could be made to him to put it right. The appeal was dismissed.

On the 1st of July 1904, *T. Terrell*, K.C., for the Plaintiffs, applied to Mr. Justice WARRINGTON to dismiss the action and to vary the Order accordingly. He stated that there was a great difficulty about amending, and that it was
30 never meant that there should be a judgment against the Plaintiffs from which they could not appeal.

WARRINGTON, *J.*—There is no judgment against the Plaintiffs. The Order is in their favour giving them leave to amend.

Terrell, K.C.—Really what I asked for was leave to amend conditionally.

35 WARRINGTON, *J.*—If you did not wish to amend you might have interposed before the Order was drawn up. You might have come to me and asked for the Order to be drawn up differently.

Terrell, K.C.—I come now with a Motion asking your Lordship to vary the Order.

40 WARRINGTON, *J.*—I cannot do that. The Order is drawn up. The Motion is misconceived and must be dismissed with costs.

*Imperial Tobacco Company (of Great Britain and Ireland), Ltd. v.
Purnell & Co.*

IN THE COURT OF APPEAL.

*Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, and
COZENS-HARDY.*

July 8th and 11th, 1904.

IMPERIAL TOBACCO COMPANY (OF GREAT BRITAIN AND IRELAND), LD. v. 5
PURNELL & CO.

Passing-off.—“Get-up.”—Narrow red band round cigars.—Common to the trade.—Name of brand.—Fraud neither alleged nor proved.—Judgment for Defendants at trial.—Appeal dismissed with costs.

The predecessors of the Plaintiffs, who were cigar manufacturers, in 1888 10 commenced to sell cigars under the name “Marcella,” having round them a narrow band of red paper five thirty-seconds of an inch in width, with the name of the brand printed thereon in white. They contended that these cigars were so well known and so much asked for as “narrow red band” cigars, as to entitle them to an injunction restraining the sale by the Defendant 15 of cigars bearing similar bands three-sixteenths of an inch in width, and sold under the name “Purnella.” The Defendant alleged that he had sold “Purnella” cigars since 1882 in large quantities, and other cigars bearing similar bands since 1878, but produced no documentary evidence of orders for or sales of “Purnella” cigars with a narrow red band prior to 1901, when the Plaintiffs 20 first knew of his cigars. Evidence was also given of other long uses of cigar-bands of practically the same width and style. It was held at the trial—(1) that a plain red band for cigars of whatever width was common and open to the trade; (2) that the Defendant’s red band was sufficiently distinguished from all other red bands by the name “Purnella”; and (3) that even if the Plaintiffs 25 had used a narrow red band to a greater extent than any other manufacturer, that gave them no exclusive right thereto, and the action was dismissed with costs. The Plaintiffs appealed.

Held, by the Court of Appeal, that the Plaintiffs had not established an exclusive right to a narrow red band, and that upon the evidence as a whole 30 the Plaintiffs had failed to satisfy the Court that what the Defendant was doing was calculated or intended to deceive. The appeal was dismissed with costs.

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Purnell & Co.*

The Plaintiffs, the *Imperial Tobacco Company (of Great Britain and Ireland), Ltd.*, carried on in London and in many other places a large business as manufacturers and vendors of tobacco and cigars. They carried it on in succession to several firms whose business, goodwill, trade marks, and trade names were vested in them. Among these firms was a firm trading under the style or firm name of *Allen Brothers*, who about 1888, adopted the title of "Marcella" as the name of a new brand of cigars which they put upon the market with a narrow band of red paper about five thirty-seconds of an inch in width encircling each cigar, and carrying the name "Marcella."

10 The sales of these cigars rapidly increased, and the average quantity sold in each month of the year prior to the trial was over one million. By reason of the distinctiveness of the band, the Plaintiffs alleged that soon after their introduction on the market, and continuously since, the cigars were commonly asked for, and ordered, and spoken of by the names "Narrow Red Band Cigars,"

15 "Little Red Band Cigars," "Red Banders," "Narrow Red Banders," and similar names referring to the "Red Band" or "Narrow Red Band," and that any one who asked for or ordered cigars by any such name intended and expected to receive the Plaintiff Company's "Marcella" cigars, and no others.

In their Statement of Claim, the Plaintiffs alleged "that it was in 1901 that

20 "they were informed that *John Purnell*, who carried on business as a wholesale cigar merchant at Shoreham, in Sussex, and whom they now sued as *Purnell and Co.*, was selling cigars bearing narrow red bands similar to their own, but "with the word 'Purnella' instead of the word 'Marcella.'" They then communicated with the Defendants, but, receiving no reply, and being unable

25 to meet with any such cigars, concluded that they had been misinformed. In November, 1902, they renewed their investigations, and in January, 1903, discovered such cigars of the Defendants on sale in the South of England at a price cheaper than that of the Plaintiffs' cigars. They thereupon issued the writ in this action.

30 By their Defence the Defendants denied that the Marcella cigars were spoken of by the names in question except for the purposes of trap orders; they alleged that various other cigar makers had used similar narrow red bands, and said that they had not replied to the letters received from the Plaintiffs prior to these proceedings because they regarded them as idle threats

35 (1) in view of the long user of their own narrow red bands, and (2) the common use in the trade.

The action was tried before Mr. Justice *Joyce*.

For the Plaintiffs, evidence was given by *E. J. Lambert*, manager of the "Lambert & Butler" branch of the Plaintiff Company, who described the origin

40 of and trade in the cigars in question. A number of trade witnesses, including *F. Gage*, Swansea; *Jesse Saxby*, Kilburn; *T. S. Bowles*, Cardiff; *A. Jackman*, Glasgow; *H. W. Styles*, Brighton; *V. A. Stewart*, Southend-on-Sea; *A. F. May*, Ryde; *J. H. Thompson*, Brighton; *W. Dickinson*, Manchester; *J. P. Burns*, Glasgow; *D. W. Anderson*, Glasgow; *W. R. Rowland*, Redhill; *T. C. Dolan*, Liverpool; *A. Hughes*, Reading; *W. J. Lovett*, Birmingham; *F. Knight*, West Bromwich; *G. Towell*, Exeter; *H. Brabeer*, Portsmouth; *J. R. Miller*, Reigate; and *N. S. Harvey*, Portsea, gave evidence to the effect that for a period going

45 back thirteen years they had heard the term "narrow red band" applied very frequently to "Marcella" cigars, and had not ever heard it applied to any other

50 cigar. A number of customers gave similar evidence, including a carpenter who smoked "two or three shillings worth a week and knew them as often as "narrow red band cigars" as 'Marcellas,' " and a frequent smoker who said it was six months before he noticed the name "Marcella" on the band. [*JOYCE, J.*—Nobody smokes a cigar without looking at the band!—*Neville, K.C.*—Well,

55 my lord, I positively deny that, because I have smoked many cigars and always

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take the band off.] *H. J. Walsh*, a secretary to the Plaintiff Company, deposed as to being handed "Purnella" cigars in response to orders in January 1904 for "narrow red band cigars" at several hotels, including the "Crown Inn," at Portslade, kept by one *Greenyer*, who, as he alleged, said, "They are cheap, but a lot of people think they are 'Marcellas'."

On behalf of the Defendants, a body of evidence was given to the effect that the term "narrow red band" did not exclusively denote the Plaintiffs' cigars, and that a number of different brands of cigars bearing narrow red bands of practically the same width had been on the market for many years, *e.g.*, "Cuba House," "Prince Imperial," "Hayward's Special," "Sherwood Rangers," "Flor Fina," and others. This evidence was given by *T. J. Fletcher* and *A. H. Dexter*, both of Nottingham; *A. H. Callow*, Leicester; *C. Tyler*, Sheffield and Nottingham; *A. Bottomley*, Halifax; *G. J. Freeman*, Hoxton; *C. M. Smeaton* and *F. Woolf*, traveller and secretary to *Robinson & Barnsdale, Ltd.*, Nottingham; *A. J. Temple*, Hammersmith; *D. Lyon*, of Stepney, who had manufactured "Purnella" cigars for the Defendants for the last four years, for three of which he had put the narrow red bands upon them; *W. H. Newman*, London; *J. Moore*, of the *Tobacconists' Supply Syndicate*, London; *W. Thorpe*, London, and others. *G. Greenyer*, landlord of "The Crown Inn," Portslade, denied making the above-mentioned remarks imputed to him, and said that his words were: "I do not know; they might look a little like them ('Marcellas'), but they are not the same price." The Defendant *John Purnell* deposed that in 1878 he had sold cigars called "La Nettie," afterwards "La Nellie," bearing narrow red bands with those names in white letters upon them; that, although his books did not show sales of "Purnellas" earlier than 1894, he had in fact sold them from 1882 or 1883, and at an average of 30,000 a year for the last 10 years; and that he had never heard of the Plaintiffs' "Marcella" cigars before 1897.

Mr. Justice *Joyce* dismissed the action with costs, on the grounds that a plain red band was common to the trade, that the name "Purnella" sufficiently distinguished the Defendant's goods, and that the Plaintiffs had no exclusive right to a narrow red band for cigars.*

The Plaintiffs appealed, and on the hearing of the appeal, *Neville, K.C.*, *Astbury, K.C.*, *Eldon Bankes, K.C.*, and *Sebastian* (instructed by *McKenna & Co.*), appeared for the Appellants; and *Walter* and *St. John Morrow* (instructed by *C. Urquhart Fisher*) appeared for the Respondents.

Neville, K.C., for the Appellants.—The evidence is overwhelming that the expressions "little red band" and "narrow red band" denote the Plaintiffs' goods in the market, even if not to the trade. [VAUGHAN WILLIAMS, *L.J.*—Do people register Trade Marks nowadays? It seems to me that people might as well not register.] Registration is very important at the outset as equivalent to user; but the rights resulting from reputation, apart from registration, are as vigorous as ever. The old law has in that respect been left untouched. [VAUGHAN WILLIAMS, *L.J.*—Can you produce a written order for anything but "Marcella" cigars?] No; but in the retail trade such goods are not asked for by written orders. Many of our witnesses testify that the cigars are more frequently asked for as "little red banders" than as "Marcellas" in many parts of the country, and that no other cigar is known as the "little red bander." The evidence of the Defendant, *Purnell*, is full of contradictions; *e.g.*, he asserts without corroboration that his cigars have enjoyed a user of 20 years; but we believe and allege that even if he sold other cigars such as "Purnell Conchas" during that period, he never sold a "Purnella" cigar with that

* *Ante*, p. 368.

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word in white letters on a narrow red band in his life until 1901. [VAUGHAN WILLIAMS, *L.J.*—I will not say more than that on paper he seems to be a very bad witness, but can you persuade us, who have not seen him, to overrule the decision of Mr. Justice *Joyce* who has? Can you show us anything like the
5 damaging letter produced in *Reddaway v. Banham*?] No; but I submit that in that case it did not matter how dishonest the Defendant was; it was the general facts which damned his case. What we submit is that Mr. Justice *Joyce* underrated the importance of seeing that the evidence of such a witness requires to be most carefully scrutinised. The fact remains that there is no
10 evidence proving any order for or delivery of his narrow red band "Purnella" cigars until 1901.

Counsel for the Respondents were not called on.

VAUGHAN WILLIAMS, *L.J.*—Speaking generally, in a passing-off case, the very first thing you have to prove is—that some name, or some get-up, or some
15 symbol, has come, in the trade, to be identified with the goods manufactured or sold by a particular firm; and generally, unless you can prove that as against the whole world, your case breaks down altogether. In proving that it is not necessary to prove a wilful intention to deceive; and indeed it is sufficient, in a case where this secondary meaning of the word, or the dis-
20 tinctive mark, has been established, and also that the attention of the Defendant has been called to the fact that the goods which are sold by him are likely to deceive people into believing that they are the goods of the other person, to prove that the Defendant persists in going on and taking a course which he knows is calculated to deceive. In either case there is really deceit;
25 in the one case there is deceit in the initiation of the practice; in the other case, there is deceit in the continuation of the practice.

With regard to this part of the case, I have for a long time thought that really the Plaintiffs were not making out a good case. The Plaintiffs were placed in a very difficult position for making out their case. They had a name for
30 their cigars "Marcella." They advertised this name all over the world, and they, in a newspaper advertisement which I have before me, and in a great many others, called attention to the fact that the distinctive mark of their cigars was the word "Marcella." They put at the bottom of the advertisement, "Insist on the 'Marcella' brand of cigars." Under these circumstances it
35 was peculiarly difficult for them to make out that this thin red band had become recognised by the public as identical with "Marcella" cigars and none other. In addition to that, they were in the difficulty that undoubtedly in the case of *Fletcher Brothers* there had been cigars which had been sold for twenty years—or, it was said twenty years was an exaggeration, perhaps
40 it was fifteen years—which were bound, each cigar, with a thin red band with "Cuba House" in white letters upon it, which is singularly like the red band which is put round the "Marcella" cigars. Not only had the Plaintiffs got that difficulty, but they had also got this difficulty, that if you took the witnesses, whether trade witnesses or customers coming in to buy
45 cigars for their own smoking, the evidence was not at all conclusive. So far as the trade was concerned, they undoubtedly knew the cigar as the "Marcella" cigar, and ordered it as the "Marcella" cigar, and not a scrap of what I may call trade evidence has been produced which denoted this cigar in any other way. Then, when you come to customers from the
50 public, all the witnesses who were called, said that they came in, having smoked one of these cigars, to get another at the same place, and said "I want another of those cigars with the thin red band round it, like I had the other night." Then, when they got to know the cigars better, they learnt, I suppose, that the name was "Marcella," and they asked for the
55 "Marcella" cigar.

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Under these circumstances I think that, thus far, the case of the Plaintiffs was not satisfactorily proved; but I wish to point out that it is possible that they might, as against the Defendant, prove a case of actual deceit, and might prove out of his own mouth that he, at all events, recognised the red band as being something indicative of the cigar, and that he put the red band on his own cigars in order that he might deceive. It seems to me that such a case might be proved, and that if it was proved, the Plaintiffs might succeed, although they broke down in proving the secondary meaning attached to the red band by the public. I thought that Mr. *Neville* was going, perhaps, to prove a case of that sort. There can be no doubt here that the Defendant sought to meet the Plaintiffs' case by setting up a case of his own. Mr. Justice *Joyce* had the witnesses before him, and, however great may be the theoretical right and duty of the Court of Appeal to decide for themselves on the evidence, the well established rule is, that where there is a question of personal credibility, the Court ought to hesitate a long time before it goes against the conclusion of the Judge who saw the witnesses and their demeanour, and who heard the evidence in the case.

But there is one remarkable feature about this case, as to which I should like to say a word. The Defendant here has set up a case which, in the ordinary course of business, could have very well been proved by what I may call the primary commercial evidence for proving a commercial fact. Now this Defendant did not adopt that course. He did not produce his books to the full. He produced some, but he did not produce other books which he had himself distinctly stated would exhibit evidence supporting his case. He excused himself for not bringing forward the usual set of books which one would expect in the case of a business man, by saying that a good many of his books had, at some time or other, been destroyed, and were not forthcoming. But most of the facts that he had to prove were facts that he could prove perfectly well if he had chosen, by calling people with whom he dealt, who presumably had not lost their books. His story was that for a long period of time he had been using this red line to distinguish a cigar which he called the "Purnella." Of course, the fact that, for some length of time, he had been selling a cigar under the name of "Purnella," is more or less evidenced by his books, and was not a very important question in the case; but whether he had been using this red band to distinguish those cigars was a very important feature in the counter-story that he was setting up. If he had bought the cigars, and put the red band round them, that might have been proved by calling evidence to prove strictly the purchase by him of these cigars, the date of the purchase, and the quantity, and by general evidence of the fact; but he called some witnesses, like a Managing Director of the name of *Dexter*, who knew nothing really of his own knowledge. Some witnesses like that were called, but no witness who, at first hand, could prove, as a commercial fact can and ought ordinarily to be proved, the purchase and sale of cigars with the red band already on, or the purchase and sale of the red bands for the purpose of putting on. Under these circumstances I should have thought myself that it would have been much more satisfactory to have adjourned the case for the production of evidence of that sort. But there is the general evidence of the Defendant. Mr. Justice *Joyce* saw this witness, and Mr. Justice *Joyce* obviously thought this witness to be a witness of truth, because he distinctly finds several facts in his judgment which depended exclusively on the evidence of the Defendant. He also found, on general evidence of the type which I have been referring to, the facts which were not proved by the Defendant, but which were spoken to by other witnesses. I think, therefore, it is quite impossible for us to disturb the judgment of Mr. Justice *Joyce*.

ROMER, *L.J.*—I also am of opinion that this appeal fails; and I can state my reasons very shortly. In substance, this is an action on behalf of the Plaintiffs

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to establish that they have an exclusive right to the use of a narrow red band in the sale of their cigars—a species of monopoly in respect of the user of the narrow red band. In my opinion that claim of right is not established. The cigars that the Plaintiffs have sold, with the narrow red band upon them, are
 5 known, invoiced, and sold as “Marcella” cigars; upon the narrow red band put round the cigars which they sell you have the word “Marcella;” and in their advertisements the Plaintiffs take good care to point out—at any rate in some of their advertisements—that to get genuine cigars you must look out, not only for the narrow red band, but for the word “Marcella,” and that their
 10 cigars are known by the two things combined, the name “Marcella” and the use of the narrow red band.

There is evidence, as one might expect, that very often customers for these particular cigars, who know these cigars from having previously bought them, ask for them as “Narrow red band cigars,” and so forth. That kind of evidence
 15 is what one might expect. That customers should ask for these cigars by a description of that kind is very natural; but, I need scarcely say, that cannot of itself give to the Plaintiffs a monopoly in the red band, or a monopoly in such words as “narrow red band,” and so forth.

Now the Defendants have for some time past—for how long I need not pause
 20 to consider—been selling their cigars as “Purnella” cigars, with a similar narrow red band, the name “Purnella” being put upon it. The Plaintiffs say that what the Defendants are doing is calculated to deceive. There is no evidence of actual deception, so that it has to be assumed from the appearance of the thing, coupled with the rest of the evidence. All I can say is that, on
 25 the evidence as a whole, they have failed to satisfy me that what the Defendant is doing is calculated or intended to deceive; and on that short ground I think the appeal fails.

COZENS-HARDY, *L.J.*—I am of the same opinion. The Plaintiffs must succeed by virtue of the strength of their own case; and in the arguments
 30 before us, they unquestionably have relied mainly on an attack on the Defendant. Had it been necessary for me to express an opinion on that point, I should have hesitated before differing from Mr. Justice *Joyce* who saw the Defendant, and saw his demeanour, and who says in his judgment, “In my
 35 ‘opinion the Defendant is a perfectly honest trader.’” But, in the view which I take it is not necessary to go into that branch of the case. The Plaintiffs must succeed, if at all, on the ground that by the course of trade which they have carried on, they have acquired the sole right to the use, not of every red strip or band, but of a narrow band, as distinguished from a broad band, and
 40 also they must establish this, that their goods are known in the market so clearly and certainly under the title of “narrow red band” goods, that anybody ordering cigars of that kind, under that name, would expect the Plaintiffs’ goods. They must, in my opinion, prove either that there was originally fraud on the part of the Defendant in copying the mark, or selling the goods under a
 45 similar mark, or, at least, they must show that he is fraudulent because he continues to sell under the mark, when the Plaintiffs’ better right is pointed out to him.

I think that in the present case no such claim is made out. In the first place, no single case of actual deception has been proved. There has been plenty of time to have proved such a case could it have been established. In
 50 the next place, the name “Marcella,” which I understand is a registered Trade Mark, with the red band on the public advertisements, is coupled with a caution or warning that people buying are to look out for the mark “Marcella”:—“This high-class cigar, as sold the world over, is known by a red
 55 band with the word ‘Marcella’ on it in white.” In the face of that, we are asked to say that the thin red line, coupled with the Trade Mark, or rather, to

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put it more accurately, the thin red band, with the registered Trade Mark on it, is much more important than the Trade Mark itself, and that the Plaintiffs have a right to prevent anybody else from using a red band of that kind. The learned Judge has pointed out that a monopoly to a narrow band of this kind is something which the law cannot recognise and protect. Speaking for myself, 5 I desire to say that I think there is a tendency to exaggeration in these passing-off cases—an exaggeration which I think requires to be carefully scrutinised and modified in the Courts.

Walter.—The appeal will be dismissed, with costs.

VAUGHAN WILLIAMS, *L.J.*—Yes.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BUCKLEY.

June 4th, 1904.

IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, and COZENS-HARDY. 15

June 8th and 16th, 1904.

SACCHARIN CORPORATION, LD. v. D. T. J. LYLE & SON, LD.

Patent.—Action for infringement against Limited Company.—Infringement alleged before incorporation of Company.—Application by Plaintiffs for leave to amend by joining as Defendant the Company's predecessor in business.— 20
Application granted.—Appeal by Defendants.—Appeal dismissed on a certain undertaking being given by the Plaintiffs.

On the 23rd of October 1903 the *Saccharin Corporation, Ltd.*, commenced an action against *D. T. J. Lyle & Son, Ltd.*, for infringement of seven Letters Patent.

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The Plaintiffs, by their Statement of Claim, alleged (*inter alia*) that the Defendants had infringed one of the three Patents marked A and one of the four Patents marked B, in manner in the Particulars of Breaches therewith delivered appearing. The Particulars of Breaches alleged (1) that the Defendants had infringed one of each of the groups of Patents A and B respectively 30

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in the Statement of Claim set out, by the importation into this realm of saccharin, and by the sale, dealing with, and use of the same in this realm; that the said saccharin so imported, sold, dealt with, and used, was manufactured from toluene sulphochloride according to the processes described in the Specification of one of the four said Letters Patent marked B, and as claimed in all the claiming clauses of the said Specification; that the toluene sulphochloride from which the said substances were so manufactured as aforesaid was manufactured according to the Specification of one of the three Patents marked A in the Statement of Claim, and as claimed in all the claiming clauses of the said Specification. (2) That the Defendants purchased from one *William Hoey Williams* (a traveller for one *Karl Kramer*), in the latter part of the year 1901, two parcels, 56 lbs. each, of saccharin, and that the Defendants had also bought, at rates unknown to the Plaintiffs, saccharin from another traveller of *Kramer's*, named *Cohen*; and (3) that the Plaintiffs were unable, until they obtained discovery, to give further and better particulars, but would claim to recover compensation for all infringements committed by the Defendants.

The Defendants by their Defence denied that they had infringed the Patents or any of them; and also denied more specifically the allegations of infringement contained in the Particulars of Breaches. On the 17th of December 1903, the Plaintiffs gave notice of an application to the Master for further directions in the action—(1) that the Plaintiffs be at liberty to amend the Writ of Summons therein by adding as a Defendant *Daniel Thomas James Lyle*, and also make all necessary amendments in the Statement of Claim and Particulars of Breaches consequent thereon, and (2) that the costs of the application should be costs in the action.

In support of the application *H. T. Glassborow*, managing clerk to the Plaintiffs' solicitors, made an affidavit in which he alleged (*inter alia*)—" (1) I have from the commencement of this action had the conduct thereof on behalf of the above-named Plaintiffs; (2) in the early part of the month of December, 1903, information was received by the Plaintiffs' solicitors from a person whom it is intended to call as a witness on behalf of the Plaintiffs at the trial of this action that *Daniel Thomas James Lyle*, of East Layne, Maidstone, had infringed the Letters Patent, the subject-matter of this action, by taking part in and being connected with the instance of infringement set out in paragraph 2 of the Particulars of Breaches delivered herein. I submit the Plaintiffs are not bound to disclose the identity of such person at this stage of the proceedings. (3) For some years prior to the month of March 1902 the said *D. T. J. Lyle* carried on business as a mineral water manufacturer at East Layne, Maidstone, in the county of Kent, and other places. In the said month of March 1902 the said *D. T. J. Lyle* converted the said business previously carried on by him into a limited liability Company, and registered the same under the name of *D. T. J. Lyle & Son, Ltd.*, and being the above-named Defendants. . . . (4.) By an Agreement dated the 4th of April 1902, and expressed to be made between the said *D. T. J. Lyle* of the one part and *D. T. J. Lyle & Sons, Ltd.* (the above-named Defendant Company) of the other part, after reciting that the said *D. T. J. Lyle* had carried on the business of a manufacturer of aerated waters, &c., for some time past, that he had recently determined to transfer the business, stock-in-trade, premises, &c., to a Company, and with that view had caused a Company to be registered, it was agreed that in consideration of allotment to the said *D. T. J. Lyle* of 16,000 fully paid 1*l.* shares in the said Company, he should assign the aforesaid business and premises, where the same was carried on, the goodwill thereof, and all loose machinery, plant, stock-in-trade, horses, and effects used in or belonging to the said business to the said Company." After other clauses the affidavit continued as follows :—" (8) I submit that in fact the Defendant Company and the said *D. T. J. Lyle* are one for all practical purposes; the

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"said *D. T. J. Lyle* is the owner of the undertaking. (9) According to the
 "information supplied to the Plaintiffs' solicitors as aforesaid the said
 "*D. T. J. Lyle* purchased the saccharin complained of in the Particulars of
 "Breaches delivered herein, and the Plaintiffs by their amended Statement of
 "Claim and Particulars of Breaches will allege that the said Defendant Com- 5
 "pany have sold ^{and} or used the same. (10) The Plaintiffs are advised that,
 "owing to such information, the said *D. T. J. Lyle* is a necessary and proper
 "person to be joined as a Defendant in this action in order that the Court may
 "be placed in a position to satisfactorily deal with the issues raised herein.
 "Had such information been in the possession of the Plaintiffs' solicitors at the 10
 "date of the issue of the writ herein, the said *D. T. J. Lyle* would have been
 "joined as a Defendant in the Writ in this action."

Samuel James Lyle, the secretary of the Defendant Company, made an
 affidavit, in which, after referring to the above mentioned affidavit, he
 stated (*inter alia*) as follows:—" (2) In answer to paragraph 2 thereof, 15
 "I say that prior to the commencement of this action, viz., on the 9th of
 "September 1903, the Plaintiffs wrote and complained to *Daniel Thomas*
 "*James Lyle* (referred to in the said affidavit) of the matters the subject
 "of this action, and such letters are now produced and shewn to me
 "and marked S. J. L. 1. (3) At this time the Defendants were purchasing 20
 "saccharin under a contract between the Defendants and the Plaintiffs, dated
 "on or about the 3rd day of July 1903, and the Plaintiffs have never before
 "the 16th day of September 1903, complained to them about the subject of
 "this action, and the Defendants, from the time they were incorporated until
 "July 1903, used no saccharin at all in their business. (4) Notwithstanding 25
 "their said letter of 9th day of September 1903, the Plaintiffs elected to sue
 "the Defendants and not the said *D. T. J. Lyle*, to whom they first com-
 "plained. (6.) I submit that this application is made solely because the
 "Plaintiffs had found that they cannot possibly succeed in this application, as
 "they have not any evidence whatever against the Defendant Company, and 30
 "they know that the Defendant Company have not used any compound
 "infringing any of the Letters Patent, the subject of this action. (7) The said
 "*D. T. J. Lyle* is not, I submit, a person whose presence before the Court is
 "necessary to enable the Court to adjudicate on the questions involved in this
 "action, and that the Defendant Company, having been sued by the Plaintiffs, 35
 "are entitled to have the issue of fact, which alone is raised in this action,
 "determined as between them and the Plaintiffs."

Walter (instructed by *J. H. and J. Y. Johnson*) appeared for the Plaintiffs;
Hohler (instructed by *F. J. Berryman*) appeared for Defendants.

BUCKLEY, J.—On the 23rd of October 1903 the Plaintiffs brought an action 40
 against *D. T. J. Lyle & Sons, Ltd.*, for alleged infringement of Patent, and by
 their Particulars of Breaches they stated that the Defendants—that is the
 Limited Company—made a certain purchase in 1901, which is relied on as the
 act of infringement. It turns out that in 1901 the Defendant Company was not
 in existence. It was incorporated in March 1902. The Plaintiffs were wrong 45
 in alleging a purchase by the Limited Company at a date when it did not exist.
 The facts are that a gentleman, whose name is *D. T. J. Lyle*, was carrying on a
 certain business, and the Plaintiffs now say that it was he who purchased in
 1901. In March 1902 he sold his business to *D. T. J. Lyle & Sons, Ltd.*; he took
 16,000 out of 20,000 shares in the Company, and he became permanent managing 50
 director with very large powers, and a power even by will of appointing a
 managing director to succeed him. The Plaintiffs now say that the case which
 they wish to make is this—that *Lyle*, the proposed Defendant, was the purchaser
 in 1901; that he handed the saccharin bought in 1901 to the Company when it
 was formed, and the Limited Company used it, and therefore there has been 55

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- infringement by its purchase, and, again, by its use. The Plaintiffs want now to join *Lyle* as Defendant, and to amend their Pleadings and Particulars of Breaches, by setting up that case. The Defendants say, "No, you are wrong in your allegation, and this will be a joinder of two separate causes of action, and ought not to be allowed." In my opinion that contention cannot prevail. The cause of action is one and the same, in the sense that it is an act of infringement initiated by *Lyle*, the proposed Defendant, and continued and carried into effect by *D. T. J. Lyle & Sons, Ltd.*, which, of course, under the circumstances which I have stated, is in law, but not really in fact, a different person from *Lyle*, the original Defendant. I think that if they be separate causes of action they are causes of action which can be most conveniently tried together, and therefore I give leave to join *Lyle* as a Defendant, and leave to the Plaintiffs to amend their Pleadings and Particulars of Breaches by adding *Lyle*. The costs of the application will be costs in the action.
- 15 *Hohler*.—Will your Lordship limit the leave to amend, to any cause of action which arose after the Company came into existence?
BUCKLEY, J.—No.
Hohler.—Will your Lordship give leave to appeal? I should like to take the matter to the Court of Appeal.
- 20 BUCKLEY, J.—No, I will not. I think that this discretion, which is vested in the Judge of first instance to refuse leave to Appeal, however disagreeable it may be to him to refuse it, is one which he ought to deal with according to his proper discretion. I do not think it is a case fit for appeal, and I refuse leave to appeal. I may say personally I regret to do so.
- 25 On the 8th of June 1904, Counsel for the Defendants obtained leave from the Court of Appeal to appeal, and subsequently gave notice of appeal on the ground (1) that *D. T. J. Lyle* was not a necessary party to the action within Order 16, and (2) that the causes of action (if any) alleged were separate causes of action, and that the rules of procedure did not admit of their being joined in the same action.
- 30 *Hohler* and *J. G. Joseph* (instructed by *F. J. Berryman*) appeared for the Appellants; *Walter* and *Sinclair* (instructed by *J. H. and J. Y. Johnson*) appeared for the Respondents.
J. G. Joseph for Appellants.—The Defendant Company was only registered in March 1902, and therefore could not have infringed as alleged in the Particulars of Breaches. Upon the Plaintiffs' affidavit the action must fail; and they are not entitled to join the separate tort (if any) of the Company to the tort of *Lyle*. [*Sinclair*.—We propose to amend the Particulars of Breaches by alleging that *Lyle* bought and that he or the company sold.] That is making a new case; moreover, they would be several tortfeasors. An allegation against joint tortfeasors cannot be joined with one of several torts. [ROMER, L.J.—If the case is that with regard to the sales the Plaintiffs cannot say which sold, why cannot they be sued in the alternative?] That might be so, but they cannot join the Company and *Lyle* in an action in which they allege torts by *Lyle* before the incorporation of the Company. Separate actions should be brought. [*Thompson v. London County Council*, L.R. (1899) 1 Q.B. 840, was referred to.] [The judgment of BUCKLEY, J., was read].
- 40 *Walter* and *Sinclair* for Respondents.—The circumstances under which the mistake was made by the Plaintiffs are important. The Company replied to our first complaint to *Lyle*. There is really one continuing tort, and the Company is really *Lyle*. [ROMER, L.J.—It is too late to set that up, and there are two perfectly separate causes of action.] We submit that we can join *Lyle* who bought and the Company who sold. Order 18, Rule 1, allows us to join causes of action if they can be conveniently tried together, although against different Defendants. The practice in Patent actions is to join in one action a manufacturer and a purchaser or user.
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Saccharin Corporation, Ltd. v. D. T. J. Lyle & Son, Ltd.

[VAUGHAN WILLIAMS, *L.J.*—Can you join two distinct causes of action against different persons, neither of them having anything to do with the other?] No, not if they have nothing to do with the other. *Lyle*, by parting with the saccharin to the Company, committed a fresh act of infringement, and the Company also infringed by acquiring with the intention of using. [VAUGHAN WILLIAMS, *L.J.*—You are now alleging a single tort.] That will have to be our case when we amend the Particulars of Breaches. [VAUGHAN WILLIAMS, *L.J.*—It is not alleged in the affidavits that the saccharin sold by the Company was part of *Lyle's* saccharin.] [ROMER, *L.J.*—Your case is now a sale by *Lyle* to the Company.] Yes, and I will undertake not to claim against the Company in respect of anything before incorporation. I can claim independently against *Lyle*. [COZENS-HARDY, *L.J.*—Speaking for myself I do not think you get over the difficulty unless you abandon all claims prior to the assignment to the Company.] [*Joseph* referred to *Gower v. Couldridge*, L.R. (1898) 1 Q.B. 348.] Possession with intention of user is a continuing tort by *Lyle*.

VAUGHAN WILLIAMS, *L.J.*—Why are you not content to try this in an action in which you limit yourself to the joint torts of *Lyle* and the Company?

Walter.—Because I should be met with difficulty of proof. I can prove possession. I want to throw the onus of proof on the other side because I can trace the saccharin into the possession of *Lyle*. What became of it afterwards must be within *Lyle's* own knowledge.

COZENS-HARDY, *L.J.*—You will have *Lyle* as a Defendant, and you will get discovery of documents against him.

VAUGHAN WILLIAMS, *L.J.*—I do not think the intention of the Judicature Act and the Rules, which relate to the joinder of parties and causes of action, is to give a wider discovery, and to alter the onus of proof. The real object of the joinder is that the same facts should not be investigated in the same court twice over.

ROMER, *L.J.*—You want, in fact, to limit the case simply to this, that *Lyle*, having bought saccharin, sold it to the Limited Company who used it.

Walter.—I am quite content with that. That is all the case I want to raise. I am quite content with that cause of action that *Lyle* bought, sold to the Company, and the Company used.

VAUGHAN WILLIAMS, *L.J.*—Then under those circumstances (I will deal with the question of costs in a moment) why should not you abandon any cause of action before the Company came into existence—before this agreement under which you say *Lyle* transferred to the Company.

Walter.—I will rely upon no sale by *Lyle* other than to the Company; but I want to allege purchase by *Lyle*, because that is part of the story.

VAUGHAN WILLIAMS, *L.J.*—You will be able to allege that perfectly well without having a separate cause of action. You can allege it and prove it in a joint action against the two. You do not want to continue the action for the single tort. The truth of the matter is that this is merely a question of costs, and the whole object in this application is to enable you to get rid of the action in which you were wrong without having to pay the costs of it.

Walter.—If your Lordships think I ought in this action to rely on the joint tort, I will only rely on the joint acts, and I will claim relief in respect of the transaction of purchase and sale, or transfer, by *Lyle* to *Lyle & Sons, Ltd.*, and user by *Lyle & Sons, Ltd.*

The costs of the appeal were given to the Defendants in any event.

Joseph Halden v. B. J. Hall & Co.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE WARRINGTON.

July 6th and 7th, 1904.

JOSEPH HALDEN v. B. J. HALL & CO.

5 *Patent.—Action for infringement.—Novelty.—Subject-matter.—Judgment for Plaintiff.—Certificate that the validity of the Patent came in question given.*

In 1899 a Patent was granted to the Plaintiff and another for "Improved means applicable for use in the production of photo-prints." The invention consisted essentially in mounting a cylinder, used in conjunction with an arc
 10 *light for reproducing architects' and engineers' drawings by photography, upon trunnions, so that it could be placed in a horizontal position. The main defence was want of subject-matter.*

Held, that the invention was new, useful, and had not been anticipated, and that it was good subject-matter for a Patent, and also that the Defendants had
 15 *infringed. Judgment was given for the Plaintiff.*

Joseph Halden, the Plaintiff in the action, was the registered holder of Letters Patent (No. 5561 of 1899) granted to himself and Leonard Shaw for "Improvements applicable for use in the production of photo-prints."

The Complete Specification was as follows :—"This invention relates to an
 20 *"improved construction of apparatus designed to facilitate the expeditious and economical reproduction of drawings and the like with the aid of artificial light. Apparatus constructed according to our improved method and adapted for the purpose referred to is illustrated in the accompanying drawings, whereof*
"Fig. 1 is a view half in elevation and half in longitudinal section the apparatus
 25 *"being shown in the position it occupies during the application of the sensitised paper and the original previous to reproducing the latter upon the former.*
"Fig. 2 is a view partly in end elevation and partly in transverse section corresponding with Fig. 1. Fig. 3 is a view illustrating the general working
"of the apparatus; the cylinder being turned into position for receiving the
 30 *"source of artificial light. Figs. 4 and 5 are detached views of means which may be employed for securing the canvas covering or apron.*

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"The apparatus comprises two semi or approximately semi-cylinders A A composed of glass or other suitable transparent material; the two semi-cylindrical surfaces or tables being arranged with their concave sides towards one another either concentrically as shown, on* with their centres moved 5 somewhat apart. The opposite extremities of the tables are respectively mounted in discs B B suitably grooved for their reception; the grooves being by preference lined with caoutchouc *b b* or other yielding packing, and affording moreover freedom for expansion and contraction of the glass tables. Adjustable blocks *b b*¹ which bear upon the convex sides of the tables serve 10 to preserve the semi-cylindrical surfaces from displacement in a radial direction. The discs B B in which the opposite extremities of the tables A A are carried are connected together by means of bars or tubes C C arranged in pairs on either side between or opposite the gaps between the longitudinal edges of the tables. Or other suitable connecting pieces similarly arranged 15 may be employed. The bars or connecting pieces are respectively provided, midway of their length, with trunnions D D; the latter being carried in bearings E E mounted on two side frames F F. One of the trunnions is furnished with a plate D¹ through one or another of the perforations in which latter a pin or stop D² may be passed and inserted in a hole in the framing 20 when it is desired to maintain the apparatus in a vertical or horizontal attitude. The discs B B in which the tables are carried are respectively formed with large central openings adapted to admit an electric arc lamp G or other instrument for the production of artificial light.

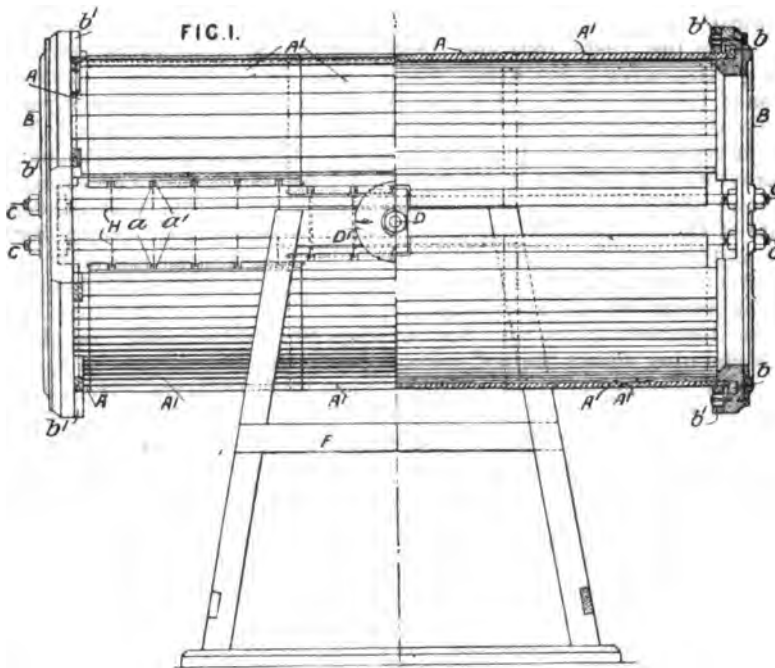
"Assuming that a drawing prepared on tracing paper is to be reproduced by the ferro-prussiate or like photographic process, and regarding the pair of 25 tables A A when mounted as before described as constituting a single cylinder, the tracing is first laid upon the upper surface of the cylinder, upon the tracing is placed the sensitised paper and these are then covered with a canvas or other apron A¹ which may be secured at intervals to one of the longitudinal bars C or other connecting pieces which extend between the end discs B. 30 The cylinder is then turned on its transverse axis D, and its opposite side, which is now uppermost, may be utilised in the same manner for the reception of another tracing or other transparent original to be copied. This together with its sensitised paper having in like manner been covered by an apron and secured, the cylinder is now turned so as to assume a vertical 35 position, and an electric arc lamp, such as G, or other source of artificial light is introduced through the opening in the upper or in the lower disc B. The lamp may be raised or lowered, according to the requirements of the work in course of reproduction and may also be rotated; or two or more lamps may be employed, either at the same or at different levels. In the drawing a single 40 lamp G is shown connected by means of a cord *g* with a counter-weight *g*¹. The canvas apron A¹ is preferably made in sections whereof the edges transverse to the cylinder or tables overlap. The longitudinal edges of each section are formed for the reception of rods *a* which may be seen at the notches or openings *a*¹. For securing these edges to the bars C extensible or spring 45 hooks H, such as shown detached in Figs. 4 and 5 may be employed. The hooks may be carried by the bar nearest to the edge to be secured or they may be carried by the bar remote therefrom. In the latter case they would require to be somewhat extended in form to permit of their being elongated so as to meet the rod *a* pertaining to the edge of the apron. The hook-ring *h* at one 50 end of each hook is arranged to fit freely on the bar C while the hook *h*¹ at the opposite end is arranged to readily engage with the rod *a*."

The Patentees claimed.—"1. The herein described apparatus for use in the production of photo-prints with the aid of artificial light; same comprising a

* "On" in the printed Specification: probably should be "or."

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- “drum formed of transparent material, mounted on trunnions, so as to be
 “rotateable about its transverse axis, and adapted for the reception of a lamp
 “or other source of light internally, whilst the drawing to be reproduced and
 “the sensitive paper are secured about its exterior surface. 2. In apparatus for
 5 “use in the production of photo-prints with the aid of artificial light, the
 “employment of a drum consisting of two annular end-plates connected
 “together by means of bars arranged on either side, the end-plates supporting
 “between them two approximately semi-cylindrical tables formed of trans-
 “parent material, such as glass, the whole being mounted to rotate on trunnions
 10 “attached to the aforesaid connecting bars, substantially as herein described.
 “3. In apparatus for use in the production of photo-prints with the aid of
 “artificial light, the combination of the printing cylinder A A, the cover or
 “apron A¹, the bars C C, and the spring hooks H H, substantially as and for
 “the purposes specified. 4. In apparatus for use in the production of photo-
 15 “prints with the aid of artificial light, the combination, with the printing
 “cylinder A A, of the end plates or discs B B, having grooves lined with
 “caoutchouc or other yielding packing, and the connecting bars C C, substan-
 “tially as set forth.”



- On the 16th July 1903 the Plaintiff issued a writ against *B. J. Hall & Co.*, claim-
 20 ing the usual relief for the infringement of his Patent in the manner described
 in the Particulars of Breaches, which (1) after charging infringement generally
 by making, selling, and dealing with photo-copying apparatus made in accordance
 with the patented invention, (2) complained in particular—“(A) Of the sale by
 “the Defendants in or about the month of November 1902 of photo-copying
 25 “apparatus constructed as aforesaid to (i) the *Corporation of Liverpool*, and
 “(ii) Messrs. *W. T. Henley's Telegraph Works, Ltd.*, late of 27, Martin's Lane,
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"Cannon Street, E.C., but now of 13 and 14, Blomfield Street, London Wall, E.C. (B) Also of the sale by the Defendants of photo-copying apparatus constructed as aforesaid to (i) Messrs. *E. C. and J. Keay, Ltd.*, James Bridge, South Staffordshire, and (ii) the *Photo-Printing Paper Company*, No. 60, Marsham Street, London, S.W. (C) Of the exhibition by the Defendants of 5
 "a photo-copying frame constructed as aforesaid at the Building Trades Exhibition held at the Agricultural Hall, London, from the 13th to the 20th June 1903"; and (3) claimed full compensation in respect of all infringements by the Defendants of the Patent.

The Defendants denied the ownership of the Letters Patent by the Plaintiff, 10
 and also that they had infringed, and further pleaded that the Patent was invalid for the reasons stated in the following amended Particulars of Objections:—"1. The said alleged invention was previously to the date of the said Letters Patent published within this realm in the following Specifications respectively filed in the Patent Office and the following printed books, viz.:— 15
 "(A) The Specification No. 9853 of 1897 of *Benjamin James Hall*, filed under Letters Patent dated the 20th of April 1897. (A1) The Specification No. 2067 of 1895 of *Jean Billard*, filed under Letters Patent dated the 29th of January 1895. (A2) The Specification No. 9591 of 1891 of *William Palmer*, filed under Letters Patent dated the 6th of June 1891." [The whole of these 20
 Specifications were relied on as anticipating the alleged invention described in the Specification and claimed by the first claiming clause.] "(B) The Defendants published in the years 1897 and 1898 a two-page descriptive Circular with Drawing illustrating a machine manufactured by them under the said last-mentioned Letters Patent. (C) The Defendants published in the years 1897 25
 "and 1898 a single page price list descriptive of such machine. 2. The said alleged invention was not new at the date of the said Letters Patent, having been previously published in the Specifications and printed Circulars referred to in paragraph 2 hereof. 3. The said alleged invention was previously to the date of the said Letters Patent published within this realm by the manu- 30
 "facture and sale by the persons or firms following, at their places of business hereinafter mentioned, in the form hereinafter set forth, of photo-copying apparatus being the same or substantially the same as the photo-copying apparatus described in the said Specification No. 5561 of 1899 and claimed in the first claiming clause thereof, namely:—By the Defendants at 39, Victoria 35
 "Street, in the County of London, in the years 1897, 1898, and 1899. 4. Having regard to the knowledge existing at the date of the said Letters Patent, the alleged invention was not proper subject-matter of Letters Patent."

Pursuant to an Order made in the action the Defendants gave the name of one purchaser from them in each of the years 1897, 1898, and 1899 of the 40
 apparatus which they alleged to be an anticipation of the Plaintiff's Patent.

The action came on for trial before Mr. Justice WARRINGTON.

Moulton, K.C., and *Walter* (instructed by *Linklater, Addison, Brown, and Jones*) appeared for the Plaintiff; *Bousfield*, K.C., and *Peterson* (instructed by *Taylor, Hoare, and Pilcher*) for the Defendants. 45

Moulton, K.C., opened the case for the Plaintiff.—The Patent is for an apparatus which is very largely used for the reproduction of architects' and engineers' drawings in the shape of what are known as "blue prints" by artificial light. The "blue prints" were formerly produced by daylight by means of a flat printing frame; but it was found that a sufficiently regular supply of light 50
 could not be relied on, and consequently the method was introduced of wrapping the prints round a vertical glass cylinder into which an electric arc light was introduced. The essence of the patented invention consists in placing such a cylinder on trunnions, so that it can be shifted into a horizontal position when it is desired to clean it or to put prints on, and thus not only is cleaning 55
 facilitated but larger cylinders can be fixed and larger prints produced. At first the Defendants only took part of the invention; now they take the whole,

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so that infringement is practically admitted, and the real defence is the want of subject-matter. The answer to that is that if it was obvious the invention would have been thought of before; but no one had done so before the Patentees.

- 5 *Dugald Clerk, G. G. M. Hardingham, A. J. Metzger, and Joseph Halden*, the Plaintiff, were then called and gave evidence in support of the Plaintiff's case; *A. J. Boulton, F. W. Golby, John B. Thorp, Harrison Ainsworth, and B. J. Hall* gave evidence for the Defendants.

- Bousfield, K.C.*, for the Defendants.—The real advance in this trade was made
10 by the Defendants. It is described in *Hall's* Specification referred to in the Particulars of Objections, and consisted in making the cylinder in two halves. This Patent was offered by the Defendants to the Plaintiff and refused by him; but subsequently when the Defendants started manufacturing the Plaintiff became a licensee under their Patent. After that he introduced his new
15 invention, which consists in putting the cylinder on trunnions. It is said that this is not obvious, because no one had done it before; but this point loses its force on account of the recent date of the Plaintiff's Specification. The idea suggests itself as soon as it is necessary to use a cylinder of unmanageable size. There is no invention in putting a cylinder on trunnions, though there may be
20 in doing it in a particular way, as in the second claim, which is justified; but the Plaintiff is not entitled to set up the first, and so prevent the Defendants from using trunnions at all. This claim is bad as being a claim for a principle apart from any particular mode of carrying it into effect. Having regard to the state of knowledge it is impossible for anyone to claim the combination of
25 trunnions with a cylinder (*Harwood v. Great Northern Railway Company*, 11 H.L.C. 654). As regards infringement, this may be looked at in two ways—(1) as regards substance, and (2) as regards the words of the claim. So far as the substance is concerned, the Plaintiff cannot say the Defendants are indebted to him for the idea; for the idea of putting a cylinder on trunnions is old, as is
30 shown by the case of telescopes and cannons. Moreover, the flat printing frames had also been placed on trunnions. If the Patent is to be supported at all it must be limited to the use of a cylinder. The third claim is bad also, because it is not limited.

- Moulton, K.C.*, in reply.—The Defendants say that the Patentees claim
35 "trunnions however applied," and that this is a claim for a principle, and therefore bad. To say that such a claim is bad except with a particular method of application is a caricature of the doctrine of the Court. The Patentees have invented a machine of admitted utility, which does its work better than the Defendants', and now they say they have taken the Plaintiff's invention in
40 order to supply the artificial demand which the Plaintiff created. To suggest that there is an invention in making a cylinder in two parts is contrary to the authorities. *Siddell v. Vickers* (7 R.P.C. 292) is very parallel to this case; we have created a new machine of great practical utility as was done in that case. See also *Hayward v. Hamilton* (Griffin 121), and *Harwood v. Great Northern*
45 *Railway Company* (11 H.L.C. 654).

- WARRINGTON, J.—This is an action for the infringement of a Patent (No. 5561 of 1899), for an improvement in apparatus for producing prints by means of photography. The usual defences are set up; but that on which most stress
50 was laid in the argument is the defence that having regard to the knowledge existing at the date of the Letters Patent the invention was not a proper subject-matter of Letters Patent. With regard to anticipation, treating it as a defence apart from subject-matter, I find that there has been no anticipation. That the apparatus is useful is admitted; that it was new is proved.

- The facts are these:—The invention relates particularly to the copying by
55 means of photography of engineers' and architects' drawings. For some 30 years these drawings have, until recent times, as I shall mention presently, been reproduced by placing them on tracing paper or cloth in contact with sensitive

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paper in such a way that as the light shines through the tracing paper or cloth to the sensitive paper, except where it is intercepted by the black lines, the colour of the paper is changed, and the lines are left in white. They are generally called "blue prints." Until about eight years ago the process was effected by placing the drawing and the sensitive paper in a frame, such as that which is ordinarily used for printing photographs, and exposing them, so placed, to the sun, and later to electric light. About eight years ago the Defendants for the first time introduced, for the purpose of printing by electric light, the use of a glass cylinder, the advantage of that being that the electric lamp could be lowered at a certain pace through the glass cylinder, and the light thus acted on the sensitive paper through the drawing, the two being placed round the outside of the cylinder. Some difficulty was found in producing the complete glass cylinder, and accordingly the Defendants, in 1897, conceived the plan of using two semi-cylinders fastened together, and this contrivance was the subject-matter of Letters Patent, No. 9853, of the year 1897. In this apparatus of the Defendants, the drawing is placed on the glass, then the sensitive paper is placed over it, and both are held down in position by an apron or blind which is kept in place by some mode of fastening. The electric light is then inserted into the cylinder, and passed at a certain pace along its length. The Defendants' cylinders were always vertical, capable of being rotated on their own axes, but not otherwise. There was found under this invention much difficulty, especially in the case of the larger cylinders, which are sometimes required to be as much as 10 or 12 feet in length, both in fixing the drawings and the sensitive paper, and in cleaning, it being of obvious importance that the glass should be kept scrupulously clean.

The Defendants offered their Patent to the Plaintiff, who is a manufacturer of apparatus of this kind. He declined it, and in the year 1899 he made a cylindrical apparatus which the Defendants alleged was an infringement of their Patent, and, after some discussion, the Plaintiff in the month of April 1900 consented to become, and did become, a licensee under the Defendants' Patent. Meanwhile, however, it had occurred to him and to Mr. *Leonard Shaw*, who is his co-Patentee, that the difficulties I have mentioned in connection with the vertical cylinders might be overcome, and that greater convenience might be obtained if the cylinders were so contrived that they might rotate on their transverse axes. This they effected in the manner described in the Specification now in question. Part of that Specification I will read. It states that:—"This invention relates to an improved construction of apparatus designed to facilitate the expeditious and economical reproduction of drawings and the like with the aid of artificial light." Then, passing over a passage which is a mere reference to the Drawings attached to the Specification, the Patentees proceed as follows:—"The apparatus comprises two semi or approximately semi cylinders A A, composed of glass or other suitable transparent material; the two semi-cylindrical surfaces or tables being arranged with their concave sides towards one another, either concentrically as shown or with their centres moved somewhat apart. The opposite extremities of the tables are respectively mounted in discs B B suitably grooved for their reception, the grooves being by preference lines with caoutchouc *b b* or other yielding packing, and affording moreover freedom for expansion and contraction of the glass tables. Adjustable blocks *b b*¹ which bear upon the convex sides of the tables serve to preserve the semi-cylindrical surfaces from displacement in a radial direction. The discs B B in which the opposite extremities of the tables A A are carried are connected together by means of bars or tubes C C arranged in pairs on either side between or opposite the gaps between the longitudinal edges of the tables. Or other suitable connecting pieces similarly arranged may be employed. The bars or connecting pieces are respectively provided, midway of their length, with trunnions D D; the latter being carried in bearings E E mounted on two side frames F F." I do

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not think I need read any more of that description of the apparatus. I think what I have read contains the material part; but there is one passage on the next page of the Specification which I propose to read in connection with the point which was raised on one of the claims in the claiming part:—"The

5 "canvas apron A¹ is preferably made in sections whereof the edges transverse
 "to the cylinder or tables overlap. The longitudinal edges of each section are
 "formed for the reception of rods *a*, which may be seen at the notches or
 "openings *a*¹. For securing these edges to the bars C extensible or spring
 "hooks H, such as shown detached in Figs. 4 and 5, may be employed. The

10 "hooks may be carried by the bar nearest to the edge to be secured, or they
 "may be carried by the bar remote therefrom. In the latter case they would
 "require to be somewhat extended in form to permit of their being elongated
 "so as to meet the rod *a* pertaining to the edge of the apron. The hook ring *h*
 "at one end of each hook is arranged to fit freely on the bar C, while the hook

15 "*h*¹ at the opposite end is arranged to readily engage with the rod *a*." The
 Patentees claim, first:—"The herein described apparatus for use in the produc-
 "tion of photo prints with the aid of artificial light." Pausing there for one
 moment, it is clear that what the Patentees claim is not any part of the
 apparatus, or any principle illustrated by the apparatus; but it is the apparatus

20 itself. They then go on:—"Same comprising a drum formed of transparent
 "material, mounted on trunnions so as to be rotateable about its transverse
 "axis, and adapted for the reception of a lamp or other source of light internally,
 "whilst the drawing to be reproduced and the sensitive paper are secured
 "about its exterior surface." It was argued that having regard to those latter

25 words the claim was a general claim for a drum of transparent material mounted
 on trunnions so as to be rotateable about its transverse axis. I do not think so.
 I think that the claim was "the herein described apparatus," and that the addition
 of those latter words is merely an explanation and a reference to the more
 particular description contained on the previous page of the Specification which I

30 have read. The second claim is as follows:—"In apparatus for use in the pro-
 "duction of photo-prints, with the aid of artificial light, the employment of a drum
 "consisting of two annular end-plates connected together by means of bars
 "arranged on either side, the end-plates supporting between them two approxi-
 "mately semi-cylindrical tables formed of transparent material such as glass, the

35 "whole being mounted to rotate on trunnions attached to the aforesaid connecting
 "bars, substantially as herein described." I do not think as to that claim any
 serious question was raised, and I will pass on to the third claim:—"In
 "apparatus for use in the production of photo-prints, with the aid of artificial
 "light, the combination of the printing cylinder A A, the cover or apron A¹,

40 "the bars C C, and the spring hooks H H, substantially as and for the
 "purposes specified."

Now it was said—and I propose to dispose of this point at once—that that
 was an independent claim for the spring hooks; that the spring hooks were
 old and well known at the date of the Patent, and that, therefore, that claim

45 was bad. I do not think so. I think the true meaning of that claim is
 that it is a mere pendant to the claim for the apparatus, and that the spring
 hooks, and the other things as well that are mentioned in it are merely claimed
 as a part of the combination substantially as and for the purposes specified.

With regard to the fourth claim, no serious question was raised on that, and

50 I do not propose to deal with it further.

Now with regard to the serious defence as to subject-matter. At the date of
 the Patent trunnions or their equivalents had been used in connection with the
 large flat frames to which I have already alluded, and they had also been used
 in connection with a slightly curved frame employed for sun printing, which is

55 the subject-matter of *Palmer's* Patent of the year 1891, and of course trunnions,
 or their equivalents, had been used in connection with many cylinders of
 various kinds; but I do not find that they had ever been used in connection

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with any such apparatus as that which is described in the Plaintiff's Specification. In this state of things was the invention good subject-matter? I think it was. There is no question that the apparatus was new and that it was useful. The trunnion was for the first time with great advantage applied to these two semi-cylinders of glass and for the particular purpose.

After hearing the evidence on both sides I have come to the conclusion that there was sufficient invention to support the Patent. The question is one, of course, of fact; but I think one is assisted considerably in arriving at the conclusion as to the fact by a passage in Lord *Herschell's* speech in the House of Lords in *Vickers, Sons & Co., Ltd. v. Siddell*, in 7 Reports of Patent Cases, page 292, the particular passage being at page 304. I have dealt with the argument that the first claim was too wide, and also with Claim 3.

Now, have the Defendants infringed? In my opinion they have. I think one only wants to look at the model of the two apparatus to come to that conclusion. The Plaintiff's apparatus consists, as I have said, of two semi-cylinders joined together by the bars or tubes referred to in the Specification, and being of course, when so joined together, a complete cylinder, the trunnions or pivots on which it is suspended must be external. The Defendants in their contrivance have taken one of the two semi-cylinders, and have made certain modifications in the mode in which that semi-cylinder is held in its frame, such modifications being more or less necessitated by the use of one semi-cylinder instead of two, and another consequence of taking one semi-cylinder instead of two is that they are able to suspend it on rotating pivots, which are inside instead of outside the cylinder. In my judgment those two variations make no substantial difference. The substance and the merit of the Plaintiff's invention is taken by the Defendants. Moreover the Defendants admit that they introduced their contrivance with a view of meeting what they call a fictitious demand created by the Plaintiff's machine, and I think one cannot have listened to the evidence which Mr. *Hall* gave without seeing that the variations which I have referred to are just those which a man would make who wished to meet what he called a fictitious demand created by a patented article, and yet to endeavour, if possible, not to infringe the Patent.

On the whole, therefore, I come to the conclusion that the Plaintiff is entitled to judgment.

An injunction and an inquiry as to damages (the costs of which were reserved) were awarded, and an Order was made for delivery up of infringing articles. A Certificate was given that the validity of the Patent came in question.

In the Matter of Ellis & Co.'s Trade Marks.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before Mr. JUSTICE FARWELL.

July 8th, 1904.

IN THE MATTER OF ELLIS & CO.'S TRADE MARKS.

- 5 *Trade Mark. — Motion to rectify. — "Quaker." — Whether word having reference to the character or quality of the goods, or calculated to deceive or disintituled to protection. — Patents &c. Act, 1883, Sections 64 (1) (e), and 73, Patents &c. Act, 1888, Section 10.*

- A firm of wine merchants having registered the word "Quaker" as a
 10 *Trade Mark in Class 43 for fermented liquors and spirits, not including whiskey, the Secretary of the Society of Friends applied by Motion to rectify the Register by the removal of the Trade Mark on the grounds that it was not entitled to protection in the Court or Registry, and was scandalous and liable to deceive, or had reference to the character or quality of the goods.*
 15 *There is no rule of total abstinence in the Society of Friends.*

- Held, that no damage in a legal sense could accrue to the Society of Friends, or that portion of its members who are total abstainers, from the use of the Trade Mark, and that they were not persons aggrieved; also that the word had no reference to the character or quality of the goods, and was not calculated
 20 *to deceive or disintituled to protection. The Motion was dismissed with costs.*

- On the 19th of December 1902, *Ellis and Company*, wine merchants and beer bottlers, of 11 Hill Street Richmond, Surrey, applied for registration as a Trade Mark of the word "Quaker" in Class 43 for fermented liquors and spirits, not including whiskey. The Trade Mark was accepted, and was
 25 *registered under No. 250,828.*

- On the 27th of April 1904, *Isaac Sharp*, Secretary at the Central Offices of the Society of Friends, gave notice of Motion for an Order that the Register of Trade Marks, might be rectified by removing this Trade Mark therefrom, upon the following amongst other grounds, viz.:—That the same ought not,
 30 *having regard to the provisions of the Statutes in that behalf, to have been admitted to registration for the description of goods in respect of which it was registered or at all; that the said Trade Mark was not entitled to any protection in the Court or the Registry, and was scandalous and liable to deceive; and had or purported to have reference to the character and quality of the goods*
 35 *intended to be distinguished or distinguished thereby.*

The Applicant filed an affidavit in support of the Motion, which was as follows:—

"(1) I am authorised by my said Society to make this affidavit and to take "these proceedings. The name commonly applied to my said Society, and by

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" which it is very commonly known, is that of Quakers, every member of the
 " Society is called a Quaker, and I myself am commonly called a Quaker by
 " reason of my membership of the said Society; (2) *Ellis and Company* of
 " 11 Hill Street Richmond, Surrey, are registered as the proprietors of the
 " above Trade Mark in Class 43 for fermented liquors and spirits, but not 5
 " including whiskey. The said Trade Mark was advertised in the 'Official
 " 'Journal' of the 25th February 1903, but was not seen by me or by my said
 " Society, or to the best of my knowledge and belief by any member thereof,
 " and was not brought to the notice of the said Society, and has not (if it has
 " been used, which we allege not to be the case) been brought to our notice in 10
 " use; (3) Another Trade Mark or proposed Trade Mark (No. 258,971) of the
 " said *Ellis and Company* was advertised in the 'Official Journal' of January 20th
 " 1904 and contained the word 'Quaker,' together with a pictorial representa-
 " tion. The said application was made in respect of fermented liquors and
 " spirits, but not including whiskey, and on the attention of my Society being 15
 " called to the said application they opposed it, and I was duly authorised by
 " them to file notice of opposition, and did so; (4) In the counter statement of
 " the said *Ellis and Company* to my said opposition, the said *Ellis and Company*
 " relied as part of their case in repelling the said opposition on the registration
 " of the word Mark 250,828, which is complained of by me and by the said 20
 " Society upon this Motion; (5) The said Society and the members thereof and
 " I myself have independently reason to complain and do complain of the said
 " representation. The majority of the members of the said Society are total
 " abstainers, and I myself am a total abstainer, and the association of spirituous
 " liquors with the name by which we are commonly and generally known as a 25
 " religious body is offensive to us and scandalous, and is also calculated to deceive
 " the public as to the origin of the spirituous liquors intended to be distinguished
 " by the said Trade Mark by suggesting they come from us, which is entirely
 " contrary to the fact, and also by suggesting that they are suitable for our con-
 " sumption, which is also contrary to the fact, and the tendency of the said Mark 30
 " is also to bring our said Society into contempt, and the said Mark should not, I
 " respectfully submit, be countenanced or assisted by the Court; (6) There
 " exists a non-alcoholic drink called 'Stewed Quaker,' and the Mark complained
 " of herein is also deceptive by suggesting that the spirituous liquors in connec-
 " tion with which it is really intended to be used are in fact the non-alcoholic 35
 " compound referred to; (7) For the reasons above-given the said Mark is not
 " only such as the Court would not assist or allow to be assisted by registration,
 " but also has reference to the character and quality of the goods in connection
 " with which it is intended to be used or is used."

Affidavits in support of the Motion were also made by other members of the 40
 Society of Friends, stating that the members of the Society were to a very large
 extent total abstainers, and that the Mark was an offence to them as a body
 and to the deponents in particular, and was regarded as scandalous, and also that
 the Mark was calculated to deceive the public as to the origin of the spirituous
 liquors distinguished or intended to be distinguished thereby by suggesting that 45
 they emanated from the Society of Friends or some Quaker source, which was
 contrary to the fact, and also by suggesting that they were suitable for their
 consumption, which was also contrary to the fact, and the tendency of the said
 Mark was also to bring the said Society into ridicule, and that the said Mark
 should not be countenanced or assisted by registration. 50

Henry Wm. Ellis made an affidavit in opposition to the Motion, in which
 (*inter alia*) he submitted that the Applicant was not a person aggrieved, and he
 referred to an application by the Respondents which the Applicant had opposed,
 and which the Respondents had allowed to lapse in order to meet his objections,
 and to the opposition by the Applicant to a subsequent application, No. 258,971; 55
 he stated that the Society of Friends had no formal creed, and that the doctrine,
 practice and church government of the Society were embodied in the book of

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- Christian discipline issued under the sanction of the yearly meeting held in London, that there was no rule of total abstinence in the Society of Friends, that moderate and temperate habits were recommended, but nowhere was there a rule making total abstinence from intoxicating beverages obligatory on the
- 5 members of the said Society, who were in no way prohibited from exercising their own judgment in the matter, and that the Society had within itself had a Total Abstinence Society; he also stated that there were a large number of Trade Marks on the Register in respect of a great variety of goods in which the word "Quaker," or that word with a pictorial device, appeared, and he referred to a
- 10 list of 25 such Marks, and the deponent denied the allegations as to the Mark being deceptive and scandalous.

The Applicant in his affidavit in reply referred to an Appeal made to the members of the Society of Friends in connection with the temperance question.

- 15 *Upjohn*, K.C., and *Israel Davis* (instructed by *Halse and Trustam*) appeared for the Applicants; *T. Terrell*, K.C., and *L. B. Sebastian* (instructed by *Wynne, Baxter and Keble*) appeared for the Respondents; *R. J. Parker* (instructed by the *Solicitor to the Board of Trade*) appeared for the Comptroller.

- Upjohn*, K.C., for the Applicants.—The Trade Mark should be removed from
- 20 the Register, because the word "Quaker" refers to the character or quality of the goods, and was not registrable (Sect. 64 (1) (e) of the Patents Act, 1883, as amended by Section 10 of the Act of 1888); also, it is calculated to deceive or is otherwise disentitled to protection within Section 73. On the first point the word conveys an idea of the character of the goods, either that of purity,
- 25 or mellowness, or being fit for or drunk by Quakers; just as "John Bull" for beer in *Paine's Trade Mark* (9 R.P.C. 130) was said to suggest beer of such a kind as an Englishman would like. [FARWELL, J.—That was a decision as to a word said to be a fancy word.] In *Arbenz's* application (4 R.P.C. 143, L.R. 35 Ch. D. 248) "gem" was held to be descriptive of quality. "Quaker" applied
- 30 to an article is a word of commendation. Under Section 73, if it conveys that the article is drunk by or associated with Quakers in any way, that is untrue, and the Trade Mark is calculated to deceive. In the United States registration was refused of a Mark which contained the words "Knights of Labour," the Applicants having no connection with the Society of that name (*Sebastian* on Trade
- 35 Marks, p. 351). The Mark is also disentitled to protection as calculated to give offence to a large body of the King's subjects. The decision in *Clark v. Freeman* (11 Beav., 112) has been constantly disapproved. Although the use of the Mark could not be restrained, it should not be allowed the benefit of registration. [FARWELL, J.—Do you put it on the ground of imputation?] No, but that it is
- 40 offensive; it is not necessary for the present purpose that the Mark should be libellous. Section 73 forbids the registration of a scandalous design, and Section 86 of a Mark contrary to law or morality. I rely on the Mark being offensive. Suppose one registered "Wesleyan Whiskey," could that be allowed? [FARWELL, J.—Is "Plymouth Gin" scandalous?] The Applicants
- 45 are persons aggrieved (*Powell's Trade Mark*, 11 R.P.C. 4; L.R. (1894) A.O. 8). The purity of the Register is of importance (*Paine and Co. v. Daniells and Sons' Breweries*, 10 R.P.C. 217; L.R. (1893) 2 Ch. 567). Any conduct interfering with the ordinary enjoyment of life may be a nuisance at Common Law (*Lyons & Sons v. Wilkins*, L.R. (1899) 1 Ch. 255).

- 50 *Terrell*, K.C.—The Applicant is not a person aggrieved; he has no interest. On the Applicant's own case, if the word was thought to have any reference to the goods, the representation would be that the liquor was non-intoxicant. [He was stopped by the Court.]

- FARWELL, J.—Surely an enemy of the Society of Friends must have prompted
- 55 this Motion. The reputation of the Society of Friends stands so high that it is idle to suppose that they could suffer any injury from the fact that a firm of liquor sellers have registered as a Trade Mark the word "Quaker" for fermented

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liquors and spirits, not including whiskey. I do not sit here to deal with sentimental objections, but to administer the law as I find it.

First of all, in order to succeed, the Applicants have to show that they are persons aggrieved. Now the Society of Friends is one which has commanded the respect of the world for at any rate a great many years, although no doubt they had a somewhat tempestuous origin; but it is no part of their tenets to be total abstainers—temperance, I agree, is one. Some people think that total abstinence is not temperance, any more than excess of drinking is temperance. It is not for me to say whether it is so or not; but it is not one of the tenets of the Society of Friends that they are to be total abstainers. Total abstinence is not enjoined by any law, nor is it illegal, nor is it any imputation on any man to say that he is not a total abstainer. The liquor trade is a perfectly lawful trade; it is not any imputation on a man to say that he deals in liquor. All these things are so elementary that I am really at a loss to understand how it is that the Applicants have launched this Motion. They say they are persons aggrieved. They would be the last to suggest that they are interested in the liquor trade, or that they have any business interest to serve in taking this Mark from the Register. The definition of persons aggrieved is to be found in many of the cases. I will take one from *Riviere's Trade Mark*, reported in 53 Law Times N.S. 237. It includes: "Every person who will in reasonable probability suffer any injury or loss (using those words in a legal and not in a sentimental sense) from the other persons claiming to use it." It seems to me to be perfectly obvious that no legal damage can accrue to the Society of Friends, or to that portion of the Society of Friends who are total abstainers, from the use of this Trade Mark. That in itself would be sufficient to dispose of the Motion.

Secondly, it is said that this Trade Mark is bad because it is not within Section 64, sub-Section (e), as it has reference to the character or quality of the goods. Well, this is the first time that I have ever heard any such suggestion. The case before Mr. Justice *Kekewich* of "John Bull" was on the section of the old Act. That was a fancy word; but, to say that the word "Quaker" has reference to the character or the quality of the liquors appears to me to be really too fantastic; and, supposing I held that a word of that sort did refer to the character or quality of the goods, I should have at least twenty-five words and marks, which have been called to my attention, probably attacked as being open to a similar objection. No one has ever thought of raising the point before, and it appears to me to have nothing in it.

Then it is said that the Mark is within Section 73—that it is calculated to deceive, or otherwise is disentitled to the protection of the Court. I absolutely fail to see how it is calculated to deceive any one. Nobody in his senses could suppose that it represents that it is made by Quakers, or drunk by Quakers, or sold by Quakers. It simply is a word which the Respondents have chosen, because it has no reference whatever to the liquors at all. To say that it is disentitled to protection, is, in effect, to put forward a sentimental objection because a certain number of the members of the Society of Friends, including those who make affidavits upon this Motion, are total abstainers. I have already pointed out that to sell liquor, and the consumption of liquor in moderation, carries with it no imputation on any man's moral character, and to say that this is a suggestion of scandal, or immorality, or anything of that sort, against the body of Quakers seems to me to be absolutely extravagant. I cannot think that the character of the body of Quakers stands in need of any assistance from this Court to prevent it suffering from any imputation, caused by a Trade Mark of this nature, that they are indulging either in the sale of spirituous liquors, or in the drinking of spirituous liquors.

I must refuse the application with costs.

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IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, and COZENS-HARDY.

July 12th and 13th, and August 11th, 1904.

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5 *Design.—Action for infringement.—Validity of registration.—Patent granted on application prior to registration of Design.—Novelty.—Defendants threatening to sell after knowledge of registration.—Marking of articles.—Judgment for Plaintiffs.—Appeal dismissed.—Patents, &c., Act, 1883, sections 51, 58, and 59.*

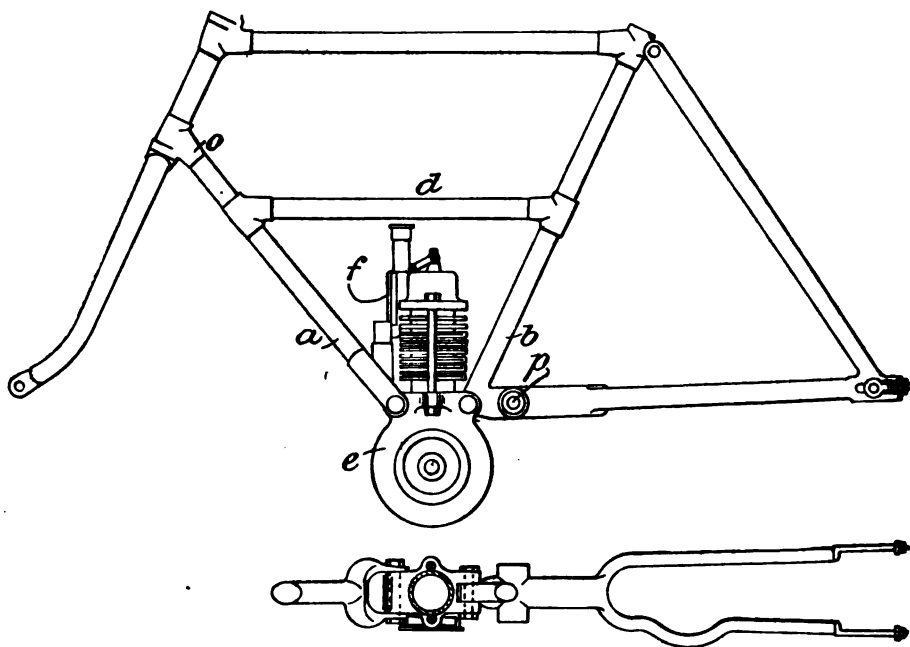
On the 18th of November 1901, M. W. and E. W. registered a Design
10 applicable "for the pattern as shown of a motor-cycle frame," and the registered proprietors of the Design subsequently commenced an action for infringement. The Defendants denied infringement, and alleged that the registration was invalid for want of novelty; they also alleged that the sales made by them before action had been made without knowledge of the registration of the Design,
15 and at the trial they contended that, although they had made a few sales after the commencement of the action, they had never threatened to do any wrongful act, since on the evidence the copyright had ceased under section 51 of the Patents, &c., Act, 1883, by reason of insufficient marking of articles by the Plaintiffs; they further alleged that a Patent had been applied for on the
20 8th of November 1901 for a frame for motor-cycles the same as that shown in the Design, and that, the Patent having been granted on an application made before the application to register the Design, the registration of the Design was invalidated by reason of a prior grant of exclusive rights in the article. It was held by Byrne, J., at the trial, that the Design was novel, and that the
25 design of the machine sold by the Defendants was, with the exception of immaterial details, identical with the registered Design; that the fact of the registration was unknown to the Defendants before action, and their acts until then were protected as far as penalties or damages were concerned, but that having regard to the subsequent sales and the position taken up by the
30 Defendants on the motion and subsequently, the Plaintiffs were entitled to an injunction against infringement; that there was no evidence of articles insufficiently marked having been sold; and that the registration of the Design

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was not invalidated by the Patent, because, first, the Design was registered before the actual grant of the Patent; secondly, that the right of copyright in a Design is not a grant but is statutory; and, thirdly, that rights under a Patent and in a Design are separate and distinct and may co-exist. An injunction was granted with costs, and by arrangement the Plaintiffs accepted 5 a fixed sum for damages. The Defendants appealed

Held, that the learned judge was correct in his finding of the facts; that in the circumstances the registration of the Design was valid, and that the applicant for a Patent for an article, and for registration of a Design for the shape of a similar article is not, under the Patents &c. Act, 1883, put to an 10 election, but may secure both. The Appeal was dismissed with costs.

On the 18th of November 1901, M. Werner and E. Werner registered a Design (No. 383,283) in Class 1 applicable "for the pattern as shown of a motor-cycle 15 "frame." A representation of the Design as registered is shown below, except that the lettering of the parts has been added for the purpose of this report.



On the 18th of April 1902 the Design was assigned to *Werner Motors, Ltd.* On the 1st of August 1902 *Werner Motors, Ltd.*, commenced an action against *A. and W. Gamage, Ltd.*, for infringement of the Design, claiming an injunction, damages or an account of profits, delivery up, and costs.

The Plaintiffs by their Statement of Claim alleged—(1) the registration of 20 the Design, and that it was a new and original Design not previously published in the United Kingdom; (2) that the Defendants had, without the written licence or consent of the Plaintiffs, applied and caused to be applied such Design or a fraudulent or obvious imitation thereof for the purpose of sale to motor

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bicycles, being goods within Class 1; (3) that the Defendants had sold and offered for sale, and were still selling and offering for sale, motor bicycles constructed according to such Design or a fraudulent or obvious imitation thereof, well knowing that such Design had been used or applied by them
 5 without the consent of the Plaintiffs; (4) that the Plaintiffs complained in particular that, on the 29th day of July 1902, the Defendants sold to *Rowland James Moon*, at their premises in Holborn, in the City of London, a motor cycle to which the said Design No. 383,283 had been wrongfully applied as aforesaid; by (5) the Plaintiffs claimed the right to recover compensation in
 10 respect of all infringements; and (6) they alleged injury to their business.

By their Defence (which is fully set out in the report of the trial *ante* p. 139) the Defendants denied infringement and the novelty of the Design; and alleged various prior publications, the only ones relied on by them at the trial being Figs. 1 and 9 of the Specification of Letters Patent granted to *Chapelle and Chapelle* (No.
 15 13970 of 1899) and an illustration on page 359 of the "Motor Car Journal" dated the 28th of July 1900. The Defence concluded with the following paragraph:—
 "The said Design was registered in this country on the 18th day of November 1901 in the names of *Michel Werner* and *Eugene Werner*; that on the 8th of
 "November 1901 one *A. F. Spooner*, as agent for the said *M. and E. Werner*,
 20 "applied for Letters Patent in this country in respect of an invention of
 "'Improvements in frames for motor bicycles and other vehicles,' which frames
 "were in all respects identical with the said Design, and Letters Patent in
 "respect of the said invention were subsequently granted and dated the 8th of
 "November 1901; the Defendants would contend that, in these circumstances,
 25 "the registration of the said Design was invalid and was contrary to the policy
 "of the Act and was a fraud on the Crown."

Figs. 1 and 2 of the Complete Specification, filed the 8th of August 1902, of *Spooner's* Patent (No. 22,563 of 1901, granted on a communication from abroad by *M. Werner* and *E. Werner*), were, with the addition of some detailed
 30 matter, substantially identical with the registered Design.

The claims were as follows:—"1. A frame for motor cycles characterized by
 "the arrangement instead of and in the place of the ordinary pedals, at the
 "angle formed by two adjacent tubes of the frame, of an opening allowing of
 "the placing of an engine suitably fixed to the said tubes but being preferably
 35 "secured by means of a fork *i* formed on one of the tubes *a* and connected to
 "an ear *h* extending the width of the casing *e*, the other tube *b* being connected
 "between the parts of the other ear *g* of the casing opposite to the first ear *h*;
 "the part *b* of the frame being formed with the head of the back stay *c* carrying,
 "itself, the pedal-crank axle *p*; all with the object of assuring greater stability
 40 "while running and to facilitate the fixing of the engine. (2) A frame for
 "motor cycles constructed substantially as described with reference to the
 "accompanying drawings."

The Complete Specification was left on the 8th of August 1902, and accepted on the 23rd of October 1902.

45 Fig. 2 of *Chapelle's* Specification, which was the anticipation chiefly relied on at the trial, is, so far as material, shown on p. 624.

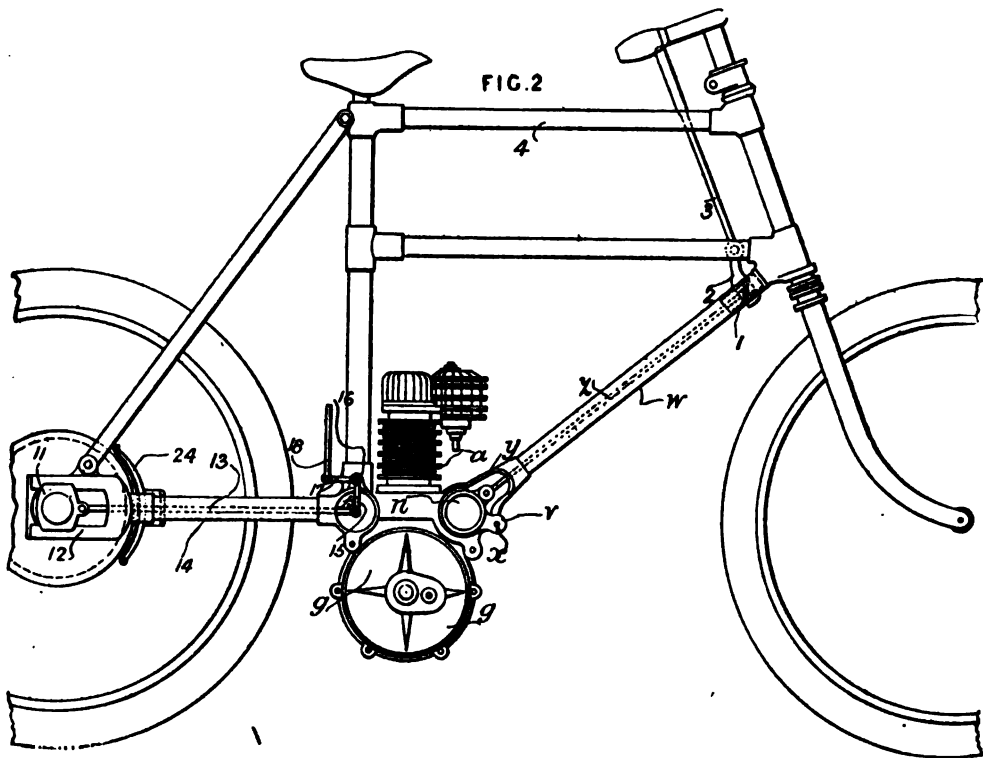
The following is an extract from the description of the *Baines* motor bicycle in the "Motor Car Journal":—"The bottom tube is divided, and, with the seat
 "tube or diagonal which is also bifurcated, forms the frame for the motor.
 50 "No pedals are fitted—that is, revolving pedals—the bottom bracket or pedal
 "crank bearing being done away with."

At the trial the Manager and Secretary of the Plaintiff Company stated in cross-examination that a second Design had been registered in November 1902, which differed from the one in question only by an inch or two in one of the
 55 dimensions and that cycles made according to the second Design had only the second registration number. The Defendants then raised the point that the Plaintiffs had not always complied with section 51 of the Patents, &c. Act,

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1883, as to the marking of articles, and alleged that, on the evidence, the copyright in the Design had ceased. The facts, as they alleged them on this point, were that a Design was in November 1902 registered by the Plaintiffs which was practically the same as the Design sued on, and that articles made according to the second Design, and therefore according to the first Design 5 substantially, had been sold without being marked with the number of the first Design. But *Byrne, J.*, found that no sale of such articles had been proved.

The Plaintiffs moved for an interlocutory injunction, but the Motion was ordered to stand to the trial, the Defendants having undertaken to keep an 10 account. The Defendants put in evidence on the Motion to prove delay in taking proceedings on the part of the Plaintiffs, but they did not state that they did not intend to sell in future.



The action was tried by *Byrne, J.*, who on the 21st of December 1903, gave judgment for the Plaintiffs, holding that the Design was novel and that the 15 Defendants' machine was, with the exception of immaterial details, identical with the registered Design; that the fact of the registration was unknown to the Defendants before action and their acts until then were protected as far as penalties or damages were concerned, but that having regard to the subsequent 20 sales and the position taken up by the Defendants on the Motion and subsequently, the Plaintiffs were entitled to an injunction; that there was no evidence of articles insufficiently marked having been sold; and that the registration of the Design was not invalidated by the Patent.*

* *Ante*, p. 137.

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An injunction was granted, and by arrangement, the Plaintiffs accepted an agreed sum for damages.

The Defendants appealed.

On the hearing of the appeal, *Cripps*, K.C., *T. Terrell*, K.C., and *J. C. Graham* 5 (instructed by *Ward, Perks, and McKay*) appeared for the Appellants; *A. J. Walter* and *D. M. Kerly* (instructed by *J. B. and F. Purchase*) appeared for the Respondents.

Cripps, K.C., and *T. Terrell*, K.C., for the Appellants.—The application for registration of a Design is made under sections 47 and 48 of the Patents, &c., 10 Act, 1883. In a Design it is the shape or configuration alone that is to be considered. The learned judge fell into the error of taking into consideration the functions of the parts of the frame as if it were the case of a Patent. A Patent was applied for on the 8th of November 1901 (No. 22,563) and a complete Specification was filed on the 8th of August 1902, but its publication 15 by reason of Section 13 of the Act of 1883 dates from the 8th of November 1901. The Drawing attached to the Complete Specification is identical with the registered Design and the particular form shown is made the subject of the claims. The chief anticipations are the illustration on page 359 of the "Motor Car Journal" of the 28th of July 1900 and the Drawings in *Chapelle's* Specification. 20 Tested by the eye there is nothing "new or original" in the Design as registered compared with the *Chapelle* Drawing. The only novel feature is that the second bar is placed slightly lower down. The Patent (No. 22,563) was acquired by the Respondents and used for blocking purposes, as they made no machines in this country, but imported them from Paris. The Design was registered 25 with the same object. It is the mere form of the Design and not the function that is to be considered (*Hecla Foundry Co. v. Walker & Co.*, 6 R.P.C. 554; L.R. 14 App. Cas. 550). [VAUGHAN WILLIAMS, *L.J.*—One must look at it with regard to convenience and not merely æsthetic merit.] One must not consider either utility or function. The Design must be new or original, and it is not 30 a question of details of difference being numerous or not (*Rollason's Design*, 15 R.P.C. 441; L.R. (1898) App. Cas. 499). Here there is nothing new or original in the Design itself, the novelty is merely the lowering of a bar. One must consider the nature of the article to which the Design is applied. The rule is laid down by *Bowen, L.J.*, in *Le May v. Welch* (L.R. 28 Ch. D. at p. 34), 35 there must be "a substantial novelty in the Design having regard to the nature of the article." Were this not the rule, trade in any article might be seriously hampered. In this instance this registration would interfere with the cycle trade for five years. In the case of the *Hecla Foundry Co. v. Walker & Co.* (6 R.P.C. 554; L.R. 14 App. Cas. 550) Lord *Herschell* (at p. 554) laid down the 40 rule that protection is given to the shape and to that alone. [COZENS-HARDY, *L.J.*—That was not a case of revocation at all.] [*Kerly*.—The registration had been challenged previously in *Walker & Co. v. Falkirk Iron Co.*, 4 R.P.C. 390.] [VAUGHAN WILLIAMS, *L.J.*—Section 47 (3) requires that the class be specified. If a Design be registered in one class would it be "new or original" 45 in another subsequently?] In *Bach's Design* (6 R.P.C. 376; L.R. 42 Ch. D. 661) it was held that it must be new or original apart from the class in which it was registered. The Patent was taken out for identically the same thing as the Design. The Applicant cannot have both grants. Publication of the Specification is not necessary for our case on this point, it is a case of "prior grant." 50 The Patent involves the Design. [ROMER, *L.J.*—A man registers a Design and subsequently takes out a Patent for the same article. Why should his Patent be bad? You cannot possibly make a Patent of a Design.] Supposing that he registers a Design, and then he takes out a Patent for the combination of parts performing the functions the Design suggested, and then assigns 55 each to different parties. [VAUGHAN WILLIAMS, *L.J.*—The first assignee will have his rights, and the second must be subject to them; he is in no better position than the assignor.] It is really a question of Patent

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law. A Patent cannot be granted to A and subsequently to B for the same thing. Two identical monopolies cannot co-exist. There is no difference in the case of a Design. Both grants are made under the Act of 1883. A prior Patent is a ground of opposition to the grant of a Patent under Section 11 of that Act. [ROMER, *L.J.*—When he filed his Provisional 5 Specification he might not have been sure whether the thing was patentable at all.] [VAUGHAN WILLIAMS, *L.J.*—Your argument is that registration of the Design should not have been granted. If you wish to impeach the validity of the registration you should have a Motion to rectify the Register.] That point has never been raised. [VAUGHAN WILLIAMS, *L.J.*—You may amend.] If A 10 files a Provisional Specification, and then B registers a Design for the same thing, next A files his Complete Specification and obtains his Patent; A is the first grantee, and can prohibit the use of the article by all, including B. A grant cannot be made to A subject to the rights of B, but only in accordance with the Statute of Monopolies. The copyright in this Design had ceased 15 before judgment was delivered, because bicycles were sold not marked with the prescribed mark. [Walter.—This was not raised in the Pleadings.] The Plaintiffs were not entitled to damages up to the date of the writ, as the Defendants had no knowledge of the registration, and their right to an injunction was gone before judgment. [Evidence as to alleged sales of 20 unmarked articles was read.] When selling the improved Design both the prescribed marks of the old and improved Designs should have been on the articles. [ROMER, *L.J.*—If the Defendants had proper notice they might have given evidence as to the identity of Designs.] [Walter.—The improved Design was never before the Court.] The matter was argued, however, and 25 dealt with in the judgment. [VAUGHAN WILLIAMS, *L.J.*—We have considerable doubt as to our being able to deal with the question of validity of registration when there is no Motion to rectify the Register.] [ROMER, *L.J.*—Are the Respondents prepared to treat this as a Motion to rectify?] [Walter.—We cannot. The Comptroller-General is not before the Court. We admit that 30 invalidity as regards registration is a good defence to an action for infringement, and in that way between the parties we will take it as if there was such a Motion.] [VAUGHAN WILLIAMS, *L.J.*—We cannot have this case cited as an authority that a Motion to rectify is unnecessary.]

Walter and Kerly for the Respondents.—The Design must be “new or 35 “original”—that is, not previously published in the United Kingdom (section 47). If the Design or drawing were shown to a third party it would not be new or original (*Blank v. Footman & Co.* 5 R.P.C. 653; L.R. 39 Ch. D. 678); *Winfield v. Snow* (8 R.P.C. 15). The evidence shows it was new and original in this country. [The evidence was referred to in detail.] Novelty is to be tested by 40 the evidence of persons who are familiar with the class of articles in question; Prof. Boyes said it struck him as being new. [VAUGHAN WILLIAMS, *L.J.*, referred to Lord *Herschell's* test of comparing the Designs side by side in *J. Harper & Co. v. Wright, &c., Ltd.* (12 R.P.C. 483; L.R. (1896) 1 Ch. 148.)] That case was one of infringement, and Lord *Herschell* found that the design 45 was a new one; it differed mainly from the older one in having a wider base. The Collar case (*Le May v. Welch, ubi supra*) is distinguishable; there were enormous numbers of collars on the market of all shapes. In this case one novel feature was removing the bar out of a place in which it had always been put and placing it lower down. To the mechanic this would suggest a great 50 deal more than mere change of form. There is no rule that one cannot consider function. The Design is solid and not a mere drawing. The chief differences between our Design and the alleged anticipation are—the cross bar *d* springs from a different place; the tube (*w*) in the *Chapelle* Drawing is not bifurcated as in the corresponding one (*a*) in the Design, and the end of it is not attached 55 to the motor: the crank axle is in front of the motor and not behind, as in the design; the “Motor Journal” illustration shows this difference plainly. Again

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there is no open space in the *Chapelle* Drawing as in the Design. The frame connection in the *Chapelle* Drawing is different, and is described in words in the "Motor Car Journal." [VAUGHAN WILLIAMS, *L.J.*—So far as outline is concerned, the difference is the bar is in a lower position, the rest is the same

5 whether it consists of one piece of metal or three.] The Design must be looked at with an "instructed" eye. [Mr. *Boult's* evidence was then referred to.] The Design is addressed to makers of cycle frames who would recognise that there was a great difference in function produced by the change of lowering the bar.

10 [VAUGHAN WILLIAMS, *L.J.*—Section 60 of the Act of 1883 refers to the Design being applicable for the pattern, or for the shape or configuration, or for the ornament. You may claim for all those or for only the pattern, and the Court will look at it to see if the Design really goes further.] The whole must be judged when looked at. [VAUGHAN WILLIAMS, *L.J.*—If there be a striking novelty in part of the Design are persons required to compare all the details?

15 They may not be of the essence of the Design.] The whole of the Design must be compared. As regards Prior Grant the analogy from Patent Law is misleading. Copyright in Designs is quite modern, and is the creation of Statute. The Acts relating thereto were consolidated in the Patents Designs and Trade Marks Act 1883, which dealt mainly with procedure in the case of

20 Patents, and established one office to administer the laws relating to Patents, Designs and Trade Marks under one Comptroller-General and the Board of Trade. In the case of a Design the Comptroller-General cannot exercise a discretion as the grant is statutory; any valid objection to the registration must be found in the Act itself. The grant of Patents by the Crown depends on the

25 Common Law and the Statute of Monopolies, and the more modern Acts deal only with procedure. It has been supposed, but never actually decided, that if two Patents be granted for the same invention the first grantee could obtain a *scire facias* to revoke the second grant. Section 26 of the Act of 1883 abolished *scire facias*, but enacted that the grounds on which *scire facias* could have been

30 obtained to repeal a Patent should be grounds for a petition for revocation, or defence to an action. It is only by reason of that provision that "Prior Grant" is alleged to be a ground for invalidity of a Patent. There never was any procedure in the case of Designs similar to *scire facias*. [COZENS-HARDY, *L.J.*—Section 90 of the Act of 1883 as applied to Designs appears to correspond with

35 revocation in the case of a Patent.] There is no procedure by which a Design can be invalidated or refused. [VAUGHAN WILLIAMS, *L.J.*—I am by no means satisfied on the construction of this Statute that we can recognise two grants for the same thing.] They are not the same. The Crown does not grant the same thing over again. Section 60 shows that the subject-matter of a Design is

40 purely shape. A Patent is only for a manufacture; shape may incidentally be of importance. In a Design it is a complete answer to an allegation of infringement to show that the tubes were altered in shape, or set at different angles. In a Design one must not use the same shape, in a Patent one must not use the same invention. It is a mere accident when the same article can be

45 protected in both ways (*Rogers v. Driver*, 20 L.J.Q.B. 31; *Hecla Foundry Co. v. Walker & Co.*, 6 R.P.C. 554, L.R. 14 App. Cas. 550; *Walker v. Falkirk Iron Co.*, 4 R.P.C. 393). [ROMER, *L.J.*—The most it comes to is that the Patent might be bad.] If one applies for both simultaneously the applications go before different people in the office. They are applied

50 for in duplicate every day and afford a "compound protection." [VAUGHAN WILLIAMS, *L.J.*—This is the first case of compound protection. You bring an action for infringement of your Design which turns out to be identical with your Patent.] We have paid double fees and claim the benefits that result from both Patent and registration of Design. There is nothing in the Statute

55 to put the applicant to election and nothing in the rights conferred to require it. A similar case occurs when Trade Mark and artistic Copyright overlap, when something the subject of copyright is registered as a Trade Mark. If the

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registration be objected to on this ground the Comptroller-General should have been made a party to these proceedings. As to the alleged sale of goods not bearing the prescribed marks, we were never asked at the trial to deal with that point at all. It is suggested that we lost the right to an injunction that we had in August 1902, but that issue was not raised on the Pleadings. [VAUGHAN-WILLIAMS, *L.J.*—The circumstances might occur after the action was brought. This matter was not pleaded because it had not then arisen.] The Defendants decided not to amend their Pleadings. If the newer pattern had the new number that was sufficient: *Harper & Co., Ltd., v. Wright & Butler, &c., Co.* (12 R.P.C. 491; L.R. 1896 1 Ch. 142). [The second Design was produced to the Court.] An old Design with small variations may be registered. Whether the variations be substantial depends on expert evidence. [COZENS-HARDY, *L.J.*—It must be substantially novel or substantially original, having regard to the nature and character of the subject-matter: *Le May v. Welch*, per *Fry, L.J.*] That was the case of a collar in which expert evidence would not be required. Here we protested against the evidence about the second Design at the time. The witnesses never saw the drawings of the newer registered Design at all. We had no opportunity of enquiring or proving that the Plaintiffs "took all proper steps to insure the marking of the article" (*Wittman v. Oppenheim*, L.R. 27 Ch. D. 260). The learned judge found that there was no sort of evidence that before delivery on sale any article was not caused to be duly marked.

VAUGHAN WILLIAMS, *L.J.*—This is an Appeal in an Action brought for infringement of a registered Design for motor cycles against a decision of the late Mr. Justice *Byrne*, whereby he gave Judgment against the Defendants, and granted an injunction against the Defendants together with an agreed sum for damages.

The Plaintiffs, by their statement of Claim, claimed an injunction to restrain the Defendants from applying, for the purpose of sale to motor cycles without licence or written consent from the Plaintiffs, the said registered Design or any obvious imitation thereof, and from selling or offering for sale such motor cycles in infringement of the Plaintiffs' registered Design. The Defendants denied infringement and alleged that the registration was invalid for want of novelty, and alleged that the sales made by them before Action had been made without knowledge of the registration of the Design, and denied the intention to do any wrongful act, and by the last clause in their Defence set up that the registration of the Design was invalidated because a Patent had been applied for on the 8th of November 1901 (that is to say ten days before the registration of the Design) for a frame for motor cycles the same as that shown in the Design, and that the Patent having been granted on an application made before the application to register the Design, the registration of the Design was invalidated.

At the trial the Defendants also contended, although the defence was not pleaded, that the copyright of the Plaintiffs had ceased because the Plaintiffs registered another Design practically identical with that sued on, and sold machines made according to the latter design without the number of the design on them. There was no amendment of the Pleadings, but Mr. Justice *Byrne* disposed of this defence by finding that it was not proved in fact. Mr. Justice *Byrne* found that the Design was novel; that the Defendants had infringed; that the fact of registration was unknown to the Defendants before Action, and that their acts until then were protected so far as penalties or damages were concerned; but having regard to the subsequent sales, and the position taken up by the Defendants on the Motion and subsequently, absence of knowledge of registration at the date of the Writ did not protect the Defendants as to such matters; but that the Plaintiffs were entitled to an Injunction and the agreed damages. I agree with all the findings of fact by Mr. Justice *Byrne*, and therefore the only question which has to be disposed of is the question of law

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raised in the last clause of the Defence, viz. :—Is the registration of the Design invalidated by the grant of the Letters Patent ?

Section 13 of the Patent Act of 1883 provides that every Patent shall be dated and sealed as of the date of application, provided that no proceeding shall
 5 be taken in respect of an infringement committed before the publication of the Complete Specification. The dates in the present case are—Date of Application, November the 8th 1901 ; Complete Specification left, August the 8th 1902 ; Accepted, October the 23rd 1902. The registration of the Design was on November the 18th 1901, and, therefore, after the date of application for the
 10 Patent ; but before the leaving of the Complete Specification.

Now, on these dates, does the Patent invalidate the registration of the Design ? It is said that it is invalidated because the Crown cannot grant the sole right of manufacturing an article to two different persons, and can, by the Statute of Monopolies, only grant such right to the first and true inventor.
 15 It is urged that having regard to the dates in this case, the Crown had, before the date of the registration of the Design, already granted the sole right to make the article before the Design was applied for. A purchaser, it is said, from the Patentee is entitled to do what he likes with the article he has bought, and ought not to be prevented by the proprietor of the registered Design from so
 20 doing. This contention has, at first sight, considerable force, but I think the answer is, that the logical result of this argument, if sound, is that there cannot be a Patent and a Design for the same article.

This, I think, is not supported by authority. The grant of Letters Patent and the Statutory Copyright of the proprietor of a Design, are different in their
 25 legal nature and effect. There is only one grant, that is of the Letters Patent, not of the Copyright. The Copyright only gives protection to the shape and configuration, although the result of such protection may be to secure important advantages, such as attend a mechanical contrivance, which might be good subject matter for a Patent ; see the Judgment of Lord *Herschell* in *Hecla*
 30 *Foundry Co. v. Walker, Hunter & Co.* in L.R. 14 App. Cas. p. 550 to 555 (6 R.P.C. 554). The fact that the design is calculated to serve some useful purpose leaves it open to every member of the public to attain the same end by using an article which differs from it in shape and configuration ; see *per* Lord *Watson* in the same case, p. 557.

Mr. Justice *Byrne* says that the patent right and the copyright may co-exist. I think this is right ; but I do not mean to say that registration of a Design which happens to secure mechanical advantages may not, as an anticipation, prevent the grant of subsequent valid Letters Patent. I think it might do so, whether the Applicant was the proprietor of the Design or a stranger.

It is suggested in this case that the grant of the Letters Patent, having regard
 40 to the date of Application, and therefore of the sealing, prevents the Design being new and original within the meaning of section 47 of the Act of 1883. In the case of a stranger to the Letters Patent, this clearly would not be the result. Can it be the result that in the case of a Patentee who registers the
 45 Design between the date of the Provisional Specification, without Drawings, and a Complete Specification with a Drawing identical with the Design ? I think not, unless one can say that the Patentee is in some way estopped from asserting the truth that the Design at the date of the Application to register was new, because he subsequently obtained Letters Patent, having a statutory date
 50 prior to that of the application to register the Design. I have some doubt on this point, but on the whole I regret to say I cannot find an estoppel or any ground for putting the Plaintiffs to an election between the Letters Patent and the Copyright of the Design. I say I regret, because I think what has been done here is an abuse of that part of the Act of 1883 relating to Designs. The
 55 legislature never intended that the copyright of Designs should be used to protect monopolies the subject of Letters Patent.

For the reasons I have given, I think this Appeal must be dismissed.

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ROMER, *L.J.*—In most cases it will be very difficult for a Patent right in respect of a new article, and the right to a Design registered under the Act for the shape of the article, to co-exist. For example, if the Patent is first and the patented article is published to the world, a design of that article cannot afterwards be held novel so as to justify a subsequent application for registration under the Act. If the Design of the article was first registered and published, there could not be a subsequent Patent merely for that article without any substantial alteration; but in some circumstances the two rights may, I think, co-exist, as in the present case, where there is first the Provisional Specification and no publication of the patented article before registration of the Design of the article under the Act, and that is followed by the Complete Specification. Under such circumstances, I think the two rights being not necessarily the same may exist together, though, no doubt, to a certain extent they may overlap and interfere the one with the other; but, I think the difficulty is met by saying that the right, second in point of time, must be held subject to the first right. In the case of a patented right, seeing that the Patent dates as from the Provisional Specification, that gives rise, as in the present circumstances, to some, but, I think, no insuperable difficulty. After the Provisional Specification and before the Design was registered, there was no publication of the patented article. Take then the case where there is an independent inventor of the Design ignorant of the Provisional Specification, and, of course, there being no publication, wholly ignorant of the patented article, and his Design, at the date of his application for registration, being novel, he obtains registration of it. It appears to me that in that case he would be entitled to say that he had a good registered Design under the Act, and though, when the Patent was subsequently protected by the final Specification, so that the patented right dates from the date of the Provisional Specification, the only effect of that would be that the owner of the registered Design must take subject to the Patentee's rights. But I cannot see in such a case as I have stated why the grant of the Patent, on the subsequent filing of the Complete Specification, should destroy the effect of the registration of the Design, which, as I have pointed out, was, at the date of the registration, perfectly good.

It was suggested, however, that though two independent persons might, under the circumstances I have indicated, have independent rights in the Patent and the Design, yet the same person could not hold both. I do not, on consideration, see sufficient reason for so deciding. If two independent persons could hold the rights, I do not see why one person should not also hold both. Consider the case of a Patentee who files his Provisional Specification. He may be in doubt whether his Patent will ultimately be held good, though he hopes and believes that it is good; but he is perfectly certain, at any rate, that so far as the Design of the article is concerned it is perfectly novel, and that he is entitled to have that Design registered. Therefore, after filing his Provisional Specification, he applies for the registration of the Design, and the Design is duly registered, and he acquires rights under that registration. Then suppose that, contrary to his hopes, his Patent was held bad, is there any reason, under those circumstances, why he should not still hold the rights he obtained by the registration of the Design? Is he to be held to have lost his right to the Design, which is otherwise good, merely because, under the circumstances I have indicated, the Patent is held bad? I think not. No doubt there may be difficulties arising about damages in a case where an infringer of the Patent is sued both by the Patentee for infringing the Patent, and by the owner of the registered Design for infringing the Design. I think any difficulty that arises with regard to damages in such a case will be adequately dealt with by the Court when the difficulty arises. I have no doubt the Court, in such a case, will see its way to do substantial justice, and I think it will be borne in mind by the Court in dealing with such a case, that one of the two rights must of necessity be held subject to the other *inter se*. I think, therefore, that in this

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case the Appeal must be dismissed, as I cannot differ from the conclusion arrived at in the Court below that there was good subject for the registration of the Design belonging to the Plaintiffs, and that the right of the Plaintiffs, in respect of that registered Design, has been infringed by the Defendants.

5 COZENS-HARDY, *L.J.*—This is an Appeal from the decision of Mr. Justice *Byrne*, who has granted an injunction restraining the Defendants from infringing a registered Design.

On the 8th of November 1901, Messrs. *Werner*, through whom the Plaintiffs claim, applied for Letters Patent for improvements in frames for motor cycles and other vehicles. The Provisional Specification of that date contained no
10 drawing, but the essential feature of the invention seems to have been to secure a space or opening in the angle formed by the lower frame member and saddle tube, in which the engine could be placed. Ten days later, that is to say, on the 18th of November 1901, Messrs. *Werner* registered the Design in question.
15 On the 8th of August 1902, their Complete Specification was filed, and it contained a drawing identical with the registered Design.

On the part of the Appellants, three points have been raised. First, it is said, that the right acquired by registration of Design on the 10th of November is, in some way, lost or affected by the grant of the Letters Patent, which, when
20 granted, bore date the 8th of November 1901, inasmuch as protection of the Design for five years is inconsistent with the protection they acquired by the Patent for 14 years from an earlier date. I do not think this argument can prevail. It seems to me that a monopoly right was acquired by registering the Design on the 18th of November, and that this right was in no way prejudiced
25 or affected by the application, in the Complete Specification, of this registered Design to the patented article. The Patent is not for the registered Design. The Patent may be used or infringed in many ways not involving the use of the registered Design. The Plaintiffs in this action do not complain of an infringement of the Patent, but solely of an infringement of the registered Design.

30 In the second place it is contended that the Design is not a new or original Design within the meaning of the Act of 1883. This really depends upon a comparison between the registered Design and *Chapelle's* motor bicycle, a print of which was published in the "*Motor Car Journal*," of the 28th of July 1900. At first I was impressed by the similarity of the two, but on consideration I
35 think the objection ought not to prevail. No doubt it is a question to be judged upon a view of the two, but regard must be had to the fact that each represents a motor cycle, and I think there is sufficient peculiarity in the position of the engine in the lower part of the Plaintiffs' drawing to distinguish it from *Chapelle's*. I do not attach so much importance to the different position of the cross-bar,
40 though this cannot be wholly disregarded. Upon the whole I see no sufficient reason for differing from the decision of the learned Judge on this point.

In the third place it was contended that by reason of section 51 of the Act of 1883, the Plaintiffs were not entitled to an Injunction inasmuch as, after action brought and before trial, cycles to which the registered Design had been applied
45 had not been marked with the prescribed mark before delivery on sale. This point was not raised in the Pleadings, but it rose on the cross-examination of the Manager and Secretary of the Plaintiff Company. It is suggested that the Plaintiffs registered a second Design only colourably differing from the first registered Design, and attached the second number only to the cycles so sold.
50 But in my opinion the evidence is not sufficient to prove the facts alleged. The second registered Design was not put in evidence in the Court below, and I am not satisfied that it differs from the first only in colourable details. No proof of actual sale was given, and I think it would be dangerous to allow the Plaintiffs' title, if otherwise unimpeachable, to be defeated by means of
55 evidence so loose and unsatisfactory.

In my opinion this Appeal must be dismissed with costs.

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IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, AND COZENS-HARDY

August 1st and 2nd, 1904.

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Patent.—Action for Infringement.—Construction of Specification.—Issue of 5
Infringement.—Judgment for the Plaintiff at the trial.—Appeal by Defendant
allowed.

The Specification of Letters Patent claimed “a Clinical Thermometer
“having two or more chambers formed within the bore of the tube and a
“comparatively open contraction within each chamber substantially as herein 10
“shown and described, and for the purpose stated.” The owner of the Patent
brought an action for infringement of the same, in which the Defendant
relied on non-infringement. In the Defendant's thermometer there were two
contractions, but, at all events in its final state, only one chamber. The
object of the two contractions was to overcome the difficulty which existed with 15
one contraction only, in obtaining the return of the mercury after the
temperature has been read; the chambers were necessary in manufacture for
the purpose of obtaining the contractions. Each of the Plaintiff's chambers was
formed in a manner previously well-known, but the Defendant's chamber and
contractions were made in a new way by one operation. It was held at the trial 20
that the two contractions formed the pith and marrow of the invention; and
that, notwithstanding the reference in the claim to two chambers, the Defendant
had infringed. Judgment was given for the Plaintiff with costs. The Defendant
appealed.

Held, that the claim was limited to a thermometer having two or more 25
chambers with a comparatively open contraction within each chamber, and that
the Defendant employed a new method and had not infringed. The appeal was
allowed with costs.

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On the 25th of February 1897, Letters Patent (No. 5120 of 1897) were granted to *James Joseph Hicks* for an invention of "Improvements in Clinical Thermometers."

- 5 "The Complete Specification was as follows:—"The invention has for its object an improved construction of clinical thermometer with a view to render the re-setting of the same more easy than is the case with clinical thermometers as heretofore constructed.

- 10 "Heretofore clinical thermometers have been made with what is known as an 'indestructible index,' which is obtained by making a single knife-edge contraction in a chamber in the bore at a position more or less near the bulb, such contraction acting, on the cooling of the mercury in the bulb, to separate the portion of mercury above the contraction from that below the same.

- 15 "With this construction of clinical thermometer it was necessary to make the said knife-edge contraction so acute as almost to close the bore at that part, as otherwise the separation of the mercury above the contraction from that below would not take place on the cooling of the same, but the entire column of mercury would pass below the said contraction.

- 20 "The above-named construction of clinical thermometer renders it very difficult to re-set the same on account of the violent shaking or swinging necessary to cause the mercury in the tube to pass below the said contraction.

- "My present invention is illustrated in the accompanying drawings, in which:—
25 "Fig. 1 is a longitudinal sectional diagram of a clinical thermometer showing my invention applied to that class of clinical thermometer known as the 'Non plus ultra,' in which the contraction for producing the 'indestructible index' is very near the bulb. Fig. 2 is a longitudinal sectional diagram showing my invention applied to an ordinary clinical thermometer in which the contraction for producing the 'indestructible index' is at a greater distance from the bulb, and Fig. 3 is a similar section showing a modification.

- 30 "According to my present invention I obviate the difficulty hitherto experienced in re-setting clinical thermometers provided with an 'indestructible index' by the following improved construction.

- 35 "I make two chambers *b b* within the bore of the tube *a* at a short distance from each other, and within each of such chambers *b b* I make a contraction *b¹*. By making two chambers within the bore of the tube, each provided with a contraction, instead of only one chamber and one contraction, I am enabled to make the two contractions employed by me less acute than is necessary with the single knife-edge contraction heretofore used.

- 40 "With my improved construction of clinical thermometer, by reason of the contractions employed to produce the 'indestructible index' being less acute than the single contraction heretofore used for such purpose, the mercury is enabled, when the thermometer is swung or shaken, to pass such contractions much more readily than heretofore, thereby greatly facilitating the re-setting of the thermometer.

- 45 "It may be remarked that with the present improved construction of thermometer, the chambers *b b* containing the contractions *b¹ b¹* and the portion of the bore of the tube *a* between them, will always remain filled or nearly so with mercury, and although the contractions *b¹ b¹* will allow the mercury to pass more freely than the single contraction heretofore used, they do not in any way interfere with the separation of the 'indestructible index' from the column of mercury on the cooling of the latter in the bulb *c*.

"These chambers *b* with contractions *b¹* may be made more or less near to the bulb *c*, as shown in the drawings.

- 50 "In the modification represented at Fig. 3, in lieu of making two contractions in a single bore, I insert between the bulb *c* and the tube *a*, a short length of double-bore tube *a¹*, the two bores of which communicate with the bulb *c* and also with the bore of the tube *a*, and I make a chamber *b* and a contraction *b¹*

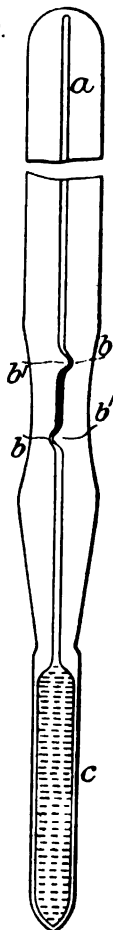
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"within each of such bores of a similar character to those shown at Figs. 1 and 2.

"It will be evident that more than two chambers with such contractions may be provided, but it is unnecessary to employ more than two."

The Patentee claimed:—"1. A clinical thermometer having two or more 5
"chambers formed within the bore of the tube and a comparatively open
"contraction within each chamber, substantially as herein shown and described
"and for the purpose stated. 2. In clinical thermometers, the combination
"with a thermometric bulb and a tube having a bore communicating with said
"bulb, of two or more chambers interposed between the indicating part of the 10
"tube and the bulb, and a comparatively open contraction within each of such
"chambers, substantially as herein set forth and for the purpose stated. 3. The
"improvements in clinical thermometers substantially as herein shown and
"described and for the purpose stated."

FIG. 2.



On the 22nd of September 1903, the Patentee commenced an action against 15
George Alexander Simmons for infringement of the Patent, claiming the usual
relief. The Statement of Claim alleged the grant and validity of the Patent,
and that the Defendant had infringed. The Plaintiff by his Particulars of

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Breaches alleged that the Defendant had continuously from the beginning of the month of August 1903 and down to the date of the writ in the action, manufactured and openly sold and offered for sale clinical thermometers of a particular construction under the trade name of "Duo in Uno," and which
 5 thermometers were made in accordance with the Plaintiff's patented invention, and had been so made, sold, and offered for sale without any licence or authority from the Plaintiff, and were complained of in this action; and that on or about the 7th August 1903, the Defendant manufactured several such thermometers and supplied them in the course of business to
 10 *Joseph Levi and Co.*, 97, Hatton Garden, in the County of London; that the Defendant by an advertisement inserted in the "Optician" newspaper of the 7th August 1903, threatened to infringe the Plaintiff's said Patent by the manufacture and sale of clinical thermometers constructed as aforesaid.

The Defendant by his Defence denied infringement as alleged or at all, and
 15 that he threatened or intended to infringe the Patent. On the 27th of February 1902, the Defendant had taken out Letters Patent (No. 4998 of 1902) for "Improvement in Clinical Thermometers." The letterpress and Figures of this Specification which are set out below, sufficiently show and explain the infringement complained of, although the Plaintiff alleged that the two
 20 constrictions could not be made at one operation; evidence was, however, given on behalf of the Defendant that the two constrictions in the Defendant's thermometers were made at one operation.

The Defendant's Specification was as follows:—"My invention relates to
 "clinical thermometers in which one or two constrictions are formed in the bore
 25 "for the purpose of obtaining what is known as an 'indestructible index.' In the case of one constriction the objection obtains that it is difficult to reset even with violent shaking, and in the case of two separate constrictions in two separate chambers, this objection is overcome, but the formation of the double
 "set of chambers and constrictions necessitates two operations, thereby increasing
 30 "the cost of production.

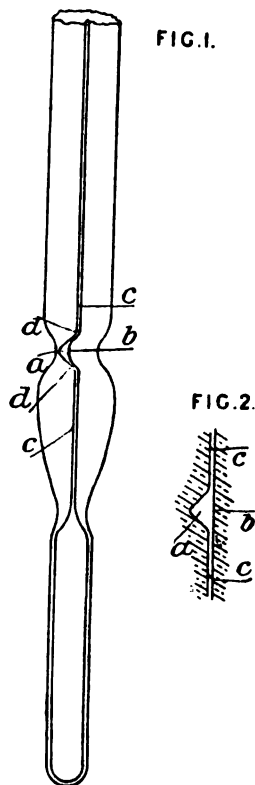
"The object of my invention is, by an improved formation of the chamber in which the constriction is made, to enable two constrictions to be formed in the same chamber, thereby securing the efficiency in one chamber of the two
 "separate less-acute constrictions, an arrangement or construction not hitherto
 35 "attained, and enabling a thicker column of mercury to be used while retaining the desired speed of indication.

"In the accompanying drawings, Fig. 1 illustrates in section the lower portion of a clinical thermometer with two constrictions in one chamber constructed
 "in accordance with my invention; Fig. 2 is a section of the chamber before
 40 "subjection to heat, and Fig. 3 is a modification of the shape of the chamber also before subjection to heat. According to my invention, instead of forming the chamber elliptical or eye-shaped as heretofore, I form the chamber *a*
 "triangular or conical as shown in Figs. 1 and 2, or other shape which has at least one straight side *b* (e.g., semi-circular as shown in Fig. 3, rectangular or
 45 "semi-elliptical) all hereinafter referred to and included in the term 'triangular,' said straight side or base *b* of the triangular chamber *a* being coincident with the bore *c* and communicating therewith. On subjecting the base *b* of the triangular chamber *a* to heat in the usual manner, the base is sucked inwards
 "by the partial vacuum in the chamber and bore towards the two walls of the
 50 "triangular chamber, leaving a triangular portion of small dimensions with a constriction *d* at both sides or ends thereof communicating one with the indicating column and the other with (or towards) the bulb.

"This double constriction is caused by the fact that the base or straight side of the chamber is of insufficient length to more than bridge across from side
 55 "to side of the chamber, thereby forming the constrictions, whereas in the usual elliptical or eye-shaped chamber the side under the influence of the heat, being of the same length as the opposite side, follows the contour of the

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"opposite side, and it is not possible to form more than a single constriction in such chambers."



The action was tried on the 21st of April 1904 by *Kekewich, J.*, who held that the two contractions formed the pith and marrow of the invention; and that the Defendant had infringed. Judgment was given for the Plaintiff with costs 5 (*ante* p. 413). The Defendant appealed.

On the hearing of the Appeal *P. O. Lawrence, K.C.*, *E. F. Lever*, and *A. M. Wilshire* (instructed by *H. R. Newson*) appeared for the Appellant; *Moulton, K.C.*, and *J. W. Gordon* (instructed by *James and James*) appeared for the Respondent. 10

Lawrence, K.C., and *Lever* for the Appellant explained the method of forming the chamber and contraction in the clinical thermometer used prior to the Plaintiff's invention and continued:—*Hicks'* invention was duplicating the chambers and contractions, and making the contractions less fine for the purpose of allowing the thermometer to be easily reset. The knife-edge contraction holds 15 the mercury up, but if made too fine, it is difficult to reset the thermometer. Hence there was formerly difficulty in getting the mercury back. *Hicks* only discovered that with duplication of the contracted passage it need not be so fine, and thus it was easier to re-set the thermometer. The essence of his invention is two or more chambers with a contraction in each. The chambers are not mere scaffolding. 20 *Hicks* does not describe how to make the contractions, he assumes that that is known. The Specification accentuates two chambers with a short distance between them. The claim also mentions two or more chambers. It does not

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cover one chamber with two contractions, such as the Defendant has. The Defendant's arrangement is as far from *Hicks'* as his is from what was known before. The Defendant does not heat the tube all round to make a bulb, he softens one side only ; so that he gets an excrescence on one side only ; therefore
 5 the form of chamber is different. After exhausting the air he applies the flame to the flat side. The result is that this is sucked in, and so that the sides are met before the top of the excrescence, thus getting two contractions or constrictions, which are not knife-edged. There is essentially only the one chamber with two constrictions, one at the entrance or one at the exit. In the process
 10 one cone is formed under another, but of a wider angle. The evidence shows that the Defendant's constrictions are made by one operation. Keeping one side of the chamber flat was novel, and enables the Defendant to do what could not be done before. In the ordinary clinical thermometer the touching would tend to be at the top of the excrescence, not the sides, whereas in the Defendant's
 15 the touching of the flat side will be first at the lower parts of the opposite glass, thus making two contractions. [The evidence was read and the judgment of *Kekewich, J.*] If the claim was for two constrictions, however made, it would be bad.

Gordon for the Respondent :—I submit that the Defendant has substituted a
 20 double chamber for two chambers, and that that is not a change of substance, but only a slight modification. As to the form of the Defendant's chamber, a lop-sided chamber was known. The formation of a chamber in these operations is to thin the glass in the particular spot, so that heating can be localised. In the heating of the eye-shaped chamber one side resumes the flat shape ; so that
 25 one passes through a stage in which one gets a lop-sided chamber as in the Defendant's process. The length of mercury between the two constrictions in the Plaintiff's thermometer corresponds to the small length of mercury between the Defendant's constrictions ; the tube holding it forms a chamber. The essence of the Plaintiff's invention is having two or more constrictions. In
 30 making the constrictions the chambers are practically destroyed ; the function of a chamber is substantially only to make the constriction. A considerable chamber would be a disadvantage. The Plaintiff claims every kind of constriction ; there was in fact only one way of making them, namely, by making one wall of a chamber collapse on the other. I submit that the
 35 evidence shows that practically the Defendant makes two chambers. But he at all events has two constrictions, and therefore takes the essence of the invention ; and I submit that he has infringed.

No reply was called for.

VAUGHAN WILLIAMS, *L.J.*—I think that this Appeal must be allowed.
 40 Looking at the Specification of *Hicks*, I find that his claim is :—"A clinical thermometer having two or more chambers formed within the bore of the tube, and a comparatively open contraction within each chamber, substantially
 "as herein shown and described and for the purpose stated." When one looks at that claim, and compares what *Hicks* claims with what *Simmons* has done,
 45 one finds this very obvious difference, that, whereas *Hicks* claims, and emphatically claims, that his invention consists of the clinical thermometer with two or more chambers within the bore of the tube, and a comparatively open contraction within each chamber substantially as herein shown and described, *Simmons* in what he does has not got the two chambers ; he has only
 50 got one chamber. Now really both *Hicks* and *Simmons* were seeking to attain a well-known result, and they were seeking to attain this well-known result generally in a manner which was perfectly well known in the trade ; but each of them proposed to effect an improvement. The object of each of them was that when the mercury in the thermometer under the influence of heat went up, it
 55 should not come back again easily, but stay up, and thus register an index of the maximum heat which the doctor or other person applying the clinical thermometer should read accurately and without haste. There were difficulties about this. If

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you had your register index too strong, there was a great difficulty in getting the mercury back again, and resetting it. Each of them was trying to attain this known object, and generally the means of obtaining it were similar, both in the original clinical thermometer, and in *Hicks'* and *Simmons'* methods. Each of them was for an improvement to attain this known result, and *prima facie* one has only 5 to read the claim of *Hicks*, and look at the claim of *Simmons*, and what *Simmons* has done, to see that the two operations are different. But it is said by Mr. *Gordon*: Yes, that is so; but although there is so much stress laid upon the two chambers, the real object was to get two contractions, and *Simmons* it is true has not two chambers in the sense in which *Hicks* uses the word, that is 10 to say, he has not two chambers produced by two different pressures inside the bore; but still Mr. *Gordon* says that is mere scaffolding, and that the real point here was to get, for the purpose of making the use of the index register more convenient, two contractions, and he puts it in a way which cannot be stated better than Mr. Justice *Kekewich* states it. He says at the end of his Judgment:—"The pith 15 "and marrow of the Plaintiff's invention are the two contractions which he only "saw his way to introduce into the thermometer by having two chambers, and "leaving them there as he does. Assuming that the Defendant never had two "chambers, and assuming, as I think is the fact—the other being an assumption "only—that there are not two chambers now, the Defendant has the two 20 "contractions, introduced for the express purpose of making the return of the "mercury easier, and avoiding the violent shaking or swinging. Therefore it "seems to me that, on a reasonable interpretation of the Plaintiff's Specification, "the Defendant has taken the pith and marrow of the Plaintiff's invention, and "that therefore the Plaintiff is entitled to the relief he asks." I cannot agree 25 with that part of the Judgment which is really the whole of Mr. *Gordon's* contention to-day. It seems to me that if one looks at the words of his claim, and regards its narrowness, it is perfectly obvious that *Hicks* has chosen to make his claim in such a form that he cannot say that the pith and marrow of his invention is the presence of two contractions. It seems to me that the whole 30 invention is the obtaining of the two contractions in the way specified, that is, by having two or more chambers formed within the bore of the tube, and a comparatively open contraction within each chamber. Under those circumstances I think this Appeal must be allowed.

ROMER, L.J.—I am of the same opinion. It is important to bear in mind 35 what the Plaintiff's invention really was, and what is his claim in his Specification. Before the Plaintiff's invention there was a well-known method of making clinical thermometers, and shortly stated that method was this—You first made a chamber in the bore of the tube by heating all round a portion of the tube, and then pressing the air in the tube, the 40 consequence of which was that with regard to the heated portion of the tube, the pressure of the air forced the heated glass out, and so produced a ball-like chamber. That was the ordinary thermometer known to clinical thermometer makers at the time of the Plaintiff's invention. After having produced the chamber, then the process, shortly speaking, was this—"The air was 45 exhausted; then by applying heat to one side of the ball-like chamber the external air pressure drove in that heated side of the ball, so that it pressed, or nearly pressed, the top of the ball against the internal top of the other side of the ball. After that side-like pressure was applied in a similar manner, and that produced a constriction or contraction, and that contraction in the chamber 50 effected the object of the clinical thermometer; it enabled what is called the indestructible index to be produced, and the only effect it had was that owing to the necessary thinness of the aperture through which the returning mercury had to come, or, so to speak, the intense smallness of the contraction, it was very difficult, indeed, except to an expert, and even then only after one or 55 two trials, to get the thread of mercury in the upper part of the tube back into what I may call the reservoir at the bottom.

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That was the position of affairs when the Plaintiff made his invention. And what was his invention? It was a very useful one, I am not saying for a moment it is not, but it was very simple. It was this. He first made two chambers of the ordinary kind—he does not venture to say in his Specification
5 that he was inventing a new kind of chamber; he certainly was not; that is not contended; he was making two ordinary chambers in the ordinary way—and then he had two separate constrictions, these two chambers being necessarily separated by some finite distance between them. That was the nature of his invention. It enabled the indestructible index to be retained, but
10 facilitated the return of the mercury thread to the bulb, and so far it had a distinct advantage, and, as I have said, it was useful. Having the two chambers and the two constrictions instead of one chamber and one constriction he need not make, and did not make, each constriction so small or so rigid as it had to be in the ordinary clinical thermometer, and that no doubt facilitated the return
15 of the mercury thread to the bulb. That was the Plaintiff's invention, and as my Lord has pointed out, his claim had to be of necessity restricted to the precise limits of his invention, because he had not invented the chamber, he had not invented the constriction, he had not invented a new chamber, he had not invented a new constriction or contraction: all that he had invented was
20 what I have said, two chambers, two contractions, the contractions not necessarily, therefore, being so rigid, or so small, as they had to be when you only employed one. In order to validate such a Patent under those circumstances it was necessary that he should carefully define what his claim was.

25 How does he put his claim? His claim is embodied substantially in the first claim in the Specification and it is for "A clinical thermometer, having two or "more chambers formed within the bore of the tube and a comparatively open "contraction within each chamber, substantially as herein shown and described." I may point out that each chamber necessitated a separate making, and that of
30 course was one drawback to his Patent because the work of making them was increased. In that state of things it is clear that the Plaintiff could not, having regard to the nature of his invention, have possibly asserted that he was claiming two contractions, however produced, without regard to the way in which they were ordinarily made, and without regard to the chambers. He
35 could not have done it without running great risk of his Patent being held invalid, and he very wisely restricted himself to his true invention, and as I have pointed out, carefully restrained his claim to two separate chambers, and two separate contractions. That left it, to my mind, perfectly open to any subsequent inventor, if he could, to effect the same results obtained by the
40 Plaintiff, the same good effects, if he could do it, by one chamber.

Now what did *Simmons* do? To my mind he made a new invention without in any way adopting the Plaintiff's. He did not make the ordinary chamber in the ordinary way. He made substantially a new chamber, and the way he made it was this—Instead of making the ball-like chamber he only
45 heated one side of a portion of the tube that had to be operated upon, and then, when the air was pressed, only one side of the tube was pressed out by the compressed air. So that instead of the ordinary ball he only had one half of a ball, and the other side was flat and rigid. He then found that if you took a very fine thread of flame, which is the ordinary method of applying the heat
50 in these cases when air is exhausted, and applied it to the flat side, the air then pressed the side so heated. What he did was, not to press the top of the flat side close against the top of the ball-like side opposite; it did not curiously enough operate in the same manner as when you pressed one side of a ball against the other side; it produced a small cavity at the top of the ball on the
55 opposite side, but constrictions on each side or contractions of the chamber. He thus solved to my mind a substantially new problem. He showed how by one operation, one chamber, and I think on the evidence, substantially a new

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method altogether, you obtained all the good effects, and possibly even better effects than were obtained by the Plaintiff, and, as I have pointed out, in a substantially different manner, at any rate in a manner not covered by the Plaintiff's express claim.

How does the Plaintiff seek to get out of this? Only by a process of reasoning and argument, common enough in patent cases, which is this—asking the Court to ignore the true invention of the Plaintiff and the true claim, and asking it, by a series of steps, to come to the conclusion that the Defendant is taking what the Plaintiff is pleased to call the pith and marrow of his invention, though not covered by the claim as it stands, and that is done by a series of arguments, which are ingenious no doubt, but seem to me ingenious to the extent of asking the person who has to listen to them to forget the true substance of the case he has to consider. It is said that here you have two chambers in one chamber. The answer is, that is a mere method of speaking, which is untrue in fact. I have pointed out what the only known method of making a chamber was in these cases. In the Plaintiff's case you had to make, and did make, two distinct chambers. In the Defendant's case you only have to make one chamber, and that to my mind a distinct shaped chamber, but even if it were not a distinct shaped chamber it would not matter; he only has to make one chamber. That is a difference that goes to the root of the matter, and it is not true to my mind to say that in this case you have two chambers rolled into one, or that you can say that a suggestion such as that meets the true merits of a case like this.

To my mind the Defendant's thermometer is a distinct thermometer from the Plaintiff's, and one that is not covered by his claim, either according to the wording of it, or according to the substance of it, rightly and properly considered, and for these reasons I agree with my Lord in thinking that the Appeal should be allowed.

COZENS-HARDY, *L.J.*—I agree, and I have really nothing to add.

Wilshere.—The Appeal will be allowed with costs here and below?

VAUGHAN WILLIAMS, *L.J.*—Yes.

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IN THE HIGH COURT OF JUSTICE.—KING'S BENCH DIVISION.

Before LORD ALVERSTONE, L.C.J.

June 7th and 8th, 1904.

FREDERICK FRENTZELL v. ALFRED DOUGILL and ERNEST G. MEYER.

- 5 *Patent.—Agreement for sole license.—Sale by licensee of his Patent rights.—Assignment of Patent subject to right of licensee.—Concurrence of assignee not necessary in carrying out the sale.*

On the 17th of July 1902 D. and M. agreed to purchase from F. for 2500*l.* Patent rights in a certain system. On the 21st of July 1902 F. obtained an
 10 option for a sole license under the four Patents. On the 7th of November 1902, by an Agreement to which R. H. was a party, D. and M. agreed to pay the unpaid balance of the 2500*l.* on F. tendering the license above referred to. On the 24th of October 1902 the said Patents had been transferred to J. H. H. subject to the rights of F. under the Agreement of the 21st of July 1902. D. and M.
 15 refused to pay the unpaid balance unless the license tendered was executed by J. H. H. In an action by F. to recover the balance,

Held, that it was not necessary that the license should be executed by J. H. H., and that the Plaintiff was entitled to succeed.

On the 10th of September 1903 Frederick Frentzell commenced an action
 20 against Alfred Dougill and Ernest G. Meyer, claiming a sum of 2000*l.* as due under two Agreements of the 17th of July 1902 and the 7th of November 1902.

The Statement of Claim was as follows :—“(1) By a Memorandum dated the 17th of July 1902, the Defendants *inter alia* agreed to purchase from the Plaintiffs for the sum of 2500*l.* patent rights for Great Britain and Ireland,
 25 “with rights to export to the Colonies, of the *Hagen* patent system of traction, together with all improvements, past, present, and future, and paid the sums hereinafter mentioned on account of the purchase price. (2) The patent rights referred to in the said Agreement were four Patents numbered 27,212 of 1897, 8754 of 1899, and 11,987 and 11,988 of 1901, of which the Plaintiff had
 30 “the sole license for the United Kingdom, Ireland, and the Isle of Man, pursuant to an Agreement dated the 21st of July 1902, between *Rudolf Hagen* and the Plaintiff, and to the Agreement mentioned in the next succeeding paragraph hereof. (3) By a Memorandum of Agreement made the 7th of November 1902, between the said *Rudolf Hagen* of the first part, the
 35 “Plaintiff of the second part, and the Defendants of the third part, it was agreed *inter alia* that upon the Plaintiff tendering the said License referred to in the said Agreements of July 17th 1902 and July 21st 1902, and in this

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"Agreement (being the sole License for the said Patents) the Defendants undertook to carry out the said Agreement of July 17th 1902, and to pay the balance of the purchase money due thereunder. (4) The Plaintiff duly tendered to the Defendants the said sole License, yet the Defendants have not paid the balance of the said purchase money due thereunder, namely, 2000*l.*, or any part thereof. (5) The Defendants, their agents or licensees, have been working the said Patents in Great Britain. 5

"The Plaintiff claims 2500*l.*

"1902. July 17th, less paid 100*l.*

"November 17th 400*l.*

500*l.*

"Amount due 2000*l.*"

Of the four Patents referred to in the second paragraph of the Statement of Claim one was (as stated in paragraph 4 of the Statement of Defence) granted to *Rudolf Hagen* and the other three to *Carl Frohnhaeuser* upon a communication from abroad made by *R. Hagen*; the Agreement of the 21st July 1902 mentioned in the second paragraph of the Statement of Claim was an Agreement in German made at Cologne, the translation of the material portion of which was as follows:—"Messrs. *Fr. Frentzel & Co.*, London. In agreement with *Dr. E. E. Lechweiss*. I hereby give you herewith the following option on my Patents in England An Agreement of sole license is provided which you intend to enter into with parties in England." It was signed "*Rudolf Hagen*. Agreed to the above *Dr. E. E. Lechweiss*." It was subsequently agreed between *R. Hagen*, the Plaintiff, and the Defendants that "sole," in the above Agreement, was intended to mean a sole license for the United Kingdom, Ireland, and the Isle of Man. 15 20 25

The Statement of Defence was as follows:—" (1) The Defendants do not admit that the Memorandum, dated the 17th of July 1902 is sufficiently or correctly set forth in the Statement of Claim, and they will crave leave to refer to the same when produced at the trial. They will require the Plaintiff to produce and put in evidence at the trial the Agreement dated the 21st July 1902 which they do not admit. They deny that as alleged or at all the Plaintiff ever had a sole license for the United Kingdom of Great Britain and Ireland and the Isle of Man, or any license under the Patents, or any of the same referred to in paragraph 2 of the Statement of Claim. (2) They do not admit that the Agreement, dated the 7th November 1902, referred to in paragraph 3 of the Statement of Claim is therein correctly or sufficiently set forth, and they will crave leave to refer to the same at the trial. The Defendants never agreed as alleged, or at all, to carry out the alleged or any Agreement, or to pay the alleged or any moneys to the Plaintiff on his tendering the alleged or any license. The moneys claimed in this action are not payable to the Plaintiff until he tenders, as provided in the said Agreement, dated the 7th November 1902, a sole licence for the United Kingdom of Great Britain and Ireland and the Isle of Man under the aforesaid Patents, together with the assignment of improvements in such Agreement mentioned. The Plaintiff has never tendered such license and assignment nor any license or assignment, and has not performed the conditions appearing in Clause 3 of such Agreement which are precedent to his right to be paid the said moneys or any part thereof. (3) The purchase consideration, 2500*l.*, was the price agreed pursuant to the said Memorandum dated the 17th of July 1902 and the said Agreement dated the 7th of November 1902 to be paid to the Plaintiff for the sole license aforesaid, together with the rights to export to the Colonies in paragraph 1 of the Statement of Claim mentioned and the aforesaid assignment of improvements. On account of this agreed price the Defendants have paid the sum of 525*l.* (4) Of the Letters Patent aforesaid, No. 27,212 of 1897 was granted to *Rudolf* 30 35 40 45 50 55

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- "Hagen, and Nos. 8754 of 1899 and 11,987 and 11,988 of 1901 to Carl Frohnhaeuser, upon a communication from abroad made to him by the said Rudolf Hagen. By a Deed of Assignment dated the 24th of October 1902, and made between the said Rudolf Hagen and Joseph Hinson Hoadley, the said R. Hagen assigned to the said J. H. Hoadley the said Patent No. 27,212 of 1897. Further by a Deed of Assignment, also dated the 24th of October 1902, and made between the said Carl Frohnhaeuser and the said R. Hagen and the said Joseph Hinson Hoadley, Carl Frohnhaeuser at the request and by the direction of the said R. Hagen assigned to the said Joseph Hinson Hoadley the said Patents Nos. 8754 of 1899 and 11,987 and 11,988 of 1901. At all times material after, but not on or before the 7th of November 1902, the Defendants were aware of the fact of the said Patents having been assigned as aforesaid, and of the terms and provisions of the said Deeds of Assignment, and accordingly the said Joseph Hinson Hoadley, in whom the said Patents, since the date of the said Deeds of Assignment, have been vested in, and ever since such date has been a necessary party to the grant to the Defendants or their nominees of a valid sole license as aforesaid, and the proper and only person capable of granting such a license. (5) With the assent and approval of the Plaintiff a sole license as aforesaid was, on or about the 3rd of February 1903, prepared at the direction of the Plaintiff, the said R. Hagen, and the Defendants, by Messrs. North & Sons, solicitors, of Leeds, acting for all the last-named parties, to which license the proposed parties were respectively the said Joseph Hinson Hoadley, the said R. Hagen, the Plaintiff, and the Defendants. The said license was, on the 3rd day of February 1903, executed by the said R. Hagen, the Plaintiff, and the Defendants, and was handed to the said Messrs. North & Sons by the said R. Hagen, with instructions to obtain the execution thereof by the said Joseph Hinson Hoadley, and the said Messrs. North & Sons at the same time signed and gave to the said F. Frentzel an undertaking that in consideration of the said R. Hagen and F. Frentzel handing them the said license for the purpose of enabling them to obtain the said Joseph Hinson Hoadley's signature thereto, the said Messrs. North & Sons undertook to hold such license as an escrow, to be delivered up to the Defendants on payment of the amount due to the Plaintiff only if and when signed by the said Joseph Hinson Hoadley, and in case he declined to sign the same the signatures of the said R. Hagen and the Plaintiff to such license were to be null and void. The said Messrs. North & Sons and the Defendants have used their best endeavours to induce the said Joseph H. Hoadley to execute such license, but he is unwilling and has refused so to do. (6) The Defendants have at all times been ready and willing to pay to the Plaintiff the moneys claimed in this action upon his being entitled to be paid the same; but he has never been in a position to obtain the sole license aforesaid or the rights aforesaid to export to the colonies or the said assignment of improvements. (7) They make no admission as to paragraph 5 of the Statement of Claim, and say that the same is wholly irrelevant."
- 45 The Deed of the 24th of October 1902 made between Rudolf Hagen and J. H. Hoadley, and mentioned in the fourth paragraph of the Statement of Defence, was an Indenture whereby, after reciting the grant of Patent No. 27,212 of 1897 to Hagen and the grant of Patents Nos. 8754 of 1899 and 11,987 and 11,988 of 1901 to Frohnhaeuser, on a communication from Hagen, and an agreement by Hagen to sell and assign, or cause to be sold and assigned, the said four Patents to Hagen, "subject, however, to any whatever rights are now held in and upon the same by one F. Frentzel of London, England, by reason of a certain paper writing called an option for a license signed by the said parties of the first part and the said F. Frentzel and one Ernest Lechweiss, and bearing date Cologne, July 21st 1902"; for the considerations therein mentioned Hagen sold, assigned, and transferred unto Hoadley, Patent No. 27,212, and agreed to cause to be assigned and transferred

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the other three Patents and the entire interest therein "subject, however, to any right held by the said *F. Frentzel* by reason of the said paper writing for an option dated July 21st 1902 heretofore mentioned."

By his Reply the Plaintiff, after joining issue on the Defence, and admitting the payment of the 525*l.*, stated as follows:—"(3) The Plaintiff does not admit 5
"that the said *Joseph Hinson Hoadley* is a necessary party to the said sole license, or that his signature to such sole license is necessary. (4) If, however, the signature of the said *Joseph H. Hoadley* to the said document pur-
"porting to be a sole license mentioned in paragraph 5 of the Defence is
"necessary (which is not admitted), the Defendants and their said-solicitors, 10
"Messrs. *North & Sons*, have not used their best endeavours to obtain the execution thereof by the said *Joseph Hinson Hoadley*, but, on the contrary,
"they never presented the said document to him to execute, or, if they did,
"they did not present the same to him within or at a reasonable time. The
"Plaintiff will accordingly contend that the Defendants ought not to be 15
"admitted to say that the said sum claimed in this action is not payable until the said *Joseph Hinson Hoadley* has executed the said document, or that the
"signature of the said *Joseph H. Hoadley* is necessary to the said license. (4)
"In the alternative the Plaintiff says that the signature of the said *Joseph H.*
"*Hoadley* to the said document is not necessary, the said *Joseph H. Hoadley* 20
"having assented in writing to a license being granted to the Defendants."

The action came on for trial before the LORD CHIEF JUSTICE.

Rawlinson, K.C., and *W. W. Mackenzie* (instructed by *E. G. Barrett*) appeared for the Plaintiff; *Scott Fox*, K.C., and *Colefax* (instructed by *Vincent and Vincent*, agents for *North & Sons*, of Leeds) appeared for the 25 Defendants.

Lord ALVERSTONE, L.C.J.—In this case the real question is, whether the Plaintiff *Frentzell* is entitled to any relief in respect of the non-payment of sums of money that he claims? Whether he is entitled to have the money paid to him without the execution of any further document is not the question in this action. 30
It may be (I do not express any final opinion upon it) that the documents that have been executed are not sufficient. That is not the defence that is raised. The defence raised is that unless *Hoadley* concurs they are not bound to pay over the money, and that is the point I am going to deal with and in respect of which I decide against the Defendants. 35

The law upon the matter to my mind is really too plain for any argument in this case. *Primâ facie* the man in whose name the Patent is taken out, or the person whose name appears upon the Register, is the owner of the Patent, but for a great many years long before the Act of 1883 and since, as section 87 provides, all equitable rights have been considered by the Courts and can be 40 enforced in the ordinary way, and the only effect of an Agreement, even of such as that of the 24th of October, would be a right to which effect might have been given to get the Patent registered in the name of the person claiming by assignment. It now turns out (and I am not giving any judgment against the Defendants on that ground) that this Agreement has not been registered. The 45 matter has been standing over, but still I quite agree, as Mr. *Scott Fox* has pressed me, that, if I thought that on the face of that Agreement *Hoadley* was entitled to have the Patents registered in his name free and clear from any other title, and if I had thought that *Hoadley* was a necessary party, I should not have hesitated to give effect to that notwithstanding the fact that it had not 50 been registered, because I should have given directions for the registration. Therefore I deal with the substance of this matter. Is it a valid objection which is taken by Mr. *Scott Fox* on behalf of Messrs. *Meyer* that they are not bound to accept any licence unless *Hoadley* concurs? The point has been fairly put by Mr. *Scott Fox* without shrinking from it—his client in the box 55 says: "I knew all along I could get *Hagen* and *Frentzell's* signatures, but I am "not content to take it without *Hoadley*," the reason being not only that he

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wants to be sole licensee of the Patent, but wants to bring out a Company. He thinks, and it may be true for all I know, that what *Hagen* has done or had done with regard to *Hoadley* may create some difficulty by making people think that *Hoadley* may have some claims which, in his opinion, he has
5 not got.

The Agreement of the 24th of October, which is said to be the reason which justified Mr. *Whittell* on behalf of *Meyer* in saying: "I must have *Hoadley's* signature," is an Agreement which upon the face of it is made subject to *Frentzell's* rights under the Agreement of the 21st of July. Therefore, to
10 suggest that that was a document which would enable *Hoadley* to claim the rights in the Patents independently of *Frentzell* is an argument to which I cannot give the slightest adhesion. It was a document which the Registrar could only register as giving *Hoadley* certain rights, and upon the face of that document it reserved *Frentzell's* rights, and I think the point which Mr.
15 *Rawlinson* took when that document was read is a perfectly sound and good one, and has been acted upon over and over again in dealing with Patent rights.

What is the next position? The next position is that it was contemplated that *Meyers*, the buyers, should be the sole licensees. It is quite unnecessary
20 for me to go into the distinction between sole licensee and assignee. For the purpose of what we are dealing with to-day it is practically quite immaterial, whether or not the Defendants became sole licensees or assignees. The rights of a sole licensee, though they are not enforced in the same way, are the same. He cannot bring an action in his own name, but he can get the benefit of the
25 Patentee's name by making him either a plaintiff or a defendant, and therefore *Hagen* in setting up any claim as against *Meyer*, but being willing that *Meyer* should have the rights; the position of Messrs. *Meyer* as sole licensees, is exactly the same for all purposes of this bargain as though they were assignees. Having chosen to involve themselves in this *Hoadley* question, I can well
30 imagine that *Whittell* said: "Well, I will not let you bring out a company 'until you get *Hoadley's* concurrence." We have nothing to do with bringing out Companies: we have to deal with the right of *Meyer* to be sole licensee in this case.

There is one point which makes the case plainer, and that is that immediately
35 after this question had arisen some doubt was thrown upon the validity of these Patents, and in the interests of Messrs. *Meyer*, and not in the interests of *Hagen* or the interests of *Frentzell*, Mr. *Whittell* very properly took steps to see whether it was not desirable that there should be disclaimers entered, application for which might have been made by sole licensees, though of course it might
40 have to be in the name of *Hagen*. But what has been said is that *Hagen* did not think it was necessary. There is no suggestion made that *Hagen* was not willing to make any such application as the sole licensee would be entitled to make if he wanted to protect his own Patents. Therefore there are no merits in this action whatever. The whole question is were the Defendants entitled to
45 say we will not pay over this money unless you get *Hoadley's* signature. In my opinion they had not the slightest right to do it. I now come to what has happened on the 3rd of February. I come to the conclusion with some regret that *Frentzell* was told that it was a matter of form; he was told that he would be paid his money shortly, and though I do not think for a moment that
50 *Whittell* said anything, or meant to say anything which was unfair or untrue I think he did not make it sufficiently plain that this *Hoadley* point was going to be raised as a serious objection because the very document he gave was a document that he would keep the executed licence deed in the interests of *Frentzell* and that it should not be handed over until the money was paid. That
55 was *Whittell's* own answer. Therefore it is perfectly plain that he was not told "You will not get your money unless you get *Hoadley* to sign." What he was told was "We want *Hoadley's* name; it is a matter of form, and I will see that

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"the Defendants do not get this licence until that money is paid." That is what happened on that occasion, and I have not the slightest doubt about it. I further come to the conclusion that the conversation did take place which has been sworn to by two witnesses; that *Meyer* did say in the month of March that he had a quarrel or a difference with *Dougill*, and that he did say that he had been delaying the licence in his own interests. I further find that he did delay the licence in his own interests—not improperly, but in his own interests and not in *Hagen's*, because *Whittell* has said: "I sent the telegram not to proceed on the instructions of *Meyer*; I thought it was in the interests of *Hagen* to send it, that he had specific instructions, and he, practically speaking, gave the reason." He had got that day the report of the Patent Agent, and he thought it might be desirable in *Meyer's* interest to have disclaimers before the assignment took place. Therefore, it is perfectly plain he was acting as a gentleman and a solicitor in the interests of *Meyer*, and not in the interests of *Hagen*. Then for some reason or other having got the signatures of these gentlemen, *Hagen* and *Frentzell*, which could be enforced, which would come into force if they paid the money—it was not to be handed over unless they paid the money—the Defendants now turn round and say that the Plaintiff is not entitled to have that money because he has not got *Hoadley's* signature. I say a more unjustifiable defence to a case in which the signatures have been obtained and a promise made that it shall not be handed over until the money is paid I have seldom heard set up. What has happened in this case is perfectly plain. It is obviously a very valuable Patent. *Meyer* admits he paid no less than 3000*l.* to *Dougill* and indemnified him against all these claims for *Dougill's* interest as a possible sole licensee. Yet he comes into this Court and, through his counsel, say he has not had the benefit of this Agreement. The suggestion that he has not made any wagons is to anyone who has had much experience of Patent Law an absolutely futile suggestion. The rights in the Patent do not depend on making wagons. He has had them over here; he has had the working drawings, he has been soliciting orders, he has been advertising himself as the sole licensee, and he is the *Hagen Syndicate* over here. If that is not the exercise of patent rights from which *Hagen* could have restrained him if *Hagen* had not given his consent, I do not know what is. *Meyer* has been acting as sole licensee; he is in fact in equity the sole licensee here, and he has been claiming not to pay this money in his own interests, and not in the interests of either of *Hagen* or *Frentzell*. I wish it to be distinctly understood that I am not saying he did not *bonâ fide* act in his own interests in doing this, but because, wishing to improve his position before he parted with his money, he put pressure upon *Hagen*—it may be to get *Hagen's* assent to the bargain—that is no ground whatever why he should decline to fulfil his proper obligations to *Frentzell*. It was not a matter for *Hagen*, because *Hagen* was content to take his 500*l.* and his royalties.

Another point was raised by Mr. *Scott Fox*—that because he had not got the property in the Patents on the 17th of July the contract could not be enforced. Now it turns out that months before there had been a verbal arrangement, not cross-examined to, between *Lechweiss* and *Frentzell* that *Frentzell* should have the sole right of selling these Patents, and that he should have anything he could get above the 500*l.* plus the royalties. Therefore he got an equitable right. *Frentzell* had an equitable title to these Patents, which could have been enforced the moment he was willing to pay 500*l.* and the royalties that are the subject of the Agreement.

I have touched upon the main points. In my opinion there must be judgment for the Plaintiff for the sum of 1975*l.* to be paid over if the Defendants desire it upon the Plaintiff and *Hagen* executing any documents that are tendered to them, but should they object on the ground that the covenants are not proper ones the assignment shall if necessary be settled by a Conveyancer of the

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Court, and I make that Order. I cannot of course give any interest on this money because there has been no contract for payment of interest, and nothing which would entitle *Frentzell* to get interest, but I make the money payable to-day, the documents to be tendered within a week, so that at any rate there

5 will be some hope that there will not be any further delay over this matter. The documents are to be tendered for execution within a week if desired, and if the documents are not satisfactory they are to be settled by the Conveyancer of the Court.

I ought to say, and perhaps I had better say it now, that I think this is a

10 perfectly good licence as it stands, being delivered as an escrow, not to be used until the money was paid, and it was prepared by the Defendants. If, as I think, they had no right to insist upon *Hoadley's* name, I think this is a perfectly good assignment to them of the rights, but if it be thought that because the Deed has *Hoadley's* name in it it would be better that there should

15 be a Deed without *Hoadley's* name in it I see no reason why that should not be done, and I say this in the interests of the Defendants. Therefore, if the Defendants choose to tender a document in the same form as this, or in another form which *Frentzell* and *Hagen* are willing to execute, then the money will be paid over upon that document being executed.

IN THE COURT OF APPEAL.

20

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER AND COZENS-HARDY.

July 29th, 1904.

MACMILLAN AND OTHERS v. EHLMANN BROTHERS, LD.

Trade name.—Action to restrain use of a name that was not either Plaintiff's

25 *or Defendant's.—No deception, or probability of deception proved.—Action dismissed.—Appeal dismissed.*

A firm of Macfarlane & Co. (sometimes with various initials) traded as whisky distillers and merchants at Paisley from 1740 till 1897; they had a good local reputation. The then continuing member of the firm, J. Macfarlane,

30 *assigned the goodwill of the business to Foulds & Co., Ltd. The Plaintiffs were four of the directors of Foulds & Co., Ltd. It was agreed that the business should be assigned by Foulds & Co., Ltd., to the Plaintiffs, but that assignment was not actually executed till after action brought. Foulds & Co., Ltd., remained the real owners of and carried on the business under the style of Macfarlane & Co. In the year 1897 Ehrmann Bros., the predecessors in business of the Defendants,*

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began to use the name "Macfarlane," or "Macfarlane & Co.," to denote a brand of whisky sold by them. They adopted the name at the suggestion of a gentleman named Macfarlane, who was associated with them in their business of dealers in wines and spirits. They registered the signature of "Macfarlane & Co." as their Trade Mark. During the year 1899 the trade, nominally carried on by the Plaintiffs, was extended to England. The Plaintiffs, when the respective trades of the parties came into collision, brought this action to restrain the Defendants from using the name "Macfarlane & Co.," so as to represent their whisky as that of the Plaintiffs. At the trial it was held that the Plaintiffs had failed to prove that the Defendants' acts had intercepted or were calculated to intercept the Plaintiffs' trade. The action was dismissed with costs. The Plaintiffs appealed.

The Appeal was dismissed with costs, the judgment below being upheld on all points.

The firm of *Macfarlane & Co.* traded as whisky distillers and merchants at Paisley from 1740 till 1897; where they had a good local reputation. The then member of the firm *J. Macfarlane* assigned the goodwill of the business to *Foulds & Co., Ltd.* The Plaintiffs in the action were *R. B. Macmillan, J. Wishart, W. M. M. Turner, and T. B. C. Newton*, who were directors of *Foulds & Co., Ltd.* It was agreed that the business should be assigned by *Foulds & Co., Ltd.*, to the Plaintiffs, but that assignment was not actually executed till after action brought. *Foulds & Co., Ltd.*, remained the real owners of and carried on the business under the style of *Macfarlane & Co.* In the year 1897 *Ehrmann Bros.*, the predecessors in business of *Ehrmann Bros., Ltd.*, began to use the name "Macfarlane" or "Macfarlane & Co." to denote a brand of whisky sold by them. They adopted the name at the suggestion of a gentleman named *Macfarlane*, who was associated with them in their business of dealers in wines and spirits. They registered the signature of "Macfarlane & Co." as their Trade Mark (No. 204,384). During the year 1899 the trade, nominally carried on by the Plaintiffs, was extended to England. In May 1903 the Plaintiffs brought an action against *Ehrmann Bros., Ltd.*, claiming an injunction to restrain the Defendant Company from selling, or offering for sale, whisky under the name or description of *Macfarlane & Co.*, and from using the name or description of *Macfarlane & Co.* as part of or in connection with any labels or capsules affixed upon any bottles, jars, or casks of whisky offered for sale or sold by or on behalf of the Defendant Company, and also from stating or inserting, or causing to be stated or inserted, in any advertisement or circular, any words or expressions asserting or suggesting that they were offering for sale, or authorised to sell, *Macfarlane & Co.'s* whisky, so as to represent, or lead to the belief, that they were offering for sale, selling, or authorised to sell, the Plaintiffs' whisky. The Plaintiffs also claimed damages and costs.

The Plaintiffs, by their Statement of Claim, alleged shortly (1) that their firm was established in the year 1740, and traded up to the present time as distillers and Scotch whisky merchants, under the name of *Macfarlane & Co.*; (2) that they sold extensively in the United Kingdom and the Colonies whisky as "Macfarlane's Whisky," or "Macfarlane & Co.'s Whisky," and that they acquired a great reputation for such whisky, so that the trade and the public understood that whisky so called meant the whisky of the Plaintiff firm; (3) that the Defendant Company had for some time past sold other whisky under the name of *Macfarlane & Co.'s* whisky, thereby leading to the belief that the Defendant Company was advertising the Plaintiffs' whisky; (4) that

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the Plaintiffs did not know of this sale by the Defendant Company until just before the action; and (5) that the Plaintiff firm had suffered damage.

The Defendant Company, by their Defence, alleged shortly:—(1) That they denied that the Plaintiff Firm was established in 1740, or that it or the Plaintiffs
5 ever traded as *Macfarlane & Co.*; (2) They denied that the Plaintiffs traded as a firm or were possessed of the goodwill of a firm of *Macfarlane & Co.*, which had formerly traded at Paisley or elsewhere; (3) They alleged that if the goodwill of the old Paisley firm still existed it belonged to a Limited Company styled *William Foulds & Co., Ltd.*, of which the Plaintiffs were
10 directors or officers, and in which they were shareholders; (4) They denied the alleged reputation in the trade of the Plaintiffs' "Macfarlane whisky"; (5) They stated that they were the successors of the firm of *Ehrmann Brothers*, and were assignees of the business, goodwill, and Trade Mark of that firm; (6) That in the year 1897 they adopted "*Macfarlane & Co.*" as a
15 distinguishing brand, and caused the signature of "*Macfarlane & Co.*" to be registered as their Trade Mark (Class 43, No. 204,384), and were the proprietors thereof; (7) That "in and ever since the said year 1897 the said "firm of *Ehrmann Brothers* and the Defendants have used the said brand, "*Macfarlane & Co.*" in the said firm, and also as "*Macfarlane*" as a brand or
20 "mark to indicate and identify their whisky, and have sold large quantities "of such whisky under the said brand, and have very widely advertised the "said goods thereunder. Whisky marked with the said brand or described "thereby is, and for many years before the commencement of this action was "well known, to the trade and public as being the goods of the Defendants";
25 (8) They denied that they had done anything that led, or was calculated to lead, to the belief that they were advertising or offering for sale the Plaintiffs' whisky, or any whisky other than their own; (9) They alleged that the Plaintiffs never sold any whisky as that of *Macfarlane & Co.*, but if they did use that designation it was always accompanied with the words "of Paisley,"
30 and that the Defendants' whisky was always distinguished in bold type by the words "*Macfarlane & Co., of Glasgow*"; and (10) They alleged that the Plaintiffs were estopped through laches and acquiescence in the Defendants' acts.

The action came on for trial before Mr. Justice *Buckley* on the 15th March
35 1904, judgment being delivered on the 18th March in favour of the Defendants with costs.* The Plaintiffs appealed.

Astbury, K.C., Micklem, K.C., and J. S. Green (instructed by *Greenwood and Greenwood*) appeared for the Appellants; *Buckmaster, K.C., and Kerly* (instructed by *Hyman Isaacs and Lewis*) appeared for the Respondents.

40 *Astbury, K.C., and Micklem, K.C.*, for the Appellants, stated the admitted and proved facts of the case. The Plaintiffs do not complain of the Defendants' labels or get-up of bottles, but only of the use of the name "*Macfarlane & Co.*" We say the learned Judge drew a wrong conclusion from the evidence in holding that the adoption of the name *Macfarlane & Co.* by the Defendants
45 was honest. It was no doubt honestly suggested by Capt. *MacFarlane*, but before Mr. *Ehrmann* decided on adopting it he must have been informed of the existence of the Plaintiff firm. The learned Judge failed to notice certain discrepancies in the evidence of some of the witnesses. (Counsel read and commented on the evidence of Messrs. *Ehrmann, Taylor and Wildbore* in
50 detail.) We say secondly that the Defendants had dropped the use of the name *Macfarlane* from their advertising lists and re-introduced it at a later date to take the benefit of our trade, and in fact deceived people who traded with the Plaintiffs. In their circular headed, "A Revolution in the Wine Trade," they claimed a monopoly in the use of the name *Macfarlane & Co.* [ROMER, L.J.—

* *Ante*, p. 357.

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It is plain that the Defendants did not want to sell whisky under their own name. It is a trade artifice. The Plaintiffs pretend they are *Macfarlane & Co.* and they are really *Foulds & Co., Ltd.* Is there any evidence of actual deception? Not of customers, but of persons in the trade who thought the Plaintiffs' whisky was being advertised. (Counsel referred to the evidence of 5 trade witnesses on this point.) By their revival of the use of the name *Macfarlane* the Defendants deceived those witnesses. The Plaintiffs have a large Scotch trade, and the Defendants, after knowing of the Plaintiffs' existence and trade, have flooded Scotland with their circulars. [COZENS-HARDY, *L.J.*—Do you claim the right to prevent them using the name 10 *Macfarlane & Co.* at all?] When they knew there was a firm of *Macfarlane & Co.* of old standing they should not advertise as *Macfarlane & Co.* pure and simple. [COZENS-HARDY, *L.J.*—But your registered Trade Mark is not "*Macfarlane & Co.*" pure and simple.] They ought not to advertise without making a distinction between their *Macfarlane & Co.* and ours. 15

Counsel for the Respondents were not called on.

VAUGHAN WILLIAMS, *L.J.*—I am of opinion that this Appeal ought to be dismissed. I think it is impossible for us to over-rule the decision of Mr. Justice Buckley. Mr. Justice Buckley substantially divides his Judgment into two 20 parts. First, he considers the question whether there was personal deceit in adopting this name for the purpose of passing off the Defendants' goods as the Plaintiffs'. He finds, in the plainest possible manner, that the Plaintiffs have failed to make that case out; and I do not think we should be justified in over-ruling him.

I have not the slightest sympathy with the Defendants or with their 25 mode of conducting business, and I am very sorry myself that according to the law of this country you can for trade purposes adopt a name which is not yours, and use it coupled with a sort of suggestion that you are the sole agents of the non-existent people whose picturesque name you have chosen to adopt because you hope that customers will draw all sorts of favourable inferences in respect 30 of the wares which you sell. I am also very sorry, if I may say so, that the Plaintiffs can carry out a transaction like the purchase of this goodwill for £70. That, again, is only done for the purpose of putting forward as a recommendation something that has no real existence in fact.

The other part of Mr. Justice Buckley's Judgment deals with the question 35 whether or not, even if the intention to deceive has not been proved, there is something in the adoption of this name which is calculated to deceive customers. The evidence, which was given before the learned Judge, entirely shows that nobody had ever been deceived.

Under these circumstances I have nothing further to say but that I agree with 40 the Judgment of Mr. Justice Buckley.

I might perhaps say that, if these two traders are really desirous of carrying on business honestly on both sides, it would be perfectly easy, without doing any harm to either, to distinguish the two firms. I think the Plaintiff firm might truly call themselves the successors of the old Paisley firm which was 45 established in 1740, and the Defendants, if they were so minded, could so describe themselves that there would be no danger of their being confounded with the Plaintiffs' firm; but whether they will do so or not I do not know.*

ROMER, *L.J.*—I also do not see my way to differ from the Judgment of Mr. Justice Buckley. I have nothing to add. 50

COZENS-HARDY, *L.J.*—I agree.

* Cf. *Ante*, p. 367.

*J. B. Brooks & Co., Ltd. v. Lycett's Saddle and Motor Accessories Company, Ltd.,
and E. Lycett.*

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE FARWELL.

January 28th and 29th, 1904.

5 J. B. BROOKS & CO., LD. v. LYCETT'S SADDLE AND MOTOR ACCESSORIES
COMPANY, LD., and E. LYCETT.

*Patent.—Action for infringement.—Amendment of Specification whilst a
previous action was pending, without leave of the Court.—Amendment held to
be invalid.—Leave granted to Plaintiffs to apply at the Patent Office for
amendment and trial adjourned.—Patents &c. Act 1883, Sections 18 & 19,*
10 *Patents &c. Act 1883, Section 5.*

*In an action for infringement of a Patent, the Specification of which had
been amended, the Defendants pleaded that the amendment was invalid, because
at the time when it was applied for, a previous action for infringement was
pending, and the leave of the Court to apply at the Patent Office for leave to
15 amend had not been obtained. It appeared that owing to an agreement for
settlement, which shortly after fell through, the first action had more than two
years before the amendment been marked to stand out of the list generally with
liberty to either party to apply to restore it. After the amendment had been
made, the Defendants to the action obtained leave to restore it, and an Order was
20 subsequently made giving leave to the Plaintiffs to discontinue it without costs to
either party, it being held that there had been a tacit agreement to abandon it.*

*Held, that the action in question was "pending" at the date of the application
at the Patent Office for leave to amend, and that by reason of Sub-section (10) of
Section 18 of the Patents &c. Act, 1883, the amendment was invalid.*

25 *On the Plaintiffs applying under Section (19) for liberty to apply at the
Patent Office for leave to amend, such liberty was given to them, the action to
stand over in the meantime, and the costs and the question of terms were
reserved.*

30 *On the 9th of May 1903, J. B. Brooks & Company, Ltd., commenced an Action
against Lycett's Saddle and Motor Accessory Company, Ltd., and Edward Lycett,
for infringement of Letters Patent No. 8853 of 1893, granted to J. B. Brooks for
"Improvements in Velocipede Saddles," and of another Patent (No. 15424 of*

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1890), which for the purpose of this report it is not necessary to further refer to. The Statement of Claim alleged: (1) That the Plaintiffs were the registered owners of the Patents; (2) that the final Specification of Letters Patent No. 8553 of 1893 was duly amended on the 9th of May 1901, and that the original claims of the Specification before amendment were framed in good faith and with reasonable skill and knowledge; (3) that a certificate of validity in respect of Letters Patent No. 8553 of 1893 was granted by Mr. Justice Buckley in an action of *Brooks v. Lycett* (1901, J. No. 1920)*; and (4) that the Defendants had infringed the Patents in manner in the Particulars of Breaches therewith delivered appearing.

The Particulars of Breaches alleged: (1) That prior to the issue of the writ and subsequent to the date of the Letters Patent in the Statement of Claim referred to, the Defendant Company and the Defendant *Edward Lycett* (who was the sole director and manager of the Defendant Company, and who actively managed the business of the Defendant Company) had infringed and threatened to infringe each of the Patents by the manufacture, sale, offer for sale, and use of cycle saddles constructed according to the invention described in the final Specification of the Patent No. 8553 of 1893, and claimed in (*inter alia*) the claiming clauses 1, 2 and 3; (2) that in particular the Plaintiffs complained of (i.) the threats to sell and offer for sale by the Defendants in the newspaper *Cycling* of May 9th 1903, and in the *National Cyclists Union Review* of May 9th 1903, p. 179, of an "L 7, Flexible La Grande Saddle" in infringement of Patent 15424 of 1890 as alleged, and of "L 6, La Grande" and "L 15, La Grande" (Racers) in infringement of Patent 8553 of 1893 as alleged, (ii.) the manufacture and sale by the Defendants at 164 High Street, Deritend, Birmingham, to *Albert Walden*, on May 5th 1903, of "L 6 and L 15 La Grande" saddles in infringement of Patent 8553 of 1893 as alleged, (iii.) the manufacture by the Defendants of an "L 11, La Grande" saddle, and sale by them of the said saddle to the *Premier Cycle Company*, of Coventry, during the month of April 1903, constructed in infringement of Patent 8553 of 1893 as alleged; (3) that until discovery should have been obtained the Plaintiffs were unable to give further and better particulars of infringement, but would claim to recover in respect of all infringements.

The Defendant Company by their Defence (1) denied infringement; (2) alleged that the Letters Patent were invalid; (3) that the Specification of the Patent No. 8553 of 1893 was not duly or at all amended, that the proceedings in the second paragraph of the Statement of Claim referred to were irregular and without authority, and (4) that the original claims of the said Specification were not framed in good faith or with reasonable skill and knowledge.

Edward Lycett delivered a similar Defence, and Particulars of Objections were delivered by both parties.

Particulars of paragraph (3) of the Defence were delivered as follows:—

"At the date on which the Patentee's request for leave to make the amendment of the final Specification in the 2nd paragraph alleged to have been made was left at the Patent Office, there was an Action for infringement of the said Patent pending, to wit, an Action in the High Court intitled *J. B. Brooks & Co., Ltd., and John Boulthbee Brooks* against *Edward Lycett*, No. 1897, J. 651. But the Patentee had not obtained and did not obtain from the Court or a Judge liberty to apply at the Patent Office for such leave as aforesaid, wherefore these Defendants and each of them will contend that the Patentee was not at liberty so to apply, and that the Comptroller General had no jurisdiction to receive or entertain any such request as aforesaid, but that the said request, and all the proceedings had thereupon, were irregular and without authority by reason of the Statute in that case made and provided."

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The Plaintiffs by their Reply alleged *inter alia* (2) that the leave to amend the Specification was conclusive, and the amendment was for all purposes and in all Courts to be deemed part of the Specification and could not be put in issue in the Action; that no Action was pending for infringement of the said Letters Patent at the date of the application to amend or at the date of any proceeding thereunder; (5) that the validity of the amended Specification 8553 of 1893, was duly certified by Mr. Justice *Buckley* by Judgment dated the 21st April 1903, in an action 1901, J. No. 1920, and a certificate that the claims in the original Specification were framed in good faith and with reasonable skill and knowledge was also given in the said Judgment, and the Defendants were estopped from raising either of the defences raised in the 3rd and 4th paragraphs of their Defence.

The Action referred to in the Particulars delivered under paragraph 3 of the Defence had, in November 1898, in consequence of negotiations between the parties been marked in the Cause Book to stand out of the list generally, with liberty to either party to apply to restore. On the 9th of May 1901, the Plaintiffs obtained leave under Section 18 of the Patents, &c., Act 1883 to amend the Specification as if the Action in question had been discontinued, and amended it accordingly. In November 1901 the Defendant *Lycett* gave notice of his intention to apply to have the last mentioned Action restored to the list, the negotiations above referred to having broken down. On the 12th of February 1902, *Joyce, J.*, ordered the Action to be restored (19 R.P.C., 166), and on the 15th of March 1902, the learned Judge gave leave to the Plaintiffs to discontinue it, each party to bear their own costs. This Order was affirmed by the Court of Appeal (19 R.P.C., 364).

The Action of *J. B. Brooks & Co., Ltd., v. Lycett's Saddle and Motor Accessories Co., Ltd., and E. Lycett* came on for trial before FARWELL, J., on the 28th of January 1904.

A. J. Waller and *J. H. Gray* (instructed by *Sharpe, Parker & Co.*, agents for *C. E. Newey*, Birmingham) appeared for the Plaintiffs; *Bousfield, K.C.*, and *J. W. Gordon* (instructed by *Beale & Co.*) appeared for the Defendant Company.

The Plaintiffs' case was opened, and their evidence heard. The Defendants' case was then opened, and the question of the validity of the amendment of the Specification of Patent No. 8853 of 1893 argued.

Gordon for the Defendants:—The amendment was wholly irregular. Apart from Section 18 of the Patents, &c., Act 1883, there is no authority to amend. Sub-section (1) gives the authority and Sub-sections 2 to 9 provide the procedure. By Sub-section (10), as amended by Section 5 of the Patents &c. Act 1888, the foregoing provisions of the Section do not apply when and so long as an Action for infringement is pending. At the date at which the application to amend was made, an Action for infringement—namely, that referred to in the Particulars under paragraph 3 of the Defence—was pending, and no application to the Court under Section 19 was made. Sub-section 9 of Section 18 only means that if leave to amend be given one cannot question the amendment allowed; but if there is no jurisdiction for the leave to amend, all the proceedings are null and void. That is so in the case of this amendment, and therefore the Patent comes before the Court on the unamended Specification. [FARWELL, J.—Is not the only object of sub-section (10) to protect the party against whom the Action is pending? (*Woolfe v. Automatic Picture Gallery Co. Ltd.* 20 R.P.C. 177; L.R. (1903) 1 Ch. 18 was referred to.)] That case only decided that an application under Section 18 was not suspended by a subsequent Petition for Revocation. The sub-section does not merely negative the amendment against the party to the pending proceeding. The Action in question was undisposed of, and therefore was pending at the date of the amendment. [Waller read the judgment of *Joyce, J.*, delivered on the 15th of March 1902 as to discontinuance. *Joyce, J.*, decided that the action was dead. Moreover the

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and E. Lycett.*

same point was raised in the pleadings in the Action before *Buckley, J.*, 20 R.P.C. 390.] It was not argued and the parties here are different. An Action is pending until Judgment is given or it is otherwise disposed of. [*Re Claggett's Estate*, L.R. 20 Ch. D. 637, at p. 653, and *Cropper v. Smith*, 1 R.P.C. 254; L.R. 28 Ch. D. 148 were referred to.]

Walter was called on to argue this point:—"Pending" in sub-section (10) has no reference to *lis pendens*. The Defendants' contention amounts to this: that in law if any step remains to be taken in an Action it is pending within the sub-section. In *Woolfe v. Automatic Picture Gallery Ltd.* (20 R.P.C. 177), it was pointed out that the sub-section could not be taken literally but that the true effect of Sections 18 and 19 is that when leave is given under Section 19, all the provisions of Section 18 apply. *Joyce, J.*, has found that the Action, said to have been pending, had been dropped by January 1899 by tacit consent; and the amendment was made two years after that date. The mere fact that no formal Order was made to end the Action is not sufficient, both parties acted on the belief that it had come to an end; and *Joyce, J.*, so found, although he said it was a *lis pendens* and restored it to the list. In *Farbenfabriken vorm. Bayer & Co. v. Bowker* (8 R.P.C. 389), *Romer, J.*, refused to go behind the Order of the Comptroller allowing the amendment. Sub-section (10), and Section 19 are for the protection of the party to the pending litigation only. The Action was not pending in the sense of being an active litigation.

FARWELL, J.—I do not see that I need trouble you *Mr. Bousfield*, unless *Mr. Walter* has any more authorities to cite. [*Mr. Walter*:—No, my Lord.] I do not see my way to depart from what appear to me to be the plain words of the Act of Parliament. I confess to having some feeling of regret; because there was not a substantial litigation existing. There was a litigation—a Writ was issued against *Lycett*, the individual, on the 8th of April 1897. The Statement of Claim was delivered on the 31st of May 1897; then the Defence was put in, the Statement of Claim was amended, and the Reply delivered on the 6th of April 1898. Notice of trial was given. In November 1898, the parties began to negotiate with a view to a settlement, and accordingly an application was made to the Judge that the case might be taken out of the Paper, and it stood over generally with liberty to apply to restore. In January 1899, an agreement was entered into between the parties for the settlement of their differences, but unfortunately, for reasons which I do not know, that was cancelled by mutual arrangement in August 1899, so that in August 1899 the parties were again at arms length. No further step was taken in the Action, and the parties appear to have let it go to sleep. In February 1901, the present Plaintiffs applied to the Comptroller for leave to amend, and an Order was made on the 9th of May 1901. On the 8th of February 1902, the present Defendants applied under the liberty to restore to have the case of *Brooks v. Lycett* restored to the list. It came on before *Mr. Justice Joyce*, and it is reported in the 19th Reports of Patent Cases, page 166. The head note is this, "Where an Action set down in the list for trial has been dropped by tacit agreement between the parties without any special or express stipulation, and without any provision in the event (which happened in this case) of the agreement for the settlement of their differences subsequently going off, Held, firstly, on the Motion of the Defendant, that the Action should be restored to the list; that it was a *lis pendens*, and could be restored; but, secondly, on the Motion of the Plaintiffs for leave to discontinue, that owing to the tacit agreement the Plaintiffs were entitled to discontinue it, if they chose to do so, each party to bear their own costs." Now the first is a decision of the learned Judge that the Action was a *lis pendens* which must be restored on the application of the party having liberty to restore, and required actual application for leave to discontinue before it came to an end. The result is that the Action appears to be an Action pending within the 10th sub-section of Section 18. The subsequent application

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to Mr. Justice *Joyce* was, and his observations there were merely directed to the question of costs. He did not intend to over-rule and reverse his finding of fact on which he had held already that the Action must be restored to the list. All he said was, "You came substantially to a settlement of your
5 "grievances, and you ought to have let the matter sleep, and I shall not
"give you any costs." That is the whole result, as I read it, of the Judgment. But he certainly has held, and I consider it binds me, that there was a *lis pendens*.

Then it is said that the 10th sub-section of Section 18 only applies between
10 the parties to an Action. Well I cannot see my way to so limit it. It is quite true that there are words in Section 19 which point to that view, because one does not quite see what the Defendant in the Action has got to do with the application and the leave being obtained by the Plaintiff from the Comptroller to amend his Patent. But, however that may be, I do not feel at liberty to
15 limit the very general words of sub-section 10, which are, "So long as any
"Action for infringement in relation to the Patent is pending." The Court of Appeal in *Woolfe v. Automatic Picture Gallery Company Ltd.* have no doubt put some limitation in order to make the Section work, but the Judgment is really, so far as I am concerned and for this present purpose,
20 summed up by Lord Justice *Cozens-Hardy* on page 26 of [1903] 1 Chancery. "It seems to me that Section 18, which must be read with Section 19, states what a patentee may do before he is in litigation, and Section 19 states "what he may do while he is in litigation." It seems to me that that is the true meaning. In the case of *Woolfe v. Automatic Picture Gallery* an
25 application was made for leave before any proceeding was taken for revocation of the Patent in that case, and it was held that the subsequent Petition for revocation did not affect the prior application for leave to amend, so that Section 18 did apply notwithstanding. It does not appear to me that that touches the case before me. The case before Mr. Justice *Romer*, seemed from
30 the Judgment, as it was read by Mr. *Walter*, to be in point, but when the dates are looked at it appears that it was exactly the same case as *Woolfe v. Automatic Picture Gallery*, because there the application for leave to amend was made before the proceedings were taken. The result is that I do not see my way to saying that this amendment can be deemed to be a
35 proper amendment, and I can only treat the Patent as unamended. But, in the circumstances (and I think it is very unfortunate that this should have happened) I must assent to Mr. *Walter's* application that this Action, so far as it relates to the second Patent, should stand over so that he may now apply for leave to amend.

40 The application was granted; the costs and the question of terms being reserved.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE WARRINGTON.

July 8th, 9th, 11th and 12th, 1904.

LYCETT SADDLE AND MOTOR ACCESSORIES COMPANY, LD.

v. J. B. BROOKS & CO., LD.

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Patent.—Action to restrain threats in respect of the sale of certain articles.—Action for infringement by owners of Patent.—Particulars of Breaches not alleging specifically infringement by particular articles against which the threats were directed.—Action whether within proviso to Section 32 of the Patents &c. Act, 1883.—Alleged mala fides.—Judgment for the Defendants.

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In April 1903, the Defendants, the owners of a Patent, issued circulars warning persons dealing in, or using any of the Plaintiffs' "saddles with "four, six or more wires made in infringement" of the Patent. They also subsequently made certain threats in respect of specific saddles of a pattern known as "L 5," "L 14" and "L 16." In May 1903, the Defendants commenced an Action against the Plaintiffs for infringement of the Patent, but the Particulars of Breaches did not mention these saddles; "L 5" and "L 14" had not been sold prior to the commencement of the infringement Action, and the Defendants alleged that they did not then know of "L 16." In November 1903, the Plaintiffs commenced this Action to restrain the Defendants from issuing threats in respect of "L 5," "L 14" and "L 16," and for damages. They based their Action both on Section 32 of the Patents &c. Act, 1883, and on a common law right, alleging mala fides on the part of the Defendants. The Defendants contended that their Action against the Plaintiffs was an Action for infringement within the proviso of Section 32, and was a defence under that Section, and they denied mala fides. At the trial, the Plaintiffs submitted that the issue whether the three saddles mentioned were infringements of the Patent should be decided in the threats Action, and contended that this question could not be decided in the pending Action for infringement. The Action for infringement had at the date of the trial of this Action, been stayed under the circumstances appearing in the Report thereof (ante p 655.)

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Held, that the infringement Action was an Action for the infringement of the Patent within the proviso to Section 32 of the Patents &c. Act, 1883, and that it constituted a defence to the threats Action so far as founded on that Section,

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that there was no evidence of mala fides in the Defendants conduct, and that under the circumstances it was unnecessary to decide the issue of infringement, which could be decided at some stage of the infringement Action. The Action was dismissed with costs.

- 5 On the 19th of November 1903, the *Lycett Saddle and Motor Accessories Company, Ltd.*, commenced an Action against *J. B. Brooks and Company, Ltd.*, for an injunction to restrain the Defendants, their servants and agents from continuing to threaten the Plaintiffs and their customers or any other person with any legal proceedings or liability by reason of any patent right claimed by
10 the Defendants in respect of the use sale or purchase of cycle saddles of the Plaintiffs' manufacture, and of the makes known and sold under the distinguishing names and marks "L 5," "L 14" and "L 16," or any of them, and for damages and costs. There had been several previous actions between Messrs. Brooks and *Lycett* or their respective Companies, which will be found
15 referred to in the opening speech of *Bousfield*, K.C.

- The Plaintiffs' by their Statement of Claim, as amended, alleged:—(1) That the Plaintiffs were an incorporated Company which carried on the business of manufacturers of saddles and other accessories used by the makers of bicycles and motor carriages; that they manufactured a great variety of
20 saddles of different makes and modes of construction. Such saddles were distinguished in the Plaintiff Company's advertisements invoices and other trade documents by specific and distinctive marks; that three such marks were "L 5," "L 14" and "L 16"; that these three marks denoted well-known types of bicycle saddles which had been extensively advertised,
25 and were successful saddles; that if their sale had not been interfered with in the manner complained of in the Action, they would be in wide request in the bicycle manufacturing trade; that the saddle denoted by the mark "L 16," had in fact been extensively sold by the Plaintiffs before the sale thereof was impeded by the Defendants' threats; (2) That the
30 Defendants were a Limited Company engaged in an extensive business in the manufacture of bicycles saddles and accessories, and were trade rivals of the Plaintiff Company; that the Defendants owned several patents for improvements in bicycle saddles, and had carried on during several years past an extensive litigation with the Plaintiffs, and with their predecessors in business,
35 on the footing of their claims of patent right; that in the month of April 1903, the Defendants obtained judgment against the predecessor in business of the Plaintiff Company, the said predecessor being at that time a Company in liquidation; that by the said judgment it was adjudged that a saddle sold under the mark "L 11" was an infringement of the Defendants' Patent,
40 No. 8553 of 1893, and relief was granted to them in respect of such infringement*; that the said infringing saddle was wholly different in the principle and mode of its construction from any of the aforesaid types, "L 5," "L 14" and "L 16," made and sold by the Plaintiff Company; that the Plaintiff Company had never dealt in saddles of the make of the said "L 11,"
45 or in any make of saddle which was in fact an infringement of any legal rights of the Defendants, that no action or proceeding at law had ever been taken by the Defendants against the Plaintiffs, or their predecessors in business, for restraining the manufacture or sale of the said saddles, "L 5," "L 14" and "L 16," or any of them; (3) That the Defendants had on various occasions,
50 falsely and maliciously alleged that goods made and sold by the Plaintiffs, and in particular the said saddles, "L 5," "L 14" and "L 16," were infringements of patent rights held by the Defendants, well knowing the allegation to be

* *J. B. Brooks & Co. Ltd. v. E. Lycett Ltd.* 20 R.P.O., 390.

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untrue, and claiming in respect of the said Patent, No. 8553 of 1893, to be patentees of an invention, according to which they alleged that the Plaintiffs' said saddles were constructed, had threatened the Plaintiffs and their customers and others, with legal proceedings and liability, in respect of the selling offering for sale dealing in and using the said saddles to the great grievance loss and injury of the Plaintiffs, and they intended and threatened to continue so to threaten the Plaintiffs and the Plaintiffs' customers unless restrained by the Order and injunction of the Court ;

(4) That the Defendants on the 29th of January 1904, applied for and obtained liberty from the Court in an action brought by the Defendants against the Plaintiffs, being action 1903 J., No. 859 to apply at the Patent Office for leave to amend the Specification of the Patent No. 8553 of 1893 by way of disclaimer ;

(5) That the following were particulars of such the Defendants' false and malicious statements and threats so far as were at present known to the Plaintiffs ; but the Plaintiffs would seek to recover damages in respect of all such statements and threats whether at present known to the Plaintiffs or not :

(i.) the Defendants caused to be inserted in *Cycling* on the 9th of May 1903 by way of advertisement an announcement concerning the judgment obtained as aforesaid in the preceding month of April against the Plaintiffs' predecessors in business and a threat that the Defendant Company would take legal proceedings against anyone found selling or using *Lycett* saddles with 4, 6, or more wires ;

(ii.) in the month of April 1903 the Defendants issued a circular to the trade to the same effect as above-mentioned, and sent such circular broadcast by post to the Plaintiffs' customers and other bicycle and motor-car manufacturers ;

(iii.) on the 20th of May 1903 the Defendants wrote and sent a letter to the *Premier Cycle Co. Ltd.* in which letter they falsely alleged that saddles of the make of L. 16 of the Plaintiffs' manufacture were infringements of the Defendants' patent rights, and threatened the Company with legal liability and proceedings in case they should have any dealings with the said saddles ;

(iv.) in or about August last the Defendants by *Arthur Caleb Johnson*, one of their managing directors falsely stated to a representative of the *Rudge Whitworth Company*, that the said saddle "L 16," was an infringement of the Defendants' Patent rights, and intimated that the Defendants would take steps to enforce legal liability against the said *Rudge Whitworth Company* in case they had dealings with any cycle saddles of that make ;

(5) On the 13th of October 1903, the Defendants wrote and sent a letter to *N. R. Heighton Ltd.* in which letter they falsely alleged that saddles of the make of "L 5," "L 14" and "L 16" of the Plaintiffs' manufacture, were infringements of the Defendants' patent rights, and threatened the said *N. R. Heighton Ltd.* with legal liability and proceedings in case they should have any dealings with the said saddles ;

(6) By reason of the premises, the Plaintiffs had been greatly hindered in their trade, and had suffered heavy loss and damage. Particulars of special damage in respect of which the Plaintiffs would seek relief in this Action, were as follows—(a) Loss of profit on an order for 12,000 cycle saddles of the "L 16" pattern, refused to the Plaintiffs by the *Premier Cycle Company* in May, 1903, in consequence of the Defendants' threats, £600 ; (b) loss of profit on an order for 30,000 cycle saddles of the "L 16" pattern, refused to the Plaintiffs by *Rudge Whitworth Ltd.* in August 1903, in consequence of the Defendants' threats, £1,500 ; (c) loss of profit on an order for 500 cycle saddles of the "L 5," "L 14" and "L 16" pattern, refused to the Plaintiffs' by *W. R. Heighton, Ltd.*, in October 1903, in consequence of the Defendants' threats, £25.

The Defendants by their Defence alleged :—(1) That on or about the 9th of May 1903, they commenced an Action* in the High Court of Justice, Chancery Division, against the Plaintiffs and one *Edward Lycett* (1903—J.—No. 859),

* Reported ante p. 651.

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- in which the Defendants claimed relief against the Plaintiffs in respect of their infringement of Letters Patent, No. 8553*, of the year 1893, by the sale of saddles of the same type as the Plaintiffs' saddles, "L 5," "L 14" and "L 16," in the Amended Statement of Claim referred to; that this Action was commenced within a few days after the registration of the Plaintiff Company, and had been prosecuted with due diligence, and that by an Order in the Action, made on the 29th January 1904, the said Action was stayed; (2) that, if in the said Action, when the stay should have been removed, the Defendants should recover judgment against the Plaintiffs, the question of the infringement of the said Letters Patent, by the manufacture and sale of the saddles "L 5," "L 14" and "L 16," would be raised upon the inquiry as to damages in the said Action; (3) that so far as the amended Statement of Claim, claimed relief under Section 32 of the Patents, Designs and Trade Marks Act, 1883, the said Action was an Action for infringement of Patent within the proviso to the said section, and the Defendants alleged that the Plaintiffs had no cause of action under the said section, and that the present Action was frivolous and vexatious, and an abuse of the process of the Court; (4) that so far as the amended Statement of Claim, claimed relief in respect of alleged false and malicious statements alleged to have been made by the Defendants, the Defendants said that—(A) They denied that they made the threats set out in paragraph 5 (i.) and (ii.) of the Amended Statement of Claim; (B) they did not admit the making of any of the threats set out in paragraph 5 (ii.), (iii.), and (iv.) of the Amended Statement of Claim; (C) if any of the threats set out in paragraph 5 of the Statement of Claim were made by the Defendants, which was not admitted, they were not made maliciously, but were made *bonâ fide* in protection of the Defendants' rights under Letters Patent 8553*, of the year 1893, which the Defendants were advised were infringed by the manufacture and sale by the Plaintiffs of the saddles "L 5," "L 14" and "L 16"; the Defendants before the date of any of the acts complained of, had commenced proceedings under the said Letters Patent against the Plaintiffs, being the Action referred to in paragraph 1, and the Defendants who were unaware of the manufacture by the Plaintiffs of the said saddles, "L 5," "L 14" and "L 16," at the date of the writ offered to include in the Particulars of Breaches in the said Action, and to try at the hearing of the said Action the question of whether the said saddles were infringements of the said Patent, instead of leaving the said question to be dealt with at the inquiry as to damages in the said Action, but the Plaintiffs declined to allow the said saddles to be included in the Particulars of Breaches; (5) that save as therein admitted, the Defendants denied each and every of the facts in the Amended Statement of Claim, alleged as if the same were specifically denied; (6) that by reason of the matters in paragraph 4 of the Defence alleged, the Defendants would allege that the Action was frivolous and vexatious, and an abuse of the process of the Court, and would ask that the Plaintiffs might be ordered to pay the costs of this Action as between solicitor and client.
- The Action came on for trial before WARRINGTON, J., on the 8th of July 1904.

- Bousfield*, K.C., and *J. W. Gordon* (instructed by *Beale & Co.*), appeared for the Plaintiffs; *A. J. Waller* and *J. H. Gray* (instructed by *Sharpe, Parker & Co.*, agents for *E. C. Newey & Son*, Birmingham), appeared for the Defendants.

- Bousfield*, K.C., opened the Plaintiffs' case.—There have been several actions between *Brooks* and *Lycett* or their respective Companies. The particulars of these are as follows:—In 1895, an Action was commenced by *Brooks & Co.*, against *Lycett* for infringement of Patent 8553 of 1893 and other patents in respect of a saddle "L 11," but this Action was discontinued. A second Action was commenced on the 8th of April 1897, on the same Patents, but on the 11th of November 1898, it was marked in the cause list to stand out of the list

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generally, with liberty to either party to restore ; at the time negotiations were proceeding for a settlement of the disputes between the parties, but such settlement subsequently fell through. In 1898, the businesses of both parties were turned into limited companies. In May 1901, the Specification of Patent, No. 8553 of 1893, was amended, but the leave of the Court to apply at the Patent Office for leave to amend, had not been obtained. This Patent relates to the spreading out of the wires of the cycle saddle behind, in order to support the weight of the cantle plate. In August 1901 *Brooks & Co. Ltd.* complained of a saddle marked "L 11," and on the 5th of November 1901 issued a writ against *E. Lycett Ltd.* in a third Action on the Patent 8553 of 1893, as amended. On the 8th of February 1902 the second Action was restored on the application of *Lycett, Joyce J.* holding that it was still pending ; and on the 15th of March 1902, he gave leave to *Brooks & Co. Ltd.* to discontinue it without costs (19 R.P.C., 166), and this Order was affirmed by the Court of Appeal (19 R.P.C., 364). On the 20th of February 1903, a fourth Action was commenced by *Brooks & Co., Ltd.*, against *E. Lycett Ltd.* alleging the infringement of another patent by another saddle. The Plaintiff Company in the present Action, was registered on the 1st of April, 1903, and on the 20th of April, 1903, resolutions were passed by *E. Lycett Ltd.* for a voluntary winding-up. On the 21st of April 1903, the third Action came on before *Buckley, J.*, and no one appeared for the Defendants, *E. Lycett Ltd.* and an injunction was granted as if the Patent had been properly amended, and a certificate was granted that the validity of the Patent came into question. On the 9th of May 1903, *Brooks & Co. Ltd.* commenced a fifth Action (*ante p.*), namely against the Plaintiff Company in the present Action for infringement of Patent 8553, and of another Patent complaining of four saddles, not being those to which the present Action relates. The saddles to which the present Action relates, are cases of the duplication of wires and not of the spreading out of wires as in the Specification of the Patent, No. 8553 of 1893 ; none of the saddles referred to in the present Action were referred to in any of the five actions above mentioned, and 17,000 saddles of "L 16" form, had been sold between July 1902, and May 1903, so that *Brooks & Co. Ltd.* must have known that the Plaintiffs were selling it. [*Walter.*—They did not in fact know of it.] There will be evidence on that point. The saddles "L 5" and "L 14," were brought out just after the fifth Action was commenced. On the 29th of January 1904, *Farwell, J.*, held that the amendment of the Specification of Patent, No. 8553, of 1893, was invalid, as the second Action was pending at the date of the application to the Patent Office for leave to amend, and he made an order staying the proceedings, but gave *Brooks & Co. Ltd.* liberty to apply at the Patent Office for leave to amend (*ante p.* 655). The Order was passed on the 17th of March 1904, and an application was made at the Patent Office on the 24th of March 1904, but no amendment has yet been made. As to the threats, "L 11" is the only saddle in respect of which an injunction has been obtained, and 18 out of 22 patterns of the Plaintiffs' saddles have four, six or more wires. There is no Action in which any of the saddles "L 5," "L 14" and "L 16," are complained of as infringements, and the Plaintiffs have a good cause of Action under Section 32 of the Patents &c. Act, 1883, and also under the common law, for the circumstances show that the threats were not made *bonâ fide*.

The witnesses for the Plaintiffs were then called, including *E. Lycett*, and evidence was given to show that "L 5," "L 14" and "L 16," were not infringements of the Patent, as well as evidence on other points.

At the conclusion of the Plaintiffs' evidence, *WARRINGTON, J.*, said that if the Defendants were prepared to accept a decision not involving the question of infringement, he was, subject to argument, prepared to hold that the existing Action (that is to say that commenced on the 9th of May 1903,) was within the proviso of Section 32, and that there was no evidence of *mala fides*.

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- Bousfield, K.C., and Gordon, for the Plaintiffs.*—Under Section 32, an Action for infringement cannot be a defence to a threats Action, unless it is brought in respect of things covered by the threats. There is no Action for infringement by the Defendants, in which “L 5,” “L 14” or “L 16,” is complained of.
- 5 [*Walter.*—Those saddles will come in on the inquiry.] The Action must be one to bring to the test the question raised by the threats. [The Particulars of Breaches in the infringement Action before *Farwell, J.*, were referred to; see ante p. .] The Plaintiffs have lost large orders by reason of the threats, principally for “L 16.” One of the objects of Section 32 is to provide an Action
- 10 in which the question between the parties can be decided. It is here very important to the Plaintiffs to have the question, whether “L 5,” “L 14” and “L 16,” are infringements decided, and they desire to have a decision on that in this Action. Even if the question could be decided in the Action before *Farwell, J.*, it is adjourned on the application of the present Defendants. As
- 15 to the proviso—[*WARRINGTON, J.*—The view I take is that the Defendants have commenced, and are prosecuting an action on the Patent]. But if they succeed, they will not get a decision on the points now raised; it is not sufficient that they would get an injunction in general terms. The action must raise the specific question. The intention to bring an action is made a test of *bonâ fides*
- 20 [*Halsey v. Brotherhood*, L.R. 15 Ch. D. 514, and L.R. 19 Ch. D. 386, and *Barrett v. Day*, 7 R.P.C. 54; L.R. 43 Ch. D. 435]. Section 32 gives a Patentee a right to threaten, provided that he brings the subject-matter of dispute to a test. Section 29, as to Particulars, must be read with Section 32, a Patentee is thereby made to specify the matters of which he complains.
- 25 An Action to be within the proviso to Section 32, must bring to a test the propriety of the particular threats made. The Defendants must have known of “L 16,” when they brought the infringement Action, or at all events before the Particulars of Breaches were delivered. The Defendants have not acted with *bonâ fides*. In fact the Plaintiffs have closed their case in the infringement
- 30 Action, and no evidence has been adduced as to “L 16.” The Defendants really threatened in respect of all saddles made by the Plaintiffs, with four, six or more wires, that is how the trade would interpret the threat. Questions of infringement and validity may have to be decided in a threats Action (*Challender v. Royle* 4 R.P.C. 363). If the real question between the parties on
- 35 these saddles is not in train to be decided, it should, we submit, be decided now. At the present time, the Defendants are not in a position to sue on their Patent, either on the amended or the unamended Specification. *Smith, L.J.*, in *Skinner v. Perry* (10 R.P.C. 1), said that the Action brought under the proviso to Section 32, must be one to show the validity of the threats. The words “for
- 40 “infringement of his Patent” in the proviso must have some limit put on them. As a matter of fact, the question of infringement is a different one from that in the Action before *Farwell, J.*

Counsel for the Defendants were not called on.

- WARRINGTON, J.*—This is an Action instituted by the Plaintiffs for the
- 45 purpose of obtaining an injunction restraining the Defendants from threatening the trade with proceedings in respect of certain bicycle saddles manufactured by the Plaintiffs, which, it is alleged, are an infringement of a Patent of the Defendants. The Action is founded first upon Section 32 of the Patent Act of 1883, and, secondly, upon the general jurisdiction of the Court at Common
- 50 Law. The facts of the case are simple, but I will shortly state them.

- The Plaintiffs are a Limited Company called the *Lycett Saddle and Motor Accessories Company, Limited*, and the Defendants are a Limited Company called *J. B. Brooks and Company Limited*. They are the successors in business, in the case of the Plaintiffs, of first Mr. *Lycett*, and afterwards of a
- 55 Company called *Edward Lycett Limited*; and in the case of the Defendants, of Mr. *Brooks*. They are both manufacturers of bicycle saddles. The Defendant Company are the owners of a Patent—one amongst a great number, but the only

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one with which I need concern myself—No. 8553 of 1893. There has been considerable litigation between these rival manufacturers, beginning in the year 1895. I need not trouble as to the details of those proceedings. No fewer than five Actions for infringement have been brought either against Mr. *Lycett* or against *Edward Lycett Limited* and with regard to the fifth Action against the present Plaintiff Company. On the 21st of April 1903 the present Defendants obtained an injunction against *Edward Lycett Limited* in what has been here referred to as the third Action, restraining the infringement of the Patent No. 8553 of 1893. On the 1st of April of the same year, the present Plaintiff Company was registered. On the 20th of April, that being the day before the granting of that injunction, *Edward Lycett Limited* was wound up, and, as I understand, no business is now being carried on by *Edward Lycett, Limited*; but the business is being carried on by the present Plaintiff Company.

The threats in respect of which this Action has been brought are really four in number, though they are stated in the claim to be five. They consist, first, of a circular and an advertisement in the newspaper "Cycling." The advertisement appeared in the newspaper on the 9th of May; the circular was sent out a few days earlier. The one I hold in my hand was received by the *Premier Company* on the 6th of May. They are in identical terms. They are headed, "In the High Court of Justice. *Brooks v. Lycett*." And then they state, quite correctly, the effect of the judgment of the 21st April 1903, against *Edward Lycett, Limited*. They then state, quite correctly also, that the Defendants, that is *Edward Lycett Limited* "have transferred, or are transferring their business to the *Lycett Saddle and Motor Accessories Company Limited*" and "warning is hereby given that the Plaintiffs in the above Action, *J. B. Brooks and Company Limited* will immediately proceed for an injunction, delivery up, damages, and costs against any one found selling, offering for sale, dealing in or using any *Lycett* saddles with four, six, or more wires, made in infringement of the said Letters Patent."

I take that circular to mean this:—We have got an injunction against the infringement of the Patent No. 8553 of 1893, and we will proceed against persons selling, offering for sale, dealing in, or using saddles made in infringement of the Letters Patent; further defining the saddles against which such proceedings would be taken as those containing four, six, or more wires. That is the first of the alleged threats, and it will be observed that so far as that is concerned there is no threat against any particular saddle; it is merely a statement that they will proceed to enforce the rights to which they have been found entitled in the judgment referred to in that circular.

The other three threats are more specific. On the 30th of May, in answer to an inquiry by the *Premier Company*, a letter was written to the *Premier Company*, stating that a certain saddle called "L 16" was in the opinion of the present Defendants an infringement of their Patent. A similar threat, but by word of mouth, also in reference to "L 16," was made to a representative of the *Rudge Whitworth Company* in August, and in October a letter was written to a Mr. *Heighton*, alleging that three saddles, "L 5," "L 14" and "L 16," were infringements of the Patent.

Meanwhile, on the 9th May 1903, the Action which I have called the fifth Action, had been instituted against the present Plaintiffs for infringement of Patent, No. 8553 of 1893. The Statement of Claim contains the usual allegation:—"The Defendants have infringed and threatened to infringe both the said Letters Patent"—there was another one referred to in the claim—"in manner in the Particulars of Breaches herewith delivered appearing." With that, were delivered Particulars of Breaches which refer to certain saddles, but do not refer to either "L 16," "L 5" or "L 14," the three saddles in respect of which the threats that I have mentioned, had been made.

There is only one other fact which I think I need mention. The Action came on for trial in the early part of this year: objection was taken that an

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amendment of the Specification which had been made pending one of the previous Actions, which at the time of amendment had gone to sleep, and afterwards came to an end, was an invalid amendment of the Specification; application was made by the Plaintiffs for liberty to apply at the Patent Office for leave to amend; it was granted, and the Action is for the moment stayed pending the application to the Patent Office which has been made, and is opposed by the present Plaintiffs.

Those being the facts, I have to consider Section 32, which is as follows:—
 10 “Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby, may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been
 15 “sustained thereby, if the alleged manufacture, use, sale, or purchase, to which the threats related, was not in fact an infringement of any legal rights of the person making such threats. Provided that this Section shall not apply if the person making such threats with due diligence, commences and prosecutes an action for infringement of his Patent.” In my view the only
 20 question I have to decide under this Section is whether the proviso applies to the case or not. If the person making the threats with due diligence commences and prosecutes an action for infringement of his Patent, the Section is not to apply, and if I am satisfied that the Defendants in this case have done that which is mentioned in the proviso, I have nothing more to decide, and my
 25 duty is at an end.

Before I consider that, I will just make this observation, I have been invited by the Plaintiffs to decide the question whether the three saddles, “L 5,” “L 14” and “L 16,” are or are not infringements of the Defendants’ Patent. Taking the view which I am about to express on the proviso, I do not think I
 30 ought to do so. It would be quite useless, because if I decided that they were infringements, the Action of the Plaintiffs would fail; if I decided that they were not infringements, the Plaintiffs would equally fail, assuming that I am right in the view I am about to express on the proviso; and for that reason I think I am not at liberty to require the parties (because that is what it comes
 35 to) to try an issue, the determination of which cannot affect the result of the case, which would be the same whichever way that issue was determined. At the close of the Plaintiffs’ case, I put the view which I am now expressing to Mr. *Walter*, and he acceded to it, and has not called any evidence to prove that the three saddles are infringements. On the other hand the
 40 Plaintiffs have produced the saddles, and they have called certain evidence, not expert, except so far as Mr. *Edward Lycett* himself is an expert, to prove that the three saddles are not infringements. I propose to express no opinion upon that evidence except to say this: that if I had been obliged to decide the issue, I should not have decided that the three saddles were infringements
 45 without being instructed further by evidence on the point.

Now I come to the proviso. Has the person making the threats—that is the Defendants in this case—within the meaning of the proviso, commenced, and is he prosecuting an Action for infringement of his Patent? The fifth Action is one for infringement of the Patent which the Defendants maintain has been
 50 infringed by the three saddles here in question. They therefore come within the words of the proviso. Do they come within the substance of it? I think they do. I must examine the words a little more closely. What is the Patent which is referred to? As to that I think there is no doubt that it is the Patent on which the person making the threats relies. Now the Statute says
 55 no more. It does not say that he shall in his Particulars of Breaches specify the particular thing in respect of which he makes the threats, and I think that the Legislature advisedly omitted that requirement, because the threat might be

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a general threat, it might be a threat in regard to a number of things extremely similar with very minute differences, and it might be very oppressive to put upon the Plaintiff in the Patent Action, the necessity of specifying all these things in his Particulars of Breaches. But I think the point really is this: that all that one has to find is that there is an Action for infringement of the Patent. A good deal of confusion in my view has been introduced by seeking to import into the consideration of what is an Action for infringement of a Patent, the provisions of the Patent Act relating to Particulars of Breaches. It appears to me that the object of those provisions is first to limit the expense at the trial, and, secondly, to give to the Defendants fair notice of the particular things to which the evidence of the Plaintiffs will be directed. But the Action is, for all that, an Action for infringement of a Patent generally, and, if an injunction is obtained, the Plaintiffs will not be limited to their Particulars of Breaches either in pressing for a committal for breach of the injunction, or under the account of profits or the inquiry as to damages. It seems to me, therefore, that the fact that the saddles in question, "L 16," "L 5" and "L 14," are not specified in the Particulars of Breaches, so that the question whether they are or are not infringements will not be determined at the trial, is not material to the case. "L 5" and "L 14" could not have been included in the Particulars of Breaches, because they were not being used at the date of the issue of the writ. "L 16" was. It seems to me, therefore, that the proviso does apply, that the Defendants have commenced, and it is not alleged that they are not with due diligence prosecuting, an Action for infringement of the Patent, and therefore the section does not apply.

It has been said that this view prevents the remedy which it was the object of the Legislature to provide in enacting this section, namely, that the threatener shall bring to the test what Lord Justice *A. L. Smith* called the validity of his threats. In my view it does not, because although it is quite true that at the trial the question of whether or not the particular articles are an infringement will not be raised, it is an issue in the Action, though not at that stage of it. If the Defendants in the Patent Action insist on continuing to sell the things in respect of which the threats are made, and the Plaintiffs have obtained an injunction, and an account of profits or an inquiry as to damages, the question as to those articles will then have to be decided. It seems to me, therefore, that it is an Action which involves the decision of that question, though not at the particular stage.

If the section does not apply, have the Plaintiffs any remedy under the ordinary Law? There the Plaintiffs are in a much worse position than under the section, because it is necessary for them suing under the Common Law to prove not only that the statements are untrue, but that they are made maliciously, or, as it has been sometimes expressed, without reasonable and probable cause. I have listened carefully to the whole of the evidence given on the part of the Plaintiffs, on whom of course the onus would rest on this part of the case, and I can find no trace of anything like *mala fides* in the threats issued by the Defendants. I think that the Defendants were doing no more than doing what they could to protect their Patent, and I see no evidence of malice in their proceedings. I think, therefore, that the Action as founded on the Common Law fails also.

The result is that there must be Judgment for the Defendants, with costs.

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IN THE COURT OF SESSION IN SCOTLAND (OUTER HOUSE).

Before LORD KYLLACHY.

November 7th and 19th, December 1st and 17th, 1903, January 6th, May 31st,
 June 1st and 16th, 1904.

5 ANDREW G. BARR AND CO. *v.* MAIR AND DOUGALL.

G. AND C. MOORE *v.* MAIR AND DOUGALL.

JAMES ORR COMRIE *v.* MAIR AND DOUGALL.

Trade Mark engraved on syphons.—Property in syphons.—Bottle Exchange.—
One member interdicted from using another's syphons.

- 10 B. & Co., M., and C., the three Complainers, and M. and D., the Respondents,
 were all manufacturers of aerated waters and members of a Bottle Exchange.
 When their full syphons were sent to customers they received in return empty
 syphons, sometimes marked with their own name, sometimes plain, sometimes
 marked with the names and Trade Marks of other manufacturers. The last
 15 it was their duty by the Rules of the Bottle Exchange to send to the Exchange.
 Instead of doing this the Respondents had filled with their aerated water a
 number of syphons of the Complainers and sent them to W. and W. in execution
 of an order for the Respondents' aerated waters.

 Held that the Complainers were entitled to interdict the Respondents from so
 20 using their syphons.

 Semble that if W. and W. had sent to the Respondents empty syphons
 belonging to the Complainers and bearing their Trade Mark and had requested
 the Respondents to return these syphons full, and if the Respondents had done
 so they would have been participants in an illegal practice involving (1) a
 25 wrongful appropriation of the Complainers' property and (2) an illegal use of
 the Complainers' Trade Marks, against which the Complainers would have been
 entitled to interdict.

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These were actions between aerated water manufacturers to prevent the Respondents from using, in connection with their business, bottles marked with the names and Trade Marks of the Complainers. The Complainers in the first action were *Andrew G. Barr & Co.*, aerated water manufacturers, 184 Great Eastern Road, Glasgow, and the partners in the firm; in the second, *G. and C. Moore*, aerated water manufacturers, 181 Mordaunt Street, Glasgow, and the partners in the firm; and in the third, *James Orr Comrie*, aerated water manufacturer, 700 Garscube Street, Glasgow. The Respondents in all three actions were *Mair and Dougall*, aerated water manufacturers and bottlers, 35 Annfield Street, Glasgow, and *Andrew Dougall*, aerated water manufacturer there, the only known partner of said firm of *Mair and Dougall*, as such partner, and as an individual. All parties were members of the Glasgow and West of Scotland Aerated Water Manufacturers' Defence Association, Ltd., in connection with which a Bottle Exchange had since 1898 been established.

The Complainers, in carrying on their businesses, were in the habit of delivering and lending boxes bottles and syphons containing the aerated waters manufactured by them to their customers in Glasgow and district, on the understanding that said boxes bottles and syphons were to be returned when empty. The boxes bottles and syphons thus lent by the Complainers to their customers had impressed, moulded, engraved, or otherwise marked thereon the names of the various Complainers. The said bottles and syphons also bore the Complainers' registered Trade Marks. The Complainers did not sell the said boxes bottles or syphons to their customers, but merely lent them. The said boxes bottles and syphons were made for and purchased by the Complainers, and never ceased to be their property. The price of the bottles and syphons was not charged to the customers at the time of delivery. According to the custom followed by the Complainers and others, purchasers of said aerated waters in bottles and syphons at the time of delivery must hand in exchange to the vanman, or person giving delivery, an equal number of empty bottles or syphons, and it is immaterial to the seller whether the bottles or syphons belong to other manufacturers or not. According to the custom in Glasgow, the seller is not supposed to refill bottles or syphons belonging to other manufacturers, but is expected to send them in to the Bottle Exchange, from which he also receives such of his own bottles and syphons as have been collected by other members of the Exchange. Besides the name and Trade Mark engraved on the bottles and syphons they had ordinarily affixed to them an adhesive label giving the manufacturer's name, and indicating the nature of the aerated water.

The Respondents also supplied some of the Complainers' customers and others in the same trade in Glasgow and the district with aerated waters, and in particular *Wallace and Watson*, chemists, 71, Saint Vincent Street, Glasgow, who were not members of the Bottle Exchange. The Complainers averred that many of the syphons supplied to them by the Respondents were the property of the Complainers, and had their name and Trade Mark on them. In supplying chemists, such as *Wallace and Watson*, it is the custom in Glasgow for aerated water manufacturers not to put their own paper label on the syphons, bottles, &c., but to allow the chemists to put their own paper label on after delivery to them. On the 11th and 15th of September 1903 certain officers of the Glasgow and West of Scotland Aerated Water Manufacturers Defence Association, Limited, acting on behalf of the Complainers, purchased from *Wallace and Watson* numbers of syphons of soda water engraved with the names of the various Complainers. These had all been filled and supplied to *Wallace and Watson* by the Respondents, who knew that the Complainers averred that they were their property. With reference to their trade with *Wallace and Watson*, the Respondents explained that the business with these people was of a different

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character from the ordinary business done in the aerated water trade. The Respondents, like other manufacturers, sell their aerated waters in bottles and syphons belonging to themselves, and bearing their name, and they affix to such bottles and syphons their label, also bearing their name and indicating the nature of the aerated water supplied. The Respondents, in such dealings, not only sell their aerated waters, but give the purchasers the use of bottles and syphons, and take the risk of these being damaged or broken in transit. The Respondents' charge for supplying syphons in this way is 3s. per dozen, the syphons being returned when empty, or other syphons being exchanged at the time of delivery. *Wallace and Watson*, however, did not purchase the Respondents' aerated waters in their bottles and syphons in the ordinary course of business, but merely purchased from them a certain quantity of their aerated water, and sent out to the Respondents' premises syphons without labels thereon for the purpose of having them filled with aerated waters. The Respondents filled such syphons with their aerated waters, but did not affix their labels, and they returned them to *Wallace and Watson* to be dealt with as they thought best. The Respondents alleged that they had no knowledge of the ownership of the syphons sent to them by *Wallace and Watson*, and were not concerned whether *Wallace and Watson* had a good title to said syphons or not. The Respondents merely filled the vessels or other receptacles sent to them by *Wallace and Watson* for that purpose, and they could not inquire whether vessels or receptacles sent to them by their customers to be filled were the property of such customers or not. A Trade Mark or trade name on a syphon is not a reliable indication of the property in said syphon, and when businesses are wound up syphons are frequently sold in large quantities. They fall into the hands of people who do not take the trouble to alter the name thereon, but rely on the label affixed to truly intimate to the public the manufacturer of the waters they contain. The price charged by the Respondents to *Wallace and Watson* for filling their said syphons was 1s. 9d. per dozen.

With regard to this explanation the Complainers rejoined that it was not made matter of agreement between *Wallace and Watson* and the Respondents, nor was it ever contemplated by *Wallace and Watson* that the Respondents should supply *Wallace and Watson* with aerated waters in any other syphons than those of *Wallace and Watson* or of the Respondents, and it was a matter of complaint by *Wallace and Watson* to the Respondents that they were supplying aerated waters to them in syphons belonging to the Complainers and other aerated water manufacturers. If *Wallace and Watson* ever returned empty syphons to the Respondents other than those belonging to themselves or the Respondents, that was because the Respondents had in the first instance supplied them with aerated waters in such syphons. During the year 1902-3, the Complainers pointed out, the Respondents sent in to the Exchange only 44 syphons, and took out 456 syphons. Since complaints were made to the Respondents of their using other manufacturers' syphons, the number of syphons sent in by the Respondents increased to 90 in three months, while in the same period they took out 104 syphons. Repeated warnings (well known to the Respondents) had been sent out by the Manager of said Association to manufacturers in the trade, pointing out the illegality of filling bottles or syphons, or using bottles syphons or boxes bearing the name or registered Trade Mark, and being the property of members of the Association, including the Complainers. This was also forbidden by the Rules of the Exchange, by which the Respondents, who were members, were bound.

The Complainers stated the following pleas :—“(1) The Respondents having “illegally and unwarrantably, both at common law and by breach of the “provisions of the Merchandise Marks Act 1887, used, and being in the habit

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"of so using, bottles and syphons belonging to the Complainers which have
 "impressed, moulded, engraved, or otherwise marked thereon their name and
 "registered Trade Mark or other inscription as above set forth, the Complainers
 "are entitled to interdict as craved. 2. The Respondents having filled and
 "used in the course of their trade bottles and syphons belonging to the 5
 "Complainers and known by them to belong to the Complainers, the
 "Complainers are entitled to interdict as craved. 3. The Respondents being
 "bound (a) in accordance with the custom of the trade in Glasgow, and (b) as
 "members along with the Complainers in the Association referred to, not to
 "refill the Complainers' bottles and syphons delivered to them by or collected 10
 "by them from their customers, but to return the same to the Complainers
 "through the Bottle Exchange, the Complainers are entitled to interdict as
 "craved. 4. The Complainers having sustained, and having good reason to
 "apprehend that they will continue to sustain, loss, injury, and damage through
 "wrongful and illegal acts of Respondents, as above mentioned, are entitled to 15
 "interdict as craved, with expenses. 5. In the circumstances stated, the
 "Complainers are entitled to *interim* interdict as craved."

The Respondents pleaded:—"1. The Respondents not having used the
 "Complainers' property in the manner libelled, and the Complainers having
 "no ground for apprehending any infringement of their rights, interdict is 20
 "unnecessary and should be refused. 2. The Respondents being within their
 "rights in filling all vessels or receptacles sent to them by any of their
 "customers for the purpose, without enquiring into their customers' title to
 "same, the Note should be refused, with expenses. 3. The Complainers'
 "statements, so far as they are material, being unfounded in fact, the Note 25
 "should be refused, with expenses."

The interdict craved was in these terms: "To interdict, prohibit, and discharge
 "the Respondents, and all others acting under them, or by their instructions or
 "authority, from filling with aerated waters, and sending out or otherwise using
 "in connection with their business of aerated water manufacturers, or as their 30
 "property, bottles and syphons, impressed, moulded, engraved, or otherwise
 "marked with the name or Trade Mark of the Complainers; and to grant
 "*interim* interdict in the terms above mentioned."

On the 7th of November 1903, the Lord Ordinary on the Bills (Lord
 PEARSON) granted *interim* interdict without caution. On the 19th of November, 35
 having considered the Note for the Respondents, he allowed answers to be seen
 and appointed parties to be heard, and on the 1st of December, having heard
 parties, he passed the Note from the Bill Chamber to the Court of Session and
 continued the interdict on caution as offered. On the 17th of December the
 case was sent to the Adjustment Roll. On the 6th of January 1904, Lord 40
 KYLLACHY (Lord Ordinary) closed the Record and appointed a proof which was
 taken on the 31st of May and the 1st of June 1904. The Counsel for the Com-
 plainers were *Salvesen, K.C.*, and *D. Anderson* (instructed by *James A. B.*
Horn, S.S.C.). The Counsel for the Respondents were *Deas and Spens*
 (instructed by *Simpson and Marwick, W.S.*). The facts established at the 45
 proof appear from the narrative above and from the Lord Ordinary's Opinion
 below. There was a conflict of evidence as to whether the syphons marked
 with the Complainers' Trade Mark, found on *Wallace and Watson's* premises,
 had been collected by *Mair and Dougall* from customers in the course of trade,
 filled by them and sent to *Wallace and Watson*, or whether they had been 50
 received by the latter from the Complainers, who also supplied them, sent to
Mair and Dougall and returned full by them. It appeared that *Wallace and*
Watson did not send the syphons to their customers, but merely sold aerated
 water across the counter.

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Counsel for the Complainers contended that instead of returning Complainers' syphons, which their vanman had received, the Respondents had used them to implement an order of *Wallace and Watson's*. Even if the Respondents had in the first instance received the syphons from *Wallace and Watson* to be filled, as they stated, they had been parties to an illegal act. As members of the Bottle Exchange as well as at common law they had a duty not to fill the syphons of other members, thus taking the use of them and depriving their owners of the use for the time. This was an unlawful, though temporary appropriation of another's property. Even though the Trade Mark was applied to syphons only used in *Wallace and Watson's* shop, and not sold to the public, there was breach of the Merchandise Marks Act 1887, and of the common law. This was a case of Trade Mark and different from trade name cases, such as *Bayer v. Baird* ("C.B. Corset" Case) 15 R.P.C. 615; 25 R 1142, and *Cellular Clothing Company v. Marton* (16 R.P.C. 397; 25 R 1098). In these last probable deceit was essential, but the mere use of a Trade Mark, apart from probable deceit, is illegal. *Woolley & Sons v. Morrison* (21 R.P.C. 63) is distinguishable; where there was a trade custom of indiscriminate use which had not had time to be displaced. Here the Exchange has existed much longer; all parties are members of it, and no trade custom of indiscriminate use is put forward in defence.

Counsel for the Respondents contended:—It is not *Wallace and Watson* the parties found in possession of the syphons who are being sued, but *Mair and Dougall*, who are reported to have supplied these syphons. The onus of proof that they did supply them clearly lies on the Complainers. Counsel then discussed the evidence in detail.

Lord KYLLACHY made *avizandum*. On the 16th of June he advised the case as follows:—In this case I have had the opportunity since the close of the proof of reading the notes of evidence. I was anxious to do so particularly with reference to some of the points which were forcibly urged by Mr. Deas. The result, however, is that I am unable to hold otherwise than that the Respondents have committed as against each of the Complainers a legal wrong, against the repetition of which they are entitled to interdict.

I must own that I have a strong impression that such would be the legal result even if I accepted absolutely the Respondents' statement that the whole of the syphons which they filled for *Wallace and Watson* were supplied for that purpose by the latter firm. For, supposing the fact to be so, it is not to my mind conceivable—having regard to the practice of the trade since 1898 and the Respondents' knowledge of that practice—that they (the Respondents) could have supposed—or at all events had reasonable grounds for supposing—that *Wallace and Watson* had right to the syphons in question, or had right to use them.

Accordingly it appears to me that in filling with aerated water, syphons belonging to the Complainers and stamped with their Trade Marks, and sending out the syphons so filled to be re-sold by *Wallace and Watson*, the Respondents were, upon their own showing, participants in an illegal practice—a practice involving (1) a wrongful appropriation of the Complainers' property; and (2) an illegal use of the Complainers' Trade Marks. But while that is my impression, it is unnecessary, as it happens, to decide the case upon that ground. For upon the proof I am of opinion that the weight of the evidence is to the effect that the syphons in question were not supplied by *Wallace and Watson*, but were syphons which had been collected by the Respondents in the course of their business, and which in ordinary course should have been returned, and returned immediately, to the Bottle Exchange. I do not say that the Complainers' syphons were collected systematically and by preference—

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the Respondents' own syphons being systematically left to find their way to the Exchange, and thence back to the Respondents—or even that the Respondents encouraged or failed to discourage such conduct on the part of their vanmen. But it is I think proved, and indeed it seems to me inevitable, that at least some proportion of foreign syphons were, and in ordinary course had to be, accepted 5 by the Respondents' vanmen in exchange for their own syphons. That indeed was the basis on which the Bottle Exchange was founded; and on which the Respondents and the Complainers became members of the Exchange.

Such being the fact—there being almost necessarily a collection by the Respondents of foreign syphons to a greater or less extent—it is, I think, further 10 established that the syphons so collected by the Respondents did not all of them, during the period in question, find their way back to the Exchange, but were partly and to a considerable extent used for the purpose of the Respondents' contract with *Wallace and Watson*. I acknowledge that there is a conflict of evidence on that point, and I acknowledge also that in solving that conflict 15 there is one fact which has to be kept in view—viz., that, although entitled under their contract with *Wallace and Watson*, to make an extra charge of 3d. per dozen if the syphons filled were supplied by themselves, the Respondents did not exact such extra charge. But the suggestion is—what is at least possible 20—that the Respondents waived or omitted to exact the extra charge in order the better to preserve their hold on *Wallace and Watson's* custom, and were able to do so by this irregular use of foreign syphons. At all events, the circumstance is only one among other circumstances which require to be weighed; and on the whole I think, as I have said, that the weight of the evidence is in favour of 25 the Complainers and against the Respondents.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE WARRINGTON.

June 1st, 1904.

JOHN KNIGHT & SONS, LD. v. CRISP & CO., LD.

Passing-off.—Isolated case by shop assistant proved.—No damage to 30 Plaintiffs was proved nor any fraud on the part of the Defendants, nor any intention of repeating the act complained of.—Action as to passing-off dismissed with costs.

John Knight & Sons, Ltd. v. Crisp & Co., Ltd.

The Plaintiffs, John Knight & Sons, Ltd., soap manufacturers, sold soap known as "John Knight's Primrose Soap," and they commenced an action against a Company carrying on business as retail drapers and grocers, for a certain breach of contract in regard to the sale by the Defendants of Primrose Soap, and for passing-off soap not of the Plaintiffs' manufacture as or for soap of the Plaintiffs. The only case of passing-off proved at the trial was that a person sent by the Plaintiffs to the Defendants' shop in reference to the breach of contract, asked for a bar of "John Knight's Primrose Soap," and was given a bar of "Crisp's Imperial Primrose," with a representation that it was manufactured by the Plaintiffs', which was not the fact; but it was not proved that the assistant making the representation did so with the intention of deceiving, or that he did not make it merely by mistake.

Held, that the one instance of passing-off, without any intention to continue doing so or any proof of damage, did not constitute a ground of action. The action so far as founded on passing-off was dismissed, and the Plaintiffs having established a breach of contract, it was agreed that there should be no costs on either side.

On the 2nd of December 1903, John Knight & Sons, Ltd., carrying on business as soap manufacturers at the Royal Primrose Soap Works, Silvertown, West Ham, commenced an action against Crisp & Co., Ltd., carrying on a large business as retail drapers and grocers at Holloway, London, claiming:—(1) an injunction restraining the Defendant Company, their managers, assistants, and servants, from advertising and offering for sale, and from selling any soap not of the Plaintiffs' manufacture as "John Knight's" soap, or otherwise as or for the soap of the Plaintiff Company. (2) An injunction restraining the Defendant Company, their managers, assistants, and servants from advertising and offering for sale, and from selling the Plaintiff Company's "Primrose Soap" at less than 7½d. per bar, in breach of a verbal agreement made in the month of September 1903, between the Plaintiff Company and the Defendant Company, that the Defendant Company should not after the 24th day of September 1903 sell such soap at less than the said price; (3) damages; and (4) costs.

The Statement of Claim contained the following allegations relating to the passing-off part of the case:—

(2) That the business of the Plaintiff Company was established in the year 1817 by the late John Knight, and had from that time to the present been continuously carried on by him and his descendants; that in August 1902, the said business was converted into a Company, namely the Plaintiff Company; (3) that the said John Knight was the original maker of a high-class yellow soap known as "Primrose Soap," that the character and quality of this soap caused it to be largely sold, that it became celebrated both at home and abroad, that it was now known throughout the world, both in the trade and by the public, as one of the most important articles of household consumption, and there was a large demand for it; (9) that on the 24th of November 1903, the Defendant Company at their premises in Holloway, offered for sale and sold to one Amy Hooper, a bar of soap as and for "John Knight's Primrose Soap" or "Primrose Soap" of the Plaintiff Company, but which in fact was not made or sold by the Plaintiff Company, and was of a quality much inferior to that of the Plaintiff Company's "Primrose Soap"; (10) that by reason of the conduct of the Defendant Company as mentioned in paragraphs 8 and 9 thereof, the Plaintiff Company

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had sustained serious damage; (12) that the Defendant Company, unless restrained by the Order of the Court, would continue to offer for sale, and would sell soap as and for "*John Knight's Primrose Soap*" or the "*Primrose Soap*" of the Plaintiff Company, but not made or sold by the Plaintiff Company, to the further damage of the Plaintiff Company.

The Defendants by the 5th paragraph of the Defence denied each and every of the allegations contained in paragraph 9 of the Statement of Claim, and said that they had never sold or offered for sale, or threatened, or intended to sell or offer for sale any soap not made or sold by the Plaintiffs as and for the Plaintiffs' soap.

The action was tried before WARRINGTON, J., on the 1st of June 1904.

Henry Terrell, K.C., and *T. K. Crossfield* (instructed by *Squire and Webb*) appeared for the Plaintiffs; *Cave*, K.C., and *W. E. Vernon* (instructed by *A. R. Gery*) appeared for the Defendants.

Counsel for the Defendants referred to *Rutter & Co. v. Smith* (18 R.P.C. 49).

WARRINGTON, J.—In this case the Plaintiffs claim two separate kinds of relief. Their first claim to relief is based on a contract that the Defendants would not sell certain goods at a lower price than 7½d. per bar; and, secondly, they claim relief in the shape of an injunction restraining the Defendants—putting it shortly—from selling or offering for sale any soap not of the Plaintiffs' manufacture as and for the Plaintiffs' soap, and in each case they claim damages. These two heads of relief are quite separate and distinct, and I propose to deal with them separately.

[The learned Judge then dealt with the alleged breach of contract, and held, on the facts proved, that on the 14th of September, a bargain was made to the effect that if the Plaintiffs would supply five tons of Primrose soap, the Defendants would not sell it retail at a less price than 7½d. per bar, except that they were permitted to do so during the four days' sale from the 21st to the 24th September, and that there had been a breach of the contract; that the contract was a valid one, but that the whole of the said five tons having then been sold no injunction ought to be granted, and he awarded the Plaintiffs, on this part of the case, 40s. damages, and the costs of the action. He then continued his judgment as follows.]

Now comes the other part of the case, and that has given me very much greater difficulty. The Plaintiffs, by their Statement of Claim, allege that "On the 24th November 1903 the Defendant Company, at their premises in Holloway aforesaid, offered for sale and sold to one *Amy Hooper*, a bar of soap as and for '*John Knight's Primrose Soap*,' or the '*Primrose Soap*' of the Plaintiff Company, but which in fact was not made or sold by the Plaintiff Company, and was of a quality much inferior to that of the Plaintiff Company's '*Primrose Soap*.'" I leave out the last sentence which is immaterial for the present purpose. That is an allegation of a single sale on a particular day of a single bar of soap, as and for the Plaintiffs' soap, which was not the Plaintiffs' soap. That is followed by another allegation in paragraph 12 that, "The Defendant Company, unless restrained by the Order of this Court, will continue to offer for sale, and will sell soap as and for '*John Knight's Primrose Soap*,' or the '*Primrose Soap*' of the Plaintiff Company, but which is not made or sold by the Plaintiff Company to the further damage of the Plaintiff Company." The explanation of the words "further damage" is found in paragraph 10, in which is alleged that the Plaintiffs have suffered damage by reason of the conduct mentioned in paragraph 9.

The facts with regard to this part of the case are these. On the 23rd of November, a representative of the Plaintiffs had called at the Defendants' shop and had made complaints in reference to their proposal at the November sale to include in it five tons of their "*Best Primrose Soap*" at 6½d. a bar. He had asked that that soap should be withdrawn from the sale, or, at all events,

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should not be sold at less than 7½d. That demand had been refused, but the general manager, thinking over it, came to the conclusion, that one day's sale having passed, he might, without any damage to the rest of the sale, withdraw *Knight's* soap and substitute another kind of soap for it, namely, some soap which is sold as "*Crisp's* Imperial Primrose." I am not quite doing the manager justice in referring to the substitution. All that he decided to do was to withdraw "*Knight's* Primrose." The substitution appears to have been effected by Mr. *Francis*. Accordingly, on the morning of the 24th, *Knight's* soap which was piled up in the shop for the purpose of the sale, was withdrawn, and, in the place of it Mr. *Francis*, apparently on his own authority, piled up some "*Imperial Primrose Soap*" with a placard on it calling attention to the fact that it was "*Crisp's* Imperial Primrose Soap," and that it was to be sold at 6½d. In the afternoon, about half-past four or five, or thereabouts, Mrs. *Hooper*, the wife of an assistant in a shop, a rival of the Defendants', was sent to *Crisp's* to buy a bar of "*Primrose Soap*." The object with which she was sent appears to have been to ascertain whether they were really selling "*Knight's* "*Primrose Soap*" at 6½d.—not at all whether they were selling some other soap for "*Knight's* Primrose Soap." She went to the shop, and there is an absolute conflict of evidence between what she says, and what is said by the assistant who served her. I have seen both witnesses. There is one observation which I think must be obvious to everyone: that Mrs. *Hooper*, if she is minded to tell the truth, is much more likely to remember what took place on the occasion than the assistant, as to whom this was only one of many transactions taking place on that day. Of course, that must be qualified, by saying, as I do, that if she is minded to tell the truth, her memory is likely to be more distinct, and therefore her evidence more reliable than that of the assistant. I have seen her. I have no reason whatever to suppose that she was not telling the truth. I cannot think of any motive which would induce her to come here and not do so, and I do not see my way to disbelieve her story. If I believe it, it is this, that she asked, as she was instructed to do, for a bar of "*John Knight's* Primrose Soap"; that the bar was given to her taken from a pile of soap, each bar being stamped "*Crisp's* Imperial Primrose"; that she called attention to that, and that the answer was:—"This is Primrose Soap specially manufactured for us by *John Knight & Sons*," and she thereupon was satisfied and took the soap away. If that is true, that, no doubt, is a passing-off of that bar of soap as and for the Plaintiffs' soap.

The story, as told by *May*, the assistant, is that he was asked a question about it, and that he said that was soap of their own, specially manufactured for them. Where he really differs from Mrs. *Hooper* is in this—that he denies that he said that it was manufactured for them by *John Knight & Sons*. This assistant had been but a short time in the place. He said that he was originally engaged as an assistant warehouseman on the 31st of October, but so soon as the 2nd of November, that is, the first Monday after his engagement, he had had his book given to him, and he had gone into the shop as an assistant; but it is quite clear from his evidence as to the other soap sold by them, that he did not know much about it. He certainly was inaccurate in saying that the soap was specially manufactured for the firm, because we know from *Luccombe* that it was not so. He was asked the question, and he said, that it was a standard quality. I infer from that that he means that it was not a soap specially manufactured; that it was a standard quality of a particular manufacturer, but it was specially stamped with the name of this particular firm. Accordingly, even the statement which he himself admits he made, was not an accurate statement. I think it is quite possible—I am quite ready to credit Mr. *May* with that—that he may have been under the impression that this "*Imperial Primrose Soap*" was manufactured by *John Knight & Sons*. I do not want to come to the conclusion that he was deliberately deceiving Mrs. *Hooper*. I have

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no reason to suppose that he was a man who would do so, nor can I see what motive he would have for doing it, except the zeal of an employé who wished to do the best he could for his master. I think it is quite possible he may have been mistaken; at any rate, having seen the two witnesses, and having, to the best of my ability, compared their stories, I come to the conclusion that I must believe Mrs. Hooper, and I must believe, therefore, that the particular instance alleged in paragraph 9 did take place. 5

Now what am I to do? The passing off of that one bar of soap, by itself, does not appear to me to constitute a ground of action, unless one of two other things are established: either that it was evidence of an intention to continue so doing, or that it occasioned damage to the Plaintiffs. It seems to me that, in this kind of case, unlike the cases of infringement of copyright, in which a right of property is interfered with, either damage, or an intention for the future to do the same thing, is an essential element in the legal cause of action. 10

To deal with damage first, it is not alleged that one farthing damage was occasioned to the Plaintiffs by the sale of this bar of soap. Therefore, that element is wanting. With regard to the rest, I am convinced that, although this particular instance occurred, there was no intention whatever on the part of any of the persons employed by *Crisp & Co.* to commit a fraud, or to pass off what is called "Imperial Primrose" as and for Knight's Soap. It is not unimportant to bear in mind, in reference to that part of the case, that the Plaintiffs appear to have made at least two attempts, through a person named Lewis, and by means of Mr. Cowell, to ascertain whether the Defendants were, in fact, passing off their soap as the Plaintiffs, and failed. I think, therefore, that I must come to the conclusion that there was no intention on the part of the Defendant Company, or of those by whom its affairs are managed, to commit that wrong. 15 20 25

It does not quite rest there. The Plaintiffs' pleader seeing, as I give him credit for seeing, that the mere act itself was not sufficient to ground the relief he was seeking, alleged, as I have already mentioned, first, damage, and, secondly, the intention to continue the act complained of. The 12th paragraph of the Statement of Claim is a distinct allegation of fraud, and fraud of the grossest kind, against the Defendants, and I think if people venture to make a charge of fraud of that sort, they must bear the consequences unless they establish it. The conclusion, therefore, that I come to in respect of this part of the case is that I cannot grant any relief, and that, not being able to grant any relief, I must give the Defendants their costs on this part of the Plaintiffs' action. 30 35

The Order that I make, therefore, is, that I award 40s. damages for breach of the contract, and I give to the Plaintiffs so much of the costs of the action as relate to that part of the case. I give judgment for the Defendants on the other part of the action, with the costs of the action, so far as they relate to that part of the case, with, of course, a set-off. I put it in that form because I intend that there shall be an apportionment of the general costs of the action. 40

Terrell, K.C.—We are both agreed that it would be a simpler thing to say, no costs on either side. 45

WARRINGTON, J.—Very well; no costs on either side.

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HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE SWINFEN EADY.

July 1st, 2nd, 4th, and 13th, 1904.

ROBERT EVAN LLEWELLYN EVANS and J. AND J. TAUNTON, LD. v.
HOSKINS AND SEWELL, LD.

5

Patent.—Infringement.—Anticipation.—Patent upheld.—Certificate as to validity granted.—Stay of inquiry as to damages refused.

Letters Patent were granted to E. for "Improvements in wire mattresses or fabrics for bedsteads, cots, and like articles of furniture," the invention
10 consisting in the use of spiral springs set at an angle to the sides of the bed in such a manner that the tension of the central part of the mattress was greater than that of the sides. In an action for infringement,

Held, that the invention had not been anticipated. Certificate of validity granted.

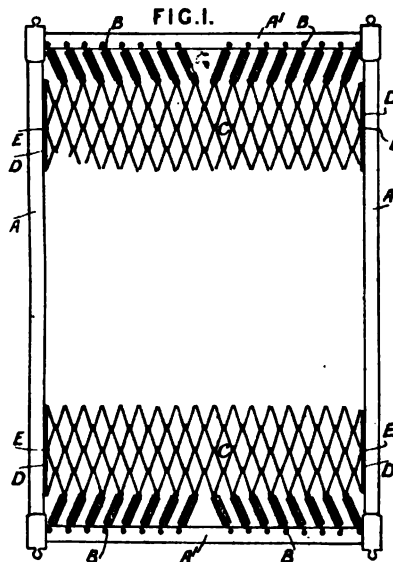
15 Application to stay inquiry as to damages pending an appeal refused, following *Hyam v. Terry* (29 W.R. 32).

In 1899 Letters Patent (No. 23,859 of 1899) were granted to Robert Evan Llewellyn Evans for "Improvements in wire mattresses or fabrics for bedsteads, cots, and like articles of furniture." John and Joseph Taunton,
20 Ld., were the exclusive licensees under this Patent.

The Specification of the Patent was as follows:—"This invention relates to wire mattresses or fabrics for bedsteads, cots, and other articles of furniture, and particularly to those composed of links, or diamond shaped connections with coiled springs arranged at each or only one end of the fabric. According
25 "to my invention, I direct (looking from the end frame-work towards the centre of the fabric) the coiled or other tension springs which are connected to the end framing by any suitable means, inwardly towards the centre of the frame; or, looking at the surface from the centre of wire netting or link work towards the end framework, the springs are arranged diagonally in opposite
30 "directions from the centre of each end, thus a greater pressure is exerted on the centre of the mattress surface or fabric than on the other portion. Where a mattress is required with tension springs at one end only, this arrangement will of course apply to that end alone.

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" Figure 1 of the accompanying drawing, represents the two end parts of a
 " spring surface or fabric with springs arranged according to my invention, and
 " fitted to the framework of a bottom of a bedstead, cot, or like article. From
 " this it will be seen that, according to my invention, instead of the tension
 " springs being arranged parallel with the longitudinal members of the sup- 5
 " porting frame-work they are (looking from the end frame-work towards the
 " centre of the fabric) directed inwardly towards the middle thereof. Or,
 " looking at the surface from the centre of the netting or linkwork towards the
 " end frame-work, the said tension springs are arranged diagonally in opposite
 " directions from the centre of each end. The effect of this arrangement, is to 10
 " direct the tension from all the springs on the middle portion of the wire
 " netting or link work, thus making the said middle portion, which receives the
 " most strain in use, considerably lighter and stronger, and, inasmuch that
 " when a person is reclining on the surface, the weight or strain is evenly
 " distributed on, and borne by all the tension springs, a highly elastic and 15
 " comfortable surface is produced, and moreover the durability of the fabric is
 " greatly increased.

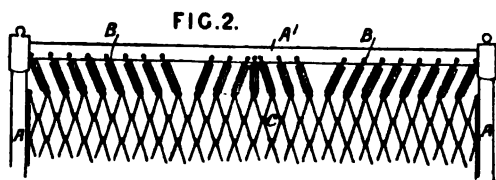


" I wish it to be understood that the tension springs may be of any pattern or
 " strength desired, also the supporting frame-work, so long that these parts
 " respectively permit of the springs being so arranged that a diagonally directed 20
 " strain is applied on the middle portion of the wire netting or link work. I do
 " not confine myself to any particular pattern or construction of link work or
 " netting, also, I may if desired, use springs of various lengths and strengths.
 " The supporting framework may be of metal, wood, or other material.
 " The several letters of reference indicate corresponding parts in the drawing. 25
 " A are the side members of the supporting frame work, and A', the end

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"members thereof. B the tension springs, C the wire netting or link-work, and D the side wires thereof, which may be connected to the framework by any suitable means, such as hooks (E).

- 5 "Figure 2, shows an arrangement which may be utilised when a large size surface or mattress is required. It will be seen that in this form the tension springs are arranged diagonally in series, and each of these series are directed diagonally towards, and exert a tension upon any portion of the link work.
- 10 "I find in practice that with spring surfaces constructed according to my invention, the middle portion is so very strong and unsagging, that there is no necessity whatever to raise the centre of the fabric by artificial means, such as arching upwardly and outwardly the end supporting members of the framework. As before observed, my invention applies equally to fabrics with tension springs at one end only as to fabrics with springs at both ends."



- The Patentee claimed :—" 1. The combination with the link work or netting of a mattress or fabric for bedsteads, cots, and like articles of furniture, of tension springs arranged (looking from the centre of the surface towards the end thereof) diagonally and in opposite directions from the centre of each end, whereby a diagonally directed tension is exerted on the middle portion of the surface, substantially described and set forth in Figure 1. 2. The combination with one end of the link work or netting of a mattress or fabric, for bedsteads, cots, and like articles of furniture, of tension springs arranged (looking from the centre of the surface towards the end thereof) diagonally in opposite directions from the middle portion of the said end, as described. 3. The combination with the link work or netting of a mattress or fabric for bedsteads, cots, and like articles of furniture, of one or more series of tension springs arranged at either one or both ends of the fabric, and directed in such a manner as to exert a diagonal tension on one or more portions of the said mattress or fabric, as described and set forth in Fig. 2."

- On the 1st of December 1903 the Patentee and the Licensees commenced an Action and issued a writ against *Hoskins and Sewell Ld.* for infringement of the Patent, claiming the usual relief.

- The Particulars of Breaches were as follows :—"The Defendants have infringed the Letters Patent mentioned in the claim by the manufacture and sale and use of articles made according to the said invention as claimed in the first and second claims of the Specification of the said invention as follows :— By instructing Messrs. *G. Gale & Sons, Ld.*, of Birmingham, to make divers wire meshes or fabrics which were made and supplied by Messrs. *G. Gale & Sons, Ld.* Dates of orders—27th of June 1901, 10th of February 1902, 15th of March 1902, 5th of June 1902, 19th of September 1902, 20th of September 1902, 24th of November, 1902, 23rd of December 1902. By the sale of the above articles. And by the sale of to *A. Gardner & Son*, furnishers, of Glasgow, in

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"or about July 1901, July 1902, October 1902, and April 1903, of meshes or fabrics made according to the said invention. The Plaintiffs cannot give any better Particulars until after discovery."

The Defendants by their Defence denied infringement, and also pleaded that the Plaintiffs' Patent was invalid for the reasons set forth in the following Particulars of Objections:—

1. The said *Robert Evan Llewellyn Evans* was not the first and true inventor of the said alleged invention. The first and true inventor was one *John Griffin*, and the said alleged invention was made by him at the Plaintiff Company's works in or about the month of September 1899.
2. The said alleged invention is not useful.
3. The said alleged invention was not new. The said invention was published in this realm prior to the date of the said Letters Patent—(A) By the publication at the Patent Office Library of the final Specifications of the following British and United States Patents. The whole of each is relied upon as against all the claiming clauses of the Plaintiffs' Specification:—*Lake* (No. 3926 of 1882); *Newton* (No. 2199 of 1855); *Hughes* (No. 2307 of 1872); *Welch* (No. 2714 of 1874); *Hunt* (No. 252,772 of 1882, U.S.A.); *Rowcliffe* (No. 5895 of 1883); *Fielding* (No. 323,572 of 1885, U.S.A.); *Brown* (No. 357,697 of 1887, U.S.A.); *Horton and Stefskin* (No. 369,791 of 1887, U.S.A.); *King* (No. 371,591 of 1887, U.S.A.); *Goodwin* (No. 19,064 of 1890); *Miller* (No. 506,246 of 1893, U.S.A.); *Gale* (No. 22,738 of 1894); *Gale* (No. 18,490 of 1895); *Nichols* (No. 5613 of 1897); *Ackermann* (No. 8149 of 1897); *Billington* (No. 8455 of 1897); *Nichols* (No. 20,338 of 1897); *Ryan* (No. 5043 of 1898); *Billington* (No. 14,928 of 1898); *Wesner* (No. 607,102 of 1898, U.S.A.). (B) By the manufacture by the Plaintiff Company at their works in Sherbourne Road, Birmingham, in or about the month of September 1899 of a wire mattress constructed according to the invention as claimed in all the claiming clauses of the Plaintiffs' Specification.
4. The Complete Specification in Claims 2 and 3 claims an invention larger than and different to the invention the nature of which is described in the Provisional Specification.
5. The said alleged invention as claimed in all the claiming clauses of the Plaintiffs' Specification is not the proper subject-matter of valid Letters Patent. The Defendants will rely hereunder upon the matters set out in paragraph 3 hereof and upon the common knowledge of the trade as to the construction of wire mattresses and spring supported mattresses.
6. That the said alleged Letters Patent are void by reason that the invention in respect of which they purport to be granted formed the subject of a grant to *Henry Clay Fletcher* and *Sidney Herbert Cornish*, dated 19th of June 1899, and No. 12,776 of A.D. 1899, which said grant was prior to the alleged grant to the Plaintiff.

The whole of the Specification and all the claiming clauses are relied on."

The action came on for trial before Mr. Justice SWINFEN EADY.

Astbury, K.C., and *J. C. Graham* (instructed by *Sayle, Carter & Co.*, agents for *Sidney C. Taunton*, of Birmingham) appeared for the Plaintiffs; *Waller and Gray* (instructed by *Sharpe, Parker & Co.*, agents for *E. C. Newby & Son*, of Birmingham) appeared for the Defendants.

Astbury, K.C., opened the case for the Plaintiffs.—There is a large trade in the mattresses which are the subject of this Patent, and they are especially used by hospitals and public institutions. The object of the invention is to keep the mattress level and to prevent it from sagging in the centre. This is attained by the use of a number of spiral springs set at an angle to the sides of the mattress and exercising tension in the direction of a central parallelogram. The method is so successful that it is possible to sell the mattresses made according to it with a guarantee that after twenty years they will not sag in the centre. Infringement is not really contested; the only real issue is that of anticipation.

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Dugald Clerk gave evidence on behalf of the Plaintiffs. He described experiments made under his direction showing that the deflection of the bed was much less than it would have been if the springs had been set parallel to the sides of the bed.

- 5 *J. O. Graham*, summed up the case on behalf of the Plaintiffs.—This is a small invention, and will not be so severely tested as it would be if an epoch-making invention were claimed. The real object of the invention is to make the actual area on which a man would be lying stiffer than it would otherwise be. In *Welch's* mattress there was a central support, and the first effect of
10 putting weight on it would be to diminish the tension of the springs. In *Goodwin and Hughes' Specifications*, which are, mechanically speaking, the same thing, the fabric is incapable of transmitting diagonal strains. In *Gale's Specification* there are no diagonal springs, though it is alleged that the springs fall into a diagonal position before they take the strain; but the point of the
15 present invention is to put the springs in a converging position before the strain is put on. It is said that *Billington's* invention is the same as the Plaintiffs', with the addition of something else, but the effect of the addition is to make the bed equally stiff at the sides as it is at the centre, so as to do away with the greater tension on the centre, which is the point of the Plaintiffs' invention.
20 *Hattersley v. Hodgson* (20 R.P.C. 594) shows that a claim of something too wide does not make the Patent bad.

Walter for Defendants.—If when properly construed the Specification includes the square mesh then there is a direct anticipation; if not then there is dis-conformity. It is attempted to distinguish *Welch's* Specification by saying
25 that he has introduced more springs; this is in reality no distinction at all. The rubber spring in the centre is a mere addition. *Gale's* Specification of 1895 shows the small mesh introduced in the centre; the springs being not held horizontally, but capable of rotation about the centre, assume the proper position to take the strain, which is that of the Plaintiffs' springs. *Billington's*
30 invention is the same as the Plaintiffs' with other springs added, so as to get an even tension, and it meets the difficulty of enabling the springs to take up the strain without having to rotate about an axis. The Specification is also bad as claiming what is useless.

- James Swinburne* gave evidence for the Defendants.
35 *Walter* summed up the case for the Defendants.—The real question is—What is the true construction of the Specification? Can the Patentee be supposed to mean what he says when he observes that, "I do not limit myself to any pattern or construction of link work"? The evidence is that with
40 any given arrangement of springs it is a question of difficulty what construction of network will give the effect which the Patentee desires. The Plaintiffs construe the Specification in the narrowest possible way; they limit it to a network of diamond-shaped links (*Morgan v. Seaward*, 1 Web. Pat. Cas. 167, 175). There is nothing to warn the public against the use of the square mesh, the effect of which is, as the evidence shows, not to give effect of the inven-tion. [SWINFEN EADY, J., referred to the words "diagonally directed strain."]
45 The Plaintiffs are trying to construe the Specification as if it said "a strain along diagonally directed wires," which is a very different thing. The Patentee did not know that a square mesh would not work. He has not given the limitation which alone renders the invention workable, and which he was
50 bound to give. Every form of linkwork will give a diagonally directed strain, but it will not give what the Plaintiffs are now interpreting their Specification to mean—that is, a strain along diagonally directed wires. What the Patentee thought he had invented was the arrangement of springs directed diagonally towards the centre, and that with any form of network, and this we say is
55 the true construction of the Specification. If this is so, then the invention is

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anticipated by *Goodwin*, and also it is useless. Allowing, however, the narrow interpretation to be put on the Patent, yet we still say it is bad; the only difference alleged between *King's* invention and the Plaintiffs' was said to be that he had not the whole of the invention—i.e., not so many springs. There is no evidence of utility. [SWINFEN EADY, J.—But you admitted infringement, and I drew the inference that you would not have made the bed if you did not consider it useful.] If springs of different strengths were used it would be necessary to rearrange the structure, and for this no directions are given. [The allegation that the Plaintiff *Evans* was not the first and true inventor was abandoned.]

Astbury, K.C., in reply.—There is really nothing left except *King's* Specification and the question of construction. Now it is always possible to construe a Specification so as to make it nonsense. It is clear that no strain can be applied without a path through which it can be applied. In *Patent Exploitation Company v. Siemens Brothers & Co.* (ante, p. 541), Lord *Davey* pointed out that “substantially as set forth” means a limitation to equivalents. What the Patentee has done is to show the structure which in his opinion will best carry out the invention; but he says that it can be carried out by means of other forms of linkwork. In *Morgan v. Seaward* the Patentee pointed out the problem, but showed no method of solving it. In a combination Patent it is not necessary to show what is old and what is new (*Hattersley v. Hodgson*).

Walter.—The decision in the *Patent Exploitation* case rested on the words “semi-solid or plastic,” and there was nothing in the anticipations which was either.

Judgment was reserved, and delivered on the 13th of July 1904.

SWINFEN EADY, J.—The Plaintiffs claim in respect of an infringement of Letters Patent (No. 23,859 of 1899) granted to the Plaintiff *Robert Evan Llewellyn Evans* for “Improvements in wire mattresses.” The Defendants admitted manufacturing in accordance with the Patent, and claimed the right to do so. The validity of the Patent was contested before me on the ground of prior publication. The Particulars of Objections denied that the Plaintiff was the first and true inventor, and alleged that this person was one *John Griffin*, but this was not persisted in.

The invention relates to wire mattresses or fabrics for bedsteads, and particularly to those composed of links of a diamond pattern with coiled springs at both ends, or only one end, of the fabric. The springs are arranged in an oblique or diagonal position, and in opposite directions from the centre of each end, in such a manner as to direct the tension from all the springs on to the middle portion of the wire mesh. The effect of this arrangement is to direct the tension from all the springs to the portion of the bed subjected to the greatest pressure when the bed is in use; the strain is taken up immediately by all the springs, and the weight is evenly distributed among them. The tension is concentrated in the centre portion of the bed, that is, the portion most requiring support; and it is obtained by means of a diagonally directed and conducted strain. The advantage of this arrangement is that it prevents the undue stretching of some springs at the expense of others scarcely stretched or strained at all, and thus increases the durability of the mattress, and reduces the liability to sag or deflection when the bed is unoccupied. Mr. *Dugald Clerk*, who was called on behalf of the Plaintiffs, stated that the new idea of getting the strain through the network to the centre of the bed required very simple means to carry it out, but had a very surprising effect, and that it surprised him. He made certain experiments in order to determine the different measure of support afforded to the centre of a bed if the springs were arranged in accordance with the Plaintiffs' invention, and if the springs were arranged parallel with the length of the bed. The result was that in the latter case, a

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weight of 100 lbs. produced the same deflection as 137 lbs. in the former case ; that is, that the diagonal arrangement was 37 per cent. better than the parallel arrangement for supporting the centre area of the bed. Mr. *Swinburne*, who was called for the Defendants, agreed that there was a very great difference of
 5 tension and pressure in the surface of the bed according to whether the springs were put straight or diagonally, the latter arrangement preventing permanent sag, because it stretched a lot of springs evenly a short distance, instead of a few springs for a long distance.

It was not disputed by the Plaintiffs' arrangement of springs, with a diagonal
 10 network, a diagonally directed strain is applied on the middle portion of the wire netting, to which portion the tension from all the springs is directed. It was, however, urged that, as the Patentee stated, in his Specification, that he did not confine himself to any particular pattern or construction of link work or netting, he claimed in effect—amongst other things—a square pattern ; but
 15 if a square mesh movable on its points of contact was used with diagonal springs, there would be no direction of any strain from these springs towards the centre ; indeed no more strain would be thrown on the centre, than if straight springs were used, as any diagonal pull on one side of a link would be met by a diagonal pull at the opposite side, and the result would be precisely the same as if you
 20 were pulling on the straight. Under these circumstances it was insisted that the Patentee had claimed a square mesh, and that the Patent was invalid as a square mesh would not produce the result sought to be achieved. The answer to this argument is, that the Patentee has not claimed such an unworkable method of carrying his invention into effect ; he describes an arrangement for
 25 conducting a diagonally directed strain to the centre of the bed, and shows in his Drawings a proper way of doing it ; and when he says that other patterns of link work will do, he obviously means meshes which will carry diagonal strains. Mr. *Clerk* said that there was a very large number of meshes of a pattern which would carry diagonal strains, and that any engineer would say
 30 which mesh would carry diagonal strains and which would not. In my opinion the Patentee has not claimed a square mesh as carrying out his invention.

With regard to want of novelty, the Specification most relied upon was *King's* of 1887. But *King's* bed lacks the essence of the Plaintiffs' invention—a strain upon the centre of the bed diagonally directed from all the springs.
 35 In *King's* bed, if a weight is placed at the point of junction between the springs which were numbered 4 and 5, it will put into tension two springs, the components of which are pulling, one towards, and one away from, the centre, as Mr. *Swinburne* stated ; there is no point in the centre area of *King's* bed, towards which any two springs in the line of tension converge. In *King's*
 40 bed, some of the springs do not stretch substantially, until you have considerable sag in the bed ; and these exert no diagonal strain towards the centre of the bed when the bed is unoccupied, whereas in the Plaintiffs' bed, when it is at rest, every spring is exerting a diagonal strain towards the centre. In my opinion *King's* Specification does not publish or disclose the Plaintiffs' inven-
 45 tion in any way.

The other Specifications relied upon are still less like the Plaintiffs' invention. You do not find, in any of them, a network with diagonal lines running through it, in combination with springs arranged as before mentioned.

I am satisfied that the Plaintiffs' invention is a novel and substantial one, and
 50 entitled to protection. The Plaintiffs are entitled to the relief claimed and the costs of the action.

Astbury, K.C.—Then I ask your Lordship to certify that the validity of the Patent came in question, and also with regard to the Breaches. We had not to prove those, because they were admitted.

55 *SWINFEN EADY, J.*—Yes.

Robert Evan Llewellyn Evans and J. and J. Taunton, Ld. v. Hoskins and Sewell, Ld.

Astbury, K.C.—And we will take damages instead of profits. I suppose your Lordship will order either delivery up or alteration of the infringing mattresses in the possession of the Defendants.

SWINFEN EADY, J.—Yes, that follows. Then there will be an inquiry as to damages, and the costs will be reserved. 5

Walter.—My Lord, I understand my clients are desirous of taking the case further, and I ask that the inquiry should be stayed, and the costs paid on the usual undertaking to return.

SWINFEN EADY, J.—Why should the inquiry be stayed?

Walter.—It is the inquiry as to damages. I do not ask for the injunction to 10 be stayed.

SWINFEN EADY, J.—Why should I stay the inquiry?

Walter.—Because it may be unnecessary.

SWINFEN EADY, J.—It is not the practice to stay such an inquiry.

Walter.—It is always so, my Lord. I know of no case in which an inquiry 15 has been proceeded with.

SWINFEN EADY, J.—What is the difference between a Patent action and any other action?

Walter.—I can only tell your Lordship what the practice is. I know of no case in which an inquiry has been proceeded with, if an appeal has been 20 presented within, say, a fortnight.

SWINFEN EADY, J.—I remember an important case where the question came before the Court of Appeal as to whether inquiries ought to be stayed or not, and the Court of Appeal said No. That was a case where an enormous sum was spent on the inquiry. It involved a claim for 70,000*l.* damages, and an 25 enormous sum was spent, and very expensive evidence was gone into on the inquiry, and in the end the appeal succeeded, so that all the inquiries were wholly unnecessary. First of all Mr. Justice *Fry*, and afterwards the Court of Appeal declined to stay the inquiry.

Walter.—My Lord, I can only say that I know of no case in which the 30 inquiry has been proceeded with.

SWINFEN EADY, J.—You must refer me to some authority. At present I will not make any order to stay. It must be the subject of a separate motion and argued separately. I have a very clear recollection of *Hyam v. Terry*,* the case I refer to, where there was a decision of the Court of Appeal. 35

* See 29 W.R. 32.

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IN THE HIGH COURT OF JUSTICE.—KING'S BENCH DIVISION.

Before MR. JUSTICE DARLING.

August 2nd, 1904.

BERCHEM v. WREN.

- 5 *Patent.—Agreement for sale.—Warranty of validity.—Condition.—Patent held invalid.—Judgment for Defendant.*

The owner of a Patent for automatic drain valves for use in steam engines entered into an Agreement to sell it. The vendor in the Agreement guaranteed the Patent to be valid and in full force. The Patent was to be sold, together
15 with the rights, privileges, and benefits appertaining thereto, further improvements, and the full and unrestricted use of the vendor's name in connection therewith, for the sum of 500l., one moiety of which was to be paid at once and the other some months afterwards. The vendor was not to part absolutely with his Patent until the whole of the price had been paid. The vendor also undertook
15 to give all possible assistance to the purchaser in his business for a certain time. The purchaser paid 250l. and took over the business, letter books, and books of orders. He carried on the business for some months, but on discovering that other similar valves had been previously in the market repudiated the Agreement. In an action by the Patentee for 250l., the balance of the 500l., the Defendant
20 alleged that there was a breach of warranty as to the validity of the Patent, which was invalid for want of novelty, utility, and subject-matter, and also that the Agreement applied only to the Patent rights. He counterclaimed for a declaration that the Agreement was not binding on him, and for a return of the 250l., or, in the alternative, damages.

25 Held, at the trial, that the Patent was invalid and that the Plaintiff could not recover the 250l.; that the Defendant was not entitled to rescission of the contract; but, that as the business was only worth 240l., he was entitled to 10l. damages with costs.

- On the 11th of January 1898, Letters Patent (No. 781 of 1898) were granted to
30 A. H. E. Berchem for an invention of "A new or improved automatic drain valve for steam-engine cylinders, steam heaters, or other analogous purposes."

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The Complete Specification was as follows :—

" This invention relates to a new or improved automatic drain valve for the cylinders of steam engines or pumps, or steam heaters, or for any other purpose to which same may be applicable. The use of a reliable draining attachment and the regular escape of water from the cylinders of steam engines is of very great importance, and this invention is designed to provide means for automatically effecting or permitting the escape of any such water of condensation this automatic drain valve being so constructed that when starting the engine or pump *etc.*, (whatever it may be applied to) it automatically allows the discharge of water of condensation and the valves do not close until the live steam attempts to pass, while they will automatically open and allow even the smallest quantity of water to pass.

" In order that my invention may be better understood I will describe same having reference to the accompanying drawing. In this drawing I show the valves arranged and mounted in a T piece, the arms (*k*) of the T being connected to the drain pipes from the steam cylinder while the shank (*l*) of the T forms an outlet for the water discharged through the valves (*m, m*). A valve (*m*) is arranged inside of and towards the end of each arm (*k*) each such valve being provided with a valve spindle (*d*) in the same axial line with one another, the inner ends of said valve spindles having a spring (*h*) interposed between them or combined therewith in suchwise that when one said valve is pushed inwards against its seating (*e*) so as to prevent steam passing to the shank (*k*) of the T piece, thereby the spring (*h*) is compressed and has a further tendency to press outwards and thereby keeps open the opposite valve and *vice versa*, while at the same time the two said valves (*m, m*) and the spring or springs (*h*) combined therewith, are so arranged that both valves can at the same time be firmly pressed inwards so as to make a steam tight joint against their seatings (*e, e*). The valves are, as shown in the drawing, advantageously circular discs with coned faces adapted to fit closely against corresponding coned seatings provided for same in each arm of the T piece. The valve spindles (*d, d*.) are supported in sleeves or bearings (*f, f*) provided in the interior of each arm of the T piece, as shown in the drawing, such bearings (*f, f*.) and the valve seating (*e, e*) being advantageously cast in one with the T piece. The end of each arm of the T piece may advantageously be screw threaded on the exterior or otherwise fitted with valve caps (*a, a*.) to receive the drain pipes from the steam cylinder, &c., and furthermore I find it advantageous to provide an opening (*b*) protected with a screw plug (or adapted to be otherwise suitably closed) to afford access to the interior of the T piece and to the internal working part. Means may be advantageously provided to adjust the tension of the springs (*h*) for instance means may be provided to alter the length of the valve spindles (*d, d*) as shown in the drawing by providing an adjustable screw nut or bracket (*g, g*) on the inner end of each valve spindle (*d, d*).

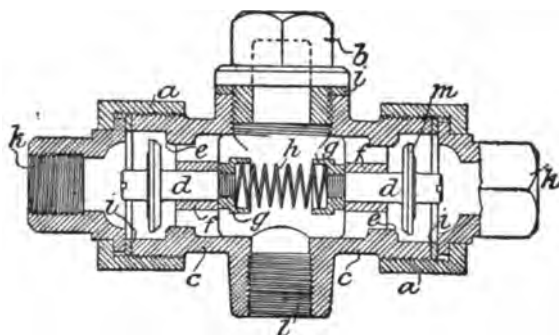
" I do not confine myself to forming the valve casing in the form of a T piece only, as my present invention may be carried out with other suitable form of valve casing. Neither do I confine myself to mounting the spindles of the two valves (*m, m*.) in the same axial line for controlling by the same spring, as if desired each valve may be mounted with a separate spring, each independent of the other valve and spring and moreover the one valve may be mounted and arranged so as to open into the discharge chamber at a different point from that at which the other valve is arranged and communicates with the said discharge chamber or common outlet.

" Automatic drain valves according to my present invention have the following advantages :—(1) Neatness and compactness as well as non-liability to get out of order. (2) Water hammer in steam cylinders and pipes in connection therewith is obviated. (3) The opening by the attendant of drain cocks

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- "before starting and when stopping engines, pumps, &c., is obviated and more-
 "over the provision of such drain cocks will no longer be necessary. (4) This
 "drain valve allows particles of water to separate from steam and consequently
 "dry steam is thereby ensured. (5) Damage which often results to engines
 5 "owing to the presence of water is obviated."

The claims were :—"1. The use of automatic drain valves in connection with
 "steam cylinders, substantially as described and illustrated. 2. Automatic
 "drain valves as described and illustrated."



- By an Agreement, dated the 8th of January 1903, between the Patentee and
 10 *Harry Wren*, it was recited that the Patent (No. 781 of 1898) had been granted,
 and it was agreed : "That the vendor shall sell and the purchaser shall pur-
 "chase the said Patent (No. 781 of 1898), which the vendor hereby guarantees
 "to be valid and in full force, being the Patent of *Berchem's* Patent automatic
 "cylinder drain valve, together with the rights, privileges, and benefits apper-
 15 "taining thereto, and all further improvements that may now or hereafter be
 "made therein by the vendor, also the full and unrestricted use of the vendor's
 "name in connection therewith, for the sum of 500*l.*, of which the sum of 250*l.*
 "is to be paid on or before the 10th of January instant, as from which date all
 "profits and goodwill are to belong to the purchaser, and the remaining sum of
 20 "250*l.* is to be paid on or before the 10th of September next, in which case the
 "vendor is not to part absolutely with the Patent until such time as the pay-
 "ment of the total sum herein provided has been completed, whereupon it shall
 "become the entire property of the purchaser." The vendor undertook to
 execute all documents necessary to complete the transfer "of the said Patent,
 25 "and all rights, privileges, and benefits appertaining thereto." "And it is
 "further agreed that the vendor shall forthwith deposit all the documents con-
 "nected with the said Patent with the purchaser's bankers, in the joint names
 "of the said vendor and purchaser." Another clause related to foreign and
 colonial sales. The Agreement continued :—"And it is further agreed
 30 "that the vendor shall give all possible assistance to the purchaser in the
 "business (without interfering with the vendor's business engagements) free
 "for the space of three months, and thereafter, if such assistance is necessary,
 "upon terms to be mutually agreed." The vendor also undertook to deliver
 the letter books containing correspondence relating to the Patent, and also
 35 original orders. The purchaser undertook to take over, at cost price, the
 vendor's stock of valves.

The purchaser, on the 3rd of September 1903, repudiated the Agreement, and
 refused to pay the second instalment of 250*l.*

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On the 11th of September 1903 the Patentee commenced an action against the purchaser by specially endorsed Writ for payment of the balance of 250*l.* under the above Agreement.

On the 8th of October the Master in Chambers gave leave to defend on the Defendant undertaking to keep an account of all sales of the valves the subject 5 of the action, and ordered Particulars of Objections to be delivered. Subsequently, on the 3rd of November, the Defendant was ordered to deliver Defence and Counterclaim within ten days, and the Plaintiff a Reply within ten days thereafter.

By his Defence the Defendant alleged that the Plaintiff had guaranteed 10 in the Agreement the validity of the Patent, and that it was a condition precedent to the completion of the Agreement that the Patent should be valid, and that in fact the Patent was invalid, by reason of want of novelty, subject matter, and utility. In the alternative the Defendant alleged that the Plaintiff had, in the Agreement, warranted the validity of the Patent, and 15 had also verbally warranted in January, 1903, that the Patent was entirely new, and was in fact the Master-Patent relating to automatic drain valves for steam-engine cylinders, and that by reason of such warranty the Defendant entered into the Agreement. By his Counterclaim the Defendant asked for a declaration that the Agreement of 8th January 1903, was not binding on him, 20 and claimed the return of the 250*l.* already paid, and in the alternative damages.

The Particulars of Objections set forth as anticipations of the alleged invention the following Specifications:—*Holt* (No. 2311 of 1878); *Carricaburu* (No. 11,427 of 1884); *Soulerin* (No. 5775 of 1887); *Phillipson* (No. 14,841 of 1889); *Russell* (No. 19,857 of 1892); *Getty* (No. 3593 of 1896); *Frisman* 25 (No. 7710 of 1897); and *Rickaby* (No. 520 of 1898). The Particulars alleged that the invention as described in the Plaintiff's Specification was useless and unworkable, as the spring if too strong would prevent the valve closing promptly, if too weak would not open against the pressure of water, and could not be maintained if properly adjusted, as equilibrium was unstable, and also 30 that the claims covered *Holt's* valve and one made and sold by *Bailey & Co.*, of Manchester, before the date of the Patent, which was substantially *Holt's* valve with an addition.

Holt's Specification showed a combined arrangement for drain and escape valves in one casing. The drain valves abutted on each other, as *Berchem's* 35 would have done if the parts *g g* were prolonged. Between the drain valves was a spring as in *Berchem's*, so that when the engine was stopped and the ends of the drain valves were relieved from pressure, this central spring expanded and carried both the drain valves off their respective seatings. The relief valves were sleeved on to some axis and were inside (*i.e.* of less 40 diameter than) the drain valves. They opened in a direction opposite to the drain valves. When either drain valve was retained on its seat by pressure of water greater than that of the steam on the other drain valve the relief valve opened, being kept normally in its seat by helical springs coaxial with the spindle of the valve. Its action was an exceptional occurrence. The valves sold 45 by *Bailey & Co.* were similar to *Holt's* with the addition of a handle for the purpose of opening both sides when required from outside. It was automatic in its action.

By his Reply and Defence to the Counterclaim the Plaintiff alleged that the Patent was valid. He also contended that the Counterclaim and Particulars of 50 Objections were irrelevant, immaterial, and afforded no defence to the action nor ground of counterclaim in so far as they related to the scope or commercial value of the Letters Patent or as to any articles actually manufactured either in accordance with the Specification or being capable of performing similar functions to the patented arrangement. The Plaintiff also denied having given 55 any warranty as alleged.

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The action came on for trial before Mr. Justice DARLING.

Maurice Hill (instructed by *H. Coulson*) appeared for the Plaintiff; *T. Terrell, K.C.*, and *F. Henlé* (instructed by *Bisgood and Marshall*) appeared for the Defendant.

- 5 *Maurice Hill*, for the Plaintiff, submitted that it was not open to the Defendant to contest the validity of the Patent. Before the Defendant purchased he examined into the Patent, and had models of the valve. After the purchase he worked at the patented invention, and did not raise the question of validity till the action was brought. Besides the Patent he purchased the
10 business, stock, and goodwill, so that the parties could not be put into their former relative positions by rescission of the contract. He had had the business for seven months. There were two small improvements made by the Plaintiff which did not alter the invention; these were lengthening the spindles of the valves to prevent both being closed at the same time if there was back pressure
15 of water and the spring was too weak, and holding the nuts in position.

- Evidence was then given by the Plaintiff and other witnesses on his behalf to the following effect:—The invention was the outcome of much labour, chiefly out of hours, as the Plaintiff was employed during the day. The business after five years brought in on the average 200% a year profit. [Details as to sales
20 were given.] On finding it became necessary to sell, the Plaintiff negotiated with the Defendant through a friend. He had only one or two conversations with the Defendant, and never gave any warranty as to the Patent being a Master-Patent as alleged, nor did he say it was the only automatic valve. He had difficulty in obtaining his German Patent which was still in force, but
25 never heard that his claims were too wide. His valve would work all right with a perfect engine. The alterations were made to prevent both valves being closed at the same time, owing to the weakness of the spring. The Patent had lapsed owing to non-payment of renewal fees in February 1904. The Plaintiff thought it was the duty of the Defendant to renew. The loss of business was
30 due to the lapse of Patent and to the Defendant's want of knowledge of engineering matters. The business was worth 500%, even without the Patent.

Expert evidence was given as to the working of *Holt's, Bailey's*, and the Plaintiff's valves.

- On cross-examination of the Plaintiff's witnesses some of the alleged defects
35 in the Plaintiff's invention were admitted.

DARLING, J.—I think the Patent is invalid.

- T. Terrell, K.C.*, for the Defendant.—The Agreement was only for the purchase of the Patent. The terms "rights, privileges, and benefits appertaining thereto" refer to the Patent only, so also the "goodwill." It was an
40 Agreement to sell the Patent and that only. The consideration has wholly failed since the Patent is invalid. The Patent was not to be transferred till the money had all been paid, but the vendor allowed the Patent to lapse. The Defendant claims a rescission of the contract. This case is governed by *Nadel v. Martin* (20 R.P.C. 723), in which the purchaser had in addition to buying an
45 invalid Patent taken over the business and bought a large number of machines, yet the contract was rescinded.

- The Defendant then gave evidence as to the circumstances under which he bought the business, and that it was not until after he had entered into the Agreement he heard of the valves sold by *Bailey & Co.* The Plaintiff had told
50 him they were not automatic. He took over no stock. The cost of advertising entailed a loss. Complaints were made by customers as to the valves. He could not therefore recommend them with the same confidence as before. He did not neglect to push the business. [He gave details as to actual sales.]

- Maurice Hill*, in reply.—The business was worth more than the Patent. For
55 breach of warranty the Defendant is only entitled to nominal damages. The purchase included the business, and was carried out at once, books &c.

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being handed over. The parties cannot be restored to their original position. The Defendant had full value for his 500*l.*, and the subsequent loss was due to his own incompetence.

DARLING, *J.*—In this case the Plaintiff sold to the Defendant a patented invention, or at least he contracted that he would sell it to him, and he also in the same Agreement gave the Defendant other things which were part of the consideration for that Agreement, such as his books, the goodwill, and the trade connection (which was a very considerable one), which he had formed with persons who were in the habit of purchasing these articles.

There is a contest before me as to whether the article was the subject of a valid Patent or not. The Plaintiff had guaranteed in his Agreement that it was a valid Patent. On hearing the evidence I have come to the conclusion that it was not a valid Patent, that the thing really was nothing but *Holt's* valve practically without the improvement afterwards introduced into *Holt's* valve, that is *Bailey's* valve. At the time this bargain was made *Holt's* valve was no longer a Patent, and therefore the thing which was supposed to be patented was a thing which practically anybody could make, and I am inclined to think they could have made a more efficient thing, that is *Bailey's* valve.

Under these circumstances the Plaintiff cannot maintain this action to recover the balance of the price which was to be paid for this patented article. The contract was that he should have 500*l.* As a matter of fact he has received 250*l.*, and he brings his action for the other 250*l.*; but, because the article was not a patented article and he guaranteed that it was, he cannot succeed.

The Defendant, therefore, has a right upon his side to maintain his Counterclaim. He claims that he is entitled to rescission of the contract and to have back what he has paid and not to pay any more. I do not think he can have that, because it is impossible to put the parties back in the position in which they were. The Defendant has used this business; he has used the connection; he has used the books; he has had made and he has sold a considerable number of these articles, and I am satisfied, upon the evidence that I have heard, that if he had been able to devote his attention to the business, and if he had been a man of business capacity he could have made far more out of the thing than he did. He could sell these things although they are not patented articles. *Bailey's* are no longer patented; they can be sold, and so I think could these. They seem to be useful things and they could be sold. Therefore he did not buy a thing of no value at all. I must arrive at what was the value of what he did buy, and, looking at it as well as I can, I think I must certainly say that the business is worth less because the article has turned out not to be the subject of a valid Patent. I do not believe the people who say that it makes no difference whether the thing that you are selling is a protected article or whether it is not—that the whole thing is advertisement and connection. I do not think so. I think it does matter whether the thing is a patented article and you can prohibit other people from making it. You might just as well say the same of a book—that it does not matter whether it is copyright or not. That would be to say that copyright has no value and that patent right has no value, which I do not believe.

In the circumstances, what do I think the business is worth which the Defendant really got? I have come to the conclusion that it was worth 240*l.* He paid 250*l.* for it; therefore he will not pay any more, and there will be judgment for the Defendant upon the claim, and there will be judgment for the Defendant on the Counterclaim for 10*l.* damages, with costs.

Colley's Patents, Ltd. v. British Patent Perforated Paper Company.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE SWINFEN EADY.

July 13th and 14th, 1904.

COLLEY'S PATENTS, LD. v. BRITISH PATENT PERFORATED PAPER COMPANY.

- 5 *Passing off.—Alleged deceptive use of label.—Defendants' label found to be earlier in date and not calculated to deceive.—Judgment for Defendants.*

The Plaintiffs, who were manufacturers of and dealers in toilet paper, brought an action against another Company, manufacturers of and dealers in the same goods, and against a purchaser from them, alleging that the label used by the
 10 *Defendants was an imitation of the Plaintiffs' label, and that the Defendants were by the use of such label passing off their goods as those of the Plaintiffs. The Defendants alleged that they and their predecessors in business had used the label complained of before the Plaintiffs had used their label.*

Held, that the Defendants had used their label continuously from a date prior
 15 *to that when the Plaintiffs first used their label, and that in any case the Defendants' label was not calculated to deceive. The action was dismissed with costs.*

On the 28th of July 1903 Colley's Patents, Ltd., commenced an action against the British Patent Perforated Paper Company and Mansell, Hunt, Catty & Co.
 20 *Ld. claiming—(1) an injunction to restrain the Defendants and each of them, their servants and agents, from copying or imitating the label of the Plaintiffs for toilet paper, and from selling, advertising, or offering for sale toilet paper not of the Plaintiffs' manufacture bearing any label copied or imitated from the said label, or otherwise passing off the goods of the Defendants or either of*
 25 *them as or for the goods of the Plaintiffs; (2) an account of profits or damages, and incidental relief.*

The Plaintiffs by their Statement of Claim alleged—(1) that the Plaintiff Company were manufacturers of and dealers in paper, and in particular toilet paper; that they were incorporated in the year 1891, and took over and had
 30 *since carried on the business of a firm which had carried on the same for several years previously; that the Defendants, the British Patent Perforated Paper Company (thereinafter called the British Company) were also manufacturers of toilet paper and were trade competitors of the Plaintiff Company; that the Defendants Mansell, Hunt, Catty & Co. Ld. (thereinafter called Mansell & Co.)*
 35 *were merchants and hotel caterers dealing among other goods in toilet paper;*

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(2) that the Plaintiff Company and the said firm had for 15 years past used for certain of their toilet paper a certain distinctive label; that the said label correctly described the said toilet paper as being made from pure manilla—that is to say, manufactured from rope or cotton waste; that the Plaintiff Company's said goods had been largely sold and advertised in connection with the said label, and the same had become and was well known to the trade and public as indicating that the goods whereon it was used were the goods of the Plaintiff Company; (3) that the said goods of the Plaintiff Company bearing the said label were formerly and for a long period supplied by the Plaintiff Company to the Defendants *Mansell & Co.*; (4) that the Defendants the *British Company* had sold and offered for sale to the Defendants *Mansell & Co.* and other customers and the Defendants *Mansell & Co.* had sold and offered

No. 1. THIN MANILLA GUARANTEED 12oz. per ROLL.

**This paper is made
from pure Manilla,
and is specially
prepared for Toilet
purposes and
GUARANTEED
to weigh
12 OZ. PER ROLL,
about
1000 SHEETS.**

No. 1. THIN MANILLA GUARANTEED 12oz. per ROLL.

for sale toilet paper, which was not the paper of the Plaintiff Company and was not pure manilla paper or made from pure manilla or from manilla at all, but was a foreign-made paper and of inferior composition and quality, bearing a label imitated or copied from the said label of the Plaintiff Company, and so nearly resembling the said label as to be calculated to deceive and to cause the Defendants' goods to be passed off as or for the goods of the Plaintiff Company; (5) that the said label of the Defendants was devised and used and was being used by them with intent to deceive purchasers and to defraud the Plaintiff Company.

The Defendants by their Defence alleged—(1) that the first-named Defendants the *British Company* took over and were carrying on business of a Company

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which had carried on business since the year 1883, and were the first manufacturers of toilet rolls in Europe; that the Plaintiffs or their predecessors commenced business in or about the year 1888; the Defendants denied that the Plaintiffs were manufacturers of toilet paper, but admitted that they were
 5 dealers in the same; (2) the Defendants denied each and all of the allegations contained in paragraph 2 of the Statement of Claim; they alleged that the label referred to in paragraph 2 of the Statement of Claim, except so far as the same consisted of the words "Ship Brand," was in no way distinctive; (3) that the use of the word "manilla" in connection with toilet papers was common to
 10 the trade, the said word in connection with toilet paper did not signify that

Thin Manilla, Superior Quality Paper.

This Paper is made
 from pure Manilla,
 and is specially
 prepared for Toilet
 purposes and
GUARANTEED
 to be of
 Superior Quality.

Thin Manilla, Superior Quality Paper.

No. 1.

such toilet paper was manufactured from rope or cotton waste; (4) they did not admit that the goods referred to in paragraph 3 of the Statement of Claim bore the label therein mentioned; (5) the Defendants denied that the toilet paper sold by them as alleged in paragraph 4 of the Statement of Claim was
 15 not manilla paper or was not made from pure manilla or from manilla at all, or that such paper was a foreign-made paper or that it was of inferior composition or quality; the label used on the said toilet paper was not imitated or copied from the said label of the Plaintiff Company, nor did it so nearly resemble the last-mentioned label as to be calculated to deceive or to cause the
 20 Defendants' goods to be passed off as and for the goods of the Plaintiff

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Company; (6) the Defendants denied each and all the allegations contained in paragraph 5 of the Statement of Claim.

Both the Plaintiffs' and the Defendants' labels were of a pale yellow colour, although differing in tint, with black letterpress. For the retail trade the Plaintiffs' label had at the top the words "Ship (Registered Trade Mark) 5
"Brand," and at the bottom, "C. P. L., London." A representation of the Plaintiffs' label appears on p. 690, and a representation of the Defendants' label will be found on p. 691.

The action came on for trial before SWINFEN EADY, J.

Micklem, K.C., and *D. M. Kerly* (instructed by *Hickson and Moir*) appeared 10
for the Plaintiffs; *Eve*, K.C., and *F. H. Maugham* (instructed by *Wilkinson, Howlett, and Wilkinson*) appeared for the Defendants. The arguments were entirely on the facts.

SWINFEN EADY, J.—I have not the least doubt as to what is the proper judgment to give in this action. It is a passing off action, and the Plaintiffs' 15
claim as opened at the Bar was a claim that the Defendants had passed off their goods as and for the Plaintiffs' by the use of a particular label. The language of the label was discussed. It was pointed out that it had upon it, "This paper
"is made from pure manilla," and it was said that no claim whatever was made to the words "manilla" or "pure manilla"; that those were words common to 20
the trade, and that at the present time paper made from wood pulp is known in the trade as "manilla." The only claim was in respect of the label as a whole. It was alleged that the Defendants used their label, which had only come to the knowledge of the Plaintiffs last year, for the purpose of passing off their goods as the goods of the Plaintiffs. 25

Now I shall have to consider the evidence, but it is conceded apparently on behalf of the Plaintiffs that the Defendants have established beyond all possibility of dispute that in and since the year 1894 they have been using the label complained of. Of course that position is accepted now. There was no suggestion on behalf of the Plaintiffs that that label had not been used by the 30
Defendants from that time. The facts seem to be these: These toilet rolls were imported from America originally and first sold in this country in or about the year 1880. Mr. *Fitch*, who gave evidence for the Plaintiffs, said that he thought he was the first person to sell them in the United Kingdom, and that he sold them first in the year 1880. Originally there was no machinery in 35
this country to carry out the work of preparing them for the market, perforating them, and so on, but in or about the year 1883 machinery was started, and the rolls were made in this country. A Limited Company called the *British Patent Perforated Company Ltd.* was formed, and acquired rights to manufacture these things and sell them. The Company ultimately got into financial 40
difficulties; according to Mr. *Alcock* it never made a profit, but did a considerable trade in 1895 and 1896; that diminished in 1897, and in 1898 a Receiver was appointed, the Company passed into liquidation, and Mr. *Alcock* purchased their rights with the sanction of the Judge in the liquidation under an Order of the Court. Now from 1883 the goods of the Company were sold in this country. 45
One of the earliest buyers who were called before me was Mr. *Shaw*, the foreman of the *Army and Navy Stores*. He entered the service of the Stores in March 1882, and he was able to speak to the purchase of the rolls originally from America, and afterwards from the old *British Company* in the year 1883. For a period that he fixed of about four years—that would be either from about 50
1883 or 1884 to about 1887 or 1888—the Stores were supplied with goods with a small rectangular printed yellow label with no picture upon it, only letterpress. Mr. *Norris*, representative of and branch manager originally, and afterwards London manager of *Ingram and Royle*, was also able to speak to the same period. They purchased paper from the *British Company, Ltd.*, then 55
manilla, up to 1887; in 1885, 1886, and 1887 their orders were large, and there was originally only a label. Subsequently there was a wrapper. His view

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was—he could not fix the date, he was speaking from memory—that it was about the year 1886 that the wrapper was used. Mr. *Alcock* spoke as to the wrapper being introduced about the same period, 1886 or 1887. That is the wrapper B. But previous to that date there was only in use the rectangular label.

- 5 Now the Plaintiffs' evidence with regard to the label that was used was this. "In the year 1888 the *British Patent Perforated Paper Company Ltd.* used a label." Now this is a label as distinguished from a wrapper. "It was part of the label C 4. "That portion in black in the right-hand corner with these letters in yellow." That is what is called the black fixture. It is a picture of the fitment
- 10 intended to carry the roll. There is a bronze handle with a wire across, and the roll is suspended from it, and there is a picture of that fitting, and with the words, "Economy, health, comfort, and neatness"—those four words principally. Now according to the Plaintiffs that was the label which the *British Company* used. That label, the Plaintiffs say, was placed about
- 15 half-way round the roll on "No. 1 thin." In other words, it was not a wrapper, but was placed apparently transversely, somewhat in the same way that the present label of the *Toilet Requisites Company Ltd.* is placed. It was placed transversely on the roll, and passing about half-way round. Now I cannot find a single person who corroborates the Plaintiffs in that version.
- 20 Not a witness called on behalf of the Plaintiffs has spoken as to ever having seen that label, and no one in the case on either side, except Mr. *Colley*, ever speaks to having seen that small label so placed, pledging himself to the particulars of it. On the other hand, the Defendants have called
- 25 Mr. *Norris* and Mr. *Shaw*, who were buyers of the goods at the time when they were put up with the label in dispute, the label C 3 upon them, and each of those two persons pledges himself positively as to the nature of the label on the goods. Mr. *Norris*, the manager of *Ingram and Royle*, said that he could not pledge himself to the actual date as to when this label was superseded by the wrapper, but there was an incident that brought the change to
- 30 his recollection, and it was this. He says: "I remember the block of the "holder being shown on the wrapper; that was a considerable change"—that is to say, this picture was a considerable change—and he says how he remembers the introduction of the wrapper. According to the Plaintiffs' evidence it was that picture which was on the label before. Then in addition to those
- 35 buyers there was Mr. *Alcock*, one of the Defendants, who trades now as the *British Perforated Paper Company*, and he was closely associated with Mr. *Lawson*, the founder and originator and managing director of the original Limited Company, and he is able to speak, as from the year 1883, of having seen the goods packed with this label upon them. In 1886 he entered the service of
- 40 the Company, and he is able to speak definitely to particular years. As to the *Sanitary Paper Company*, buyers from them, they first purchased from the Company in 1886 and continued until the middle of 1888. The goods supplied to them were labelled with the label in dispute—C 3. Then *Cathey and Dobson*, who also bought, had goods sometime before the amalgamation of the Defendants' firm. In the year 1887 they had the label C 3. Then he spoke of
- 45 *Cowtan & Co.*, who dealt with the Limited Company from 1884; their goods were labelled with C 3, and there was no other label until B was introduced, and he denied that there was ever at any time any small label with the black fixture upon it for "No. 1 thin."
- 50 In addition to those witnesses the Defendants have called the printer and his assistant. The printer, *Samuels*, has produced his record of labels printed. It goes back to the year 1894—he has two books going back as far as 1894. His earlier books have been destroyed, and so far as those books go they contain this label identical in all material particulars
- 55 with the label now in dispute. In March 1894 there is an entry of printing for the Company 5000. Then in 1895 a lot of 3000; another lot of 5000 three weeks later; November, 1895, 3000; the next year 20,000—that is to

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say, very large numbers of labels printed; and as to the particular label there is no dispute, because the label is printed in his record with the number upon it. That is as regards the records actually produced. Then Mr. *Samuels* gave this further evidence in chief: "I only printed one label for that Limited Company. It was yellow in colour; there was only letterpress, there was no 5 "block"—that is to say, this black fixture was not upon it—"and it was "exhibit A. About 1883 or 1884 was the earliest printing." Then he printed wrappers as well as the labels. Mr. *Samuels* was not cross-examined. This point was not put to him: "Was not in fact the label the Defendants used the "black fixture label"? It may be his answer would have been the same, 10 because he said he never printed but this one label—apart from wrappers he only printed this one label for them. Then he is corroborated by *Brewer*, his assistant, and foreman. *Brewer* went there in December 1889, and he says that as soon as he went to Mr. *Samuels* he remembers the printing of the yellow label. He was employed as a cutter; this label was printed in sheets, and it 15 was his duty to cut up the sheets into separate labels after they were printed. He said the type in that label C 3 is the same as that which he cut up. Now it was said, and it may well be with some truth, that this printer's cutter would not be likely to remember the exact letterpress, the exact wording of what was printed on the label. But he would be perfectly able to see whether 20 it was a plain label with letterpress only or whether there was a picture, and he is sure that it was a letterpress label. Not only that, but I think it is not giving full effect to what he said unless I also refer to the answer which he gave in cross-examination, that immediately he saw the label C 3 he recognised that as the label that he cut up, and when the other label C 1 was shown 25 to him he immediately said he had never seen that before, and when the *Toilet Requisites* label was shown to him, which has a fixture, not the same fixture as the black fixture, but which has a picture upon it, he immediately denied he had seen that, and he was able at once to identify the label which when he went to this employment he cut up. In my opinion the evidence is 30 substantially all one way. I have looked to see whether there was any witness on behalf of the Plaintiffs who would give any material evidence with regard to this black fixture label. In addition to the Plaintiff, *Sawyer*, his traveller, was called. His evidence was that the only goods of the Defendants which he had seen labelled were goods with the *Broncho* label, which was not produced 35 till a much more recent date, except that he saw the yellow label of the *Drayton Mills*—that is to say, apparently he never saw the wrapper B or C. Then there were other witnesses who had only bought *Colley's* goods. There was Mr. *Oliver*. The only labelled goods that Mr. *Oliver*, who was buyer to *Dalton, Morgan & Co.*, had ever bought were *Colley's* goods. Then Mr. 40 *Herbert Fitch* had only bought *Colley's* goods; but there was no one who was able to give any material corroboration to the Plaintiffs, that the old label of the Defendants was the black fixture label, and I have no difficulty whatever in coming to the conclusion that the old label which the Defendants used in and from the year 1883 was the label marked C 3. I do not accept the account of 45 Mr. *Colley* that the language of his label was his invention in the year 1888—that he designed that label in 1888. His contention was that one was copied from the other, but when it was put to him in cross-examination he suggested it was obvious one was copied from the other, but, if that be the fact, then I am satisfied that the Plaintiffs' was the second, and it 50 was that that was copied from the Defendants'. So that, with regard to the origin of the label, in my opinion the Defendants were first in time to use it.

Then the second point was this: Ever since they began to use it they have used it continuously. They used it for a class of paper which is a little cheaper 55 than the paper they have been selling for many years past in respect of which they have registered their trade name of "*Broncho*." Whenever they can, they

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prefer to sell the "Broncho" paper because they get more profit. But as regards the user of the label it has been used continuously.

Then it was suggested that the Defendants could not show a single person to whom they had ever sold goods so labelled except their Co-Defendants. There
 5 really is no foundation for that view; it is very far indeed from the truth. I have pointed out many instances beginning so far back as 1883 in which that label has been used. Mr. *Alcock* was examined with regard to why it was used, and he gave an answer which was to my mind very intelligible and very likely. He said that one customer of theirs whose name he
 10 has mentioned, *Wyllie & Co.*, to whom goods had been sold unlabelled, declined to sell goods with the name of the maker upon them—that has generally been the reason why the C 3 label has been used. Now it will be observed that the wrappers have the name of the Defendant Company printed across them—the *British Patent Perforated Paper Company*. The label has
 15 not, and one quite appreciates—one hardly wanted the evidence to appreciate—the trade reason which the witness gave for that method of doing business. The large wholesale dealers who take large quantities of these goods much prefer, and some of them insist, that the name of the maker or the origin of the goods shall not appear on the goods themselves, the reason being that the shopkeepers
 20 to whom they sell them if they knew where the goods came from, instead of sending a repeat order to the dealer, might order direct from the manufacturer, and so the dealer would lose the trade, so that they insist that the origin of the goods shall not appear. Now apparently the Plaintiffs do something very much the same, because they have on labels for some of their goods, certainly in addition
 25 to what appears on the label in dispute, "Ship Brand," and they have a registered mark "Ship Brand." But in respect of the goods sold to dealers they do not use that "Ship Brand" mark, but use No. 1 alone. It seems to me that that is a very reasonable explanation of how it is that this particular label has been used continuously, and still continues to be used for certain classes of
 30 goods, and with certain trades, although side by side with that the Defendants also use a wrapper which disclose their name on the goods.

Then the next point that I think should be dealt with is this. Apart from the considerations to which I have already given attention, I am of opinion that the label is not calculated to deceive in such a manner as to induce a person to
 35 buy the Defendants' goods under the impression that he was buying the Plaintiffs' goods. It is to be observed that the labels are not distinctive in themselves. They are yellow coloured, and apparently all those who use this toilet requisite use a yellow coloured label. It is small in size, rectangular in shape. The other labels are the same. The Plaintiffs' is, and the *Toilet*
 40 *Requisites Company's* label is also the same. It contains no reference to anything distinctive, but it has these words, "This paper is made from pure "manilla." I have already pointed out it is conceded that this is common to the trade. Now who are the persons who are likely to be deceived? With
 45 regard to the buyers from the wholesale dealers they obviously know the source from which these goods are obtained, and they would not go to the Defendants thinking they were going to *Colley*. With regard to the shops and retailers who retail them, they are of two classes. Some shops obtain them from the wholesale dealers. It is common ground that with regard to that
 50 trade the parties endeavour to conceal from the retail shops the name of the maker. The goods are purposely made up in that way. There is another class of retail shops which buy direct from the manufacturer, and there they get the brand "Ship Brand," or something to indicate the goods, upon them. Then there was no retailer who could give any evidence before me from which I could come to the conclusion that he or the public would be deceived in any way.
 55 Two retailers only were called on behalf of the Plaintiff; one of them was Mr. *Young*, a chemist in Finchley Road, and his evidence was that "We"—I suppose that means persons in the trade—"do not consider the labels at all in

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"purchasing the toilet rolls." Then the other person was Mr. *Dalner*, from whom the rolls were purchased which gave rise to this action. His evidence as to the way in which he came to buy these particular rolls was this—previously he had dealt with a different class of goods with a green label. He was buying some other goods on this occasion from *Mansell*, and he told them to fill up with a dozen rolls of paper, and the only description he gave was, "Some rolls of paper that he could sell at 6*d.*," and they supplied him with a dozen at 4*s.* a dozen; they cost him 4*d.* each and he could retail them at 6*d.* 5

Then I have dealt with the wholesale buyers, buyers for large dealers who obviously would not be deceived. In my opinion, having regard to the way in which these goods are put up and to the nature of the labels themselves, and to the other evidence, I am of opinion that in fact one is not likely to be passed off as and for the other. There is no probability of deception. On all these grounds I am of opinion that the Plaintiffs' action wholly fails, and must be dismissed with costs. 10 15

IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, and COZENS-HARDY.

July 15th, 25th, 26th, and 27th, 1904.

PETER PILKINGTON LD. v. B. AND S. MASSEY.

Patent.—Action for infringement.—Issue of infringement.—Judgment for Plaintiffs.—Appeal by Defendants allowed. 20

The Specification of Letters Patent for "Improvements in atmospheric or power hammers" ended with five claims, the first of which was as follows:—
"In an atmospheric hammer, arranging the closed ends of the hammer and air pump cylinders in proximity to each other, and directly connecting them through short passages of small capacity controlled by one or more valves, the arrangement being such that air can be drawn direct from the hammer-head into the air pump cylinder, at each suction stroke of the pump, to cause the hammer-head to rise, and air can be forced direct from the said pump into the hammer cylinder at each compression stroke of the pump, to cause the hammer-head to descend, so that the hammer-head will work in unison with and will 25 30

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"promptly respond to the movements of the pump piston substantially as herein described." Claims 2, 3, and 4 commenced with the words "an atmospheric hammer of the kind specified in Claim 1"; Claim 5 was for the particular hammer described and shown. The hammer described in the Specification had the capacity of regulating the force of the blow, and of the hammer-head being held up or down whilst the air pump continued to work. The owners of the Patent, having commenced an action for infringement, the Defendants relied mainly on non-infringement, although they also contended that the hammer described and shown would not work practically. The Defendants' hammer had both ends of the cylinders closed, and a by-pass between the ends of the air cylinder, and the upper passage was free, and they contended that the Claims in the Specification only extended to hammers in which the pressure of the atmosphere was employed in raising them; also that Claim 1 did not include the holding up and down actions, and the parts relating thereto, or, if it did, it was for the specific hammer described, and that they had not got the patented devices; and that Claims 2, 3, and 4 were appendant claims, so that unless the alleged infringement was covered by Claim 1, there was no infringement. It was held at the trial, that the objection to validity failed; that the claims were not limited to hammers in which atmospheric pressure was used; that Claim 1 included the parts for holding up and holding down, and was for a specific hammer; that Claims 2, 3 and 4 were appendant claims; that the Defendants' by-pass was a convenient way of making the invention workable where both ends of the cylinders were closed; and that the Defendants had infringed. Judgment was given for the Plaintiffs, with costs. The Defendants appealed.

Held, by the Court of Appeal, that atmospheric hammers with both ends of the cylinders closed, as well as those with one end only of each cylinder closed, were known at the date of the Patent; that the Patentee was dealing only with those that had not both ends closed; that the problem in hammers with closed ends was different from that in hammers with open ends, and that the Patentee had limited his claims to the latter class in which there is a single action, and that the Defendants' hammer had not a mere duplication of that action; and that they had not infringed. The appeal was allowed with costs, but not including the costs of the Particulars of Objections to the validity of the Patent.

On the 9th of August 1894, Letters Patent (No. 15,212 of 1894) were granted to Thomas Jameson, on a communication from abroad by R. M. Reay, for an invention of "Improvements in atmospheric or power hammers." The Complete Specification was as follows:—

"This invention has reference to an improved construction of atmospheric or power hammer designed to combine the advantages of steam, drop and atmospheric hammers, and which, while simple in construction, is completely under the control of the operator and so as to render it applicable to all kinds of forging, welding, stamping, drawing, tapering, embossing and like operations.

"And in order that this invention may be fully understood I will proceed to describe the same with reference to the accompanying drawings, in which

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" Figs. 1, 2, and 3 are respectively front, side, and rear elevations, and Fig. 4
 " a plan, showing an atmospheric hammer constructed according to this
 " invention. Fig. 5 is a central vertical section thereof, partly in elevation.
 " Fig. 6 is a section on the line *x x* of Fig. 5, looking in the direction indicated
 " by the arrows in that figure. Fig. 7 is a section on the line *y y* of Fig. 6, 5
 " looking in the direction of the arrows in that figure. Figs. 8 to 13 inclusive
 " are detail-views hereinafter referred to.

" The improved power hammer comprises a hammer cylinder 1 and
 " an air pump cylinder 2 inclined to each other, and provided respectively
 " with a hammer head 3 and a piston 4, the upper ends of the 10
 " cylinders being directly connected by a short passage controlled by a
 " valve as hereinafter more particularly described. The hammer head is
 " arranged to fit the cylinder 1 in which it works after the manner of a
 " plunger, the said cylinder being of uniform bore throughout. The piston 4
 " which serves to exhaust air from and compress air into the cylinder 1, for 15
 " the purpose of reciprocating the hammer head, is connected by a rod 5, and a
 " crank-pin 6 to two discs 7 which act as fly wheels. One of the discs 7 is
 " secured on a shaft 8 provided with fast and loose pulleys 9 and 10 respectively
 " and carried in a bearing 8^a. The other disc is carried by a pin 8^b supported in 20
 " the frame at 8^c. The cylinders 1 and 2 are adapted to communicate with each
 " other by means of two sets of ports 11 and 12. The ports 11 are forked and
 " open into the cylinder 1 at two places 11^a and 11^b in the length thereof. The
 " ends of the ports 11 and 12 remote from the cylinders 1 and 2 open into a
 " cylindrical valve-chamber 13, in which are arranged two rotary slide valves 25
 " 14 and 15 (see Figs. 12 and 13) adapted to close the ports 11 and 12 respectively. 25
 " The valve 14 is operated by means of a spindle 16 which is connected by
 " means of a crank 17 and a rod 18 to a treadle 19. The valve 15 is
 " operated by means of a sleeve 20 which is situate on the spindle 16, and
 " has secured on its outer end a hand regulating-lever 21. The valve 14 is a 30
 " flap valve of arc-shape in end view, as shown in Figs. 5 and 13, and is adapted
 " to fit the internal cylindrical surface of the valve-chamber 13. Near one of
 " its edges is a hole 22 (Figs. 12 and 13) with which engages one of the prongs
 " of a bifurcated part 23 carried by an extension 24 of a boss 25 fast on the
 " spindle 16 (Figs. 10 and 11), the arrangement being such that the valve 35
 " can be rocked by the spindle 16, but is free to lift to a small extent from
 " its circular seat when not forced thereon by compressed air, the extent of lift
 " being limited by the curved edge 24^a of the projection 24. The valve 15 is
 " similar to the valve 14, and is similarly attached to and operated by the sleeve
 " 20. The spindle 16 and its sleeve 20 are supported in a bearing block 26 40
 " screwed into the body of the hammer in which the inner end of the spindle
 " 16 has a bearing as shown. 27 and 28 are leather-washers for making air-
 " tight joints between the spindle 16 and sleeve, and between the sleeve and
 " block respectively. 30 is a set-screw by which the spindle 16 can be forced
 " endways in a direction to compress the said washers. 31 is a leather flap-
 " valve adapted to permit air under pressure to issue from the cylinder 2 45
 " through a hole 32 but to prevent air from entering therethrough. 31^a is a cover
 " or guard plate for the said flap-valve. 33 is a spring bar arranged normally
 " to keep the treadle 19 in the position shown in the drawings. The piston 4
 " is provided with a packing ring 34 that may be of cast iron as usual. The
 " hammer-head 3 is also furnished with packing-rings 35 that may be of 50
 " metal, but are preferably of leather as this material makes a very good
 " joint, is not affected by shocks, wears well, and is very easily renewed.
 " For the latter purpose the hammer-head 3 may be lifted out of the cylinder 1
 " in the case of small hammers the top of the cylinder being for this purpose
 " made removable; or in the case of large hammers it will be sufficient to 55
 " remove the hammer-face 36 and, possibly, also the anvil-block 37—which
 " should then be made detachable—to allow the hammer-head to descend

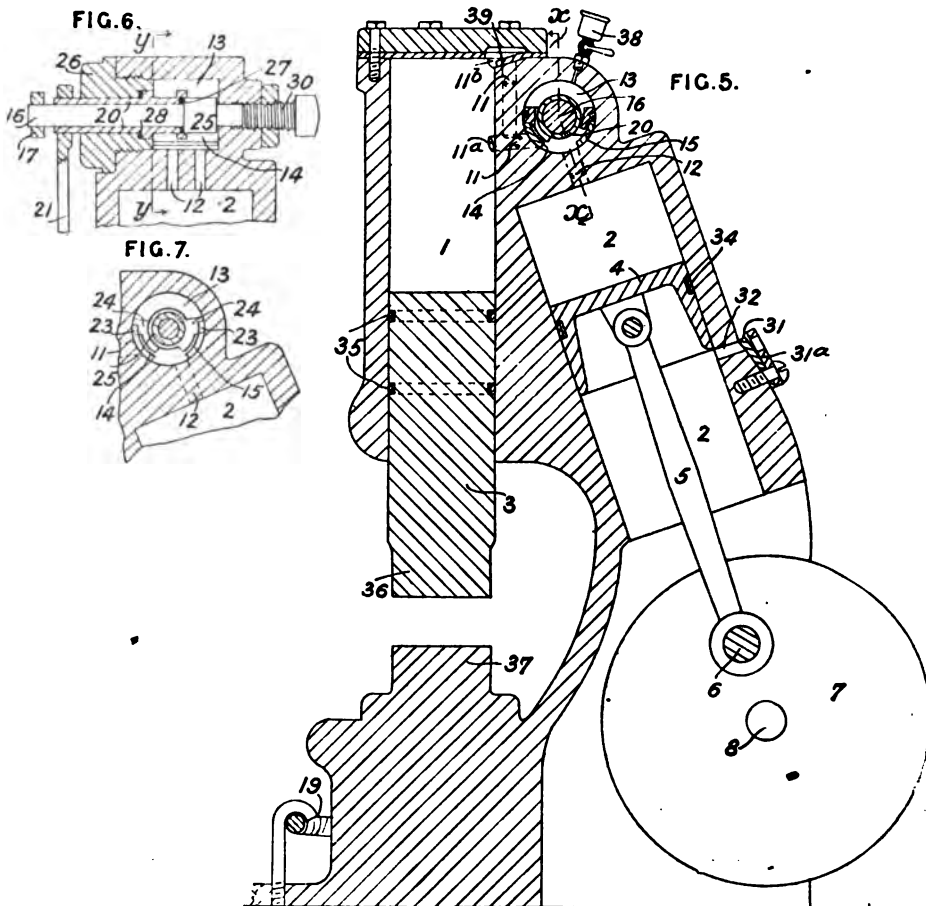
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- "sufficiently far to expose the packing-grooves therein. A single oil-hole 38 may be provided for the two cylinders and the valve, the oil being distributed therefrom by means of the pressure and vacuum produced in the machine. The lubricant will be prevented from dripping upon the work by reason of
- 5 "the vacuum set up in the cylinder 1 at each upstroke of the hammer-head.
- "When it is desired to use the hammer, the driving-belt is shifted from the loose pulley 10 to the fast pulley 9. Assuming the valves 14 and 15 to be in the positions shown in Fig. 5, the descent of the piston 4 in the cylinder 2 will cause air to be exhausted from the cylinder 1 through the ports 11^a and
- 10 "will thus cause the hammer-head 3 to be raised by the pressure thereon of the external atmosphere. A leather flap-valve 39 serves to prevent air being sucked from through the upper ports 11^b thereby ensuring that there shall be a cushion of air at the top of the cylinder 1 to prevent the hammer-head 3
- 15 "when rising from striking against the cover end of the cylinder. The ascent of the piston 4 will have no effect on the position of the hammer-head 3, as the valve 14 will, when in the position shown, be forced on its seat and prevent air passing into the cylinder 1. In its descent the piston 4 will pass the hole 32 and on ascending will expel therethrough a portion of the air in the cylinder 2; by this means the partial vacuum in the cylinder 1
- 20 "will be maintained and too great a pressure prevented from being produced in the cylinder 2. In order, now, to produce a succession of blows, the treadle 19 is pressed down, causing the valve 14 to rise and clear the ports 11; when the treadle is released the valve will be returned to its closed position and the blows will cease, the hammer-head remaining in a raised position.
- 25 "If it is desired merely to press down some article on the anvil, as in a vice the valve 15 is lowered over the ports 12 by means of the hand lever 21 and the valve 14 is slightly raised by means of the treadle 19 and when the hammer-head reaches the article, the valve 14 is opened to the extent requisite to produce the desired pressure.
- 30 "The hammer-head can in the manner just described be lowered into any desired position and then retained there by closing the valve 14; this operation is often useful to level a tool to the work to be operated on before commencing to strike.
- "To strike a blow and prevent the hammer-head from subsequently
- 35 "rising, the ports 12 are closed by the valve 15 and the treadle 19 is depressed—gradually or suddenly according to the severity desired for the blow. When it is desired to strike a blow of as great force as possible, the treadle is pressed down quickly and allowed to rise at about the same time as the blow is delivered so as to resume its initial position before the piston
- 40 "4 rises again and produces another blow.
- "Light blows and short strokes of the hammer-head are produced by slightly depressing the treadle 19; and the severity of the blows and the length of the strokes are increased as the depression of the treadle continues.
- 45 "It will be seen that the hand lever 21 is rarely used and that consequently one man is usually sufficient to hold the article to be treated and to operate the hammer. When, however, the work required to be done is of such a nature that one man is required to hold the article, and another to operate the hammer, it is preferable to substitute a lever for the treadle-arrangement
- 50 "for operating the valve 14. In some cases the valve 15 may be omitted. Instead of constructing the hammer-head as a piston, a separate piston may be employed and the hammer-head be suitably secured thereto, but the former arrangement is preferred, as being simpler.
- "A power hammer constructed as described will be found to be particularly
- 55 "adapted for architectural ironwork, bridge-building, locomotive-work, ship-building, the manufacture of hardware and axes, blacksmith-work, tool-dressing of all descriptions and general forge-work."

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The Patentee claimed :—

“1. In an atmospheric hammer, arranging the closed ends of the hammer
“and air-pump cylinders in proximity to each other and directly connecting
“them through short passages of small capacity controlled by one or more
“valves, the arrangement being such that air can be drawn direct from the
“hammer head into the air pump cylinder at each suction stroke of the
“pump to cause the hammer head to rise, and air can be forced direct from said
“pump cylinder into the hammer cylinder at each compression stroke of the
“pump, to cause the hammer head to descend, so that the hammer head will



“work in unison with and will promptly respond to the movements of the 10
“pump piston substantially as herein described. 2. An atmospheric hammer
“of the kind specified in Claim 1, in which the passage between the hammer
“and air pump cylinders is controlled by a valve adapted to automatically
“lift or open to a small extent after being moved into its closed position,
“so as to allow of the passage of air from the hammer cylinder to the air 15
“pump cylinder at each suction stroke of the latter, irrespective of the position
“of the valve operating mechanism, substantially as hereinbefore described.

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- " 3. An atmospheric hammer of the kind specified in Claims 1 and 2, in which the passage of air from the air pump cylinder to the hammer cylinder is controlled by a second valve adapted to automatically lift or open to a small extent when subjected on its underside to the action of compressed air, substantially as hereinbefore described. 4. An atmospheric hammer of the kind specified in Claim 1, in which the air pump cylinder is provided with an outlet-valve through which excess of air will be expelled by the air pump piston in order that the necessary vacuum will be produced in the hammer cylinder at each suction stroke of the pump substantially as herein described. 5. The improved atmospheric hammer, constructed, arranged and operating substantially as described and shown."

In 1902, *Peter Pilkington Ltd.*, the owners of the Patent, commenced an action against *B. & S. Massey* for infringement of the same, claiming the usual relief with costs as between solicitor and client.

- By their Statement of Claim the Plaintiffs alleged (1) that they were the legal owners of the Patent; (2) that the Defendants had infringed; and (3) that a certificate that the validity of the Patent had come into question was granted on the 25th day of July 1901 by Mr. Justice *Kekewich*.*

- The Particulars of Breaches alleged :— (1) That the Defendants, prior to the issue of the Writ in this action, had manufactured at their works at Openshaw, Manchester, and had used, sold, and advertised for sale, pneumatic hammers constructed in accordance with the Complete Specification of the Patent, and as claimed in the first, second, and fifth claims thereof; (2) In particular the Plaintiffs complained of the sale by the Defendants to one *G. T. Grey*, marine engineer, of Parr Bank, West Holborn, South Shields, of a pneumatic hammer constructed as aforesaid; (3) The Plaintiffs also complained of an advertisement on page xvii. of "The Engineer," of the 18th of July 1902, in which advertisement the Defendants advertised and offered for sale pneumatic hammers constructed as aforesaid; and (4) The Plaintiffs reserved the right to recover in respect of all infringements.

The Defendants by their Defence :—(1) Denied infringement, and (2) Alleged that the Patent was contrary to law, void and of none effect, having been granted for an alleged invention which was not new and useful. Particulars of Objections to the validity of the Patent were delivered therewith.

- The Particulars of Objections alleged :—(1) That the alleged invention in respect of which the Patent was granted, was not new, but was matter of common knowledge within this realm at and before the granting of the Patent; (2) That the alleged invention had, before the grant of the Patent, been published in various ways within the realm, and particularly in certain Specifications published at the Patent Office at the dates thereafter mentioned. [Particulars of these Specifications were then given, including that of *Manson* (No. 1603 of 1874), which was the one chiefly relied on at the trial. Other publications were alleged in paragraphs 3 to 6 inclusive.] (7) That *Thomas Jameson*, to whom the Patent was granted, was not the true and first inventor of the alleged invention in respect of which the Patent was granted; (8) That the alleged invention as described was not useful; (9) That the Specification by the Patentee lodged at the Patent Office of the alleged invention contained no sufficient description thereof, and no description at all of any useful or practical invention; in support of this contention the Defendants would produce evidence to prove that a machine constructed as shown in the drawings and as described in the letterpress of the Specification could not be made to work by reason of its being wholly unfit to produce the necessary changes of air pressure in the hammer cylinder, and by reason of the excessive pressures which would be generated in the air pump, and by reason of the want of suitable

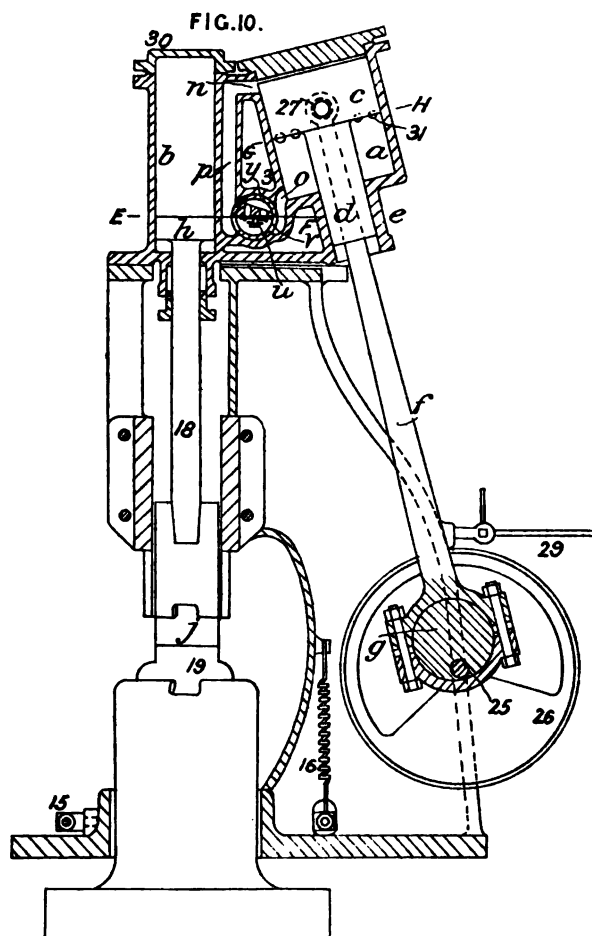
* See *Pilkington v. Yeakley Vacuum Hammer Company*, 18 R.P.C. 459.

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appliances for making good the loss of air from the interior of the machine by leakage.

Further Particulars of Objections were delivered in respect of the Objection, that the said alleged invention was not new at the date of the Patent (for which see *ante*, page 426). 5

The Defendants, on an application for leave to deliver interrogatories, admitted the sale alleged in paragraph 2 of the Particulars of Breaches and the insertion of the advertisement complained of by paragraph 3 and made certain

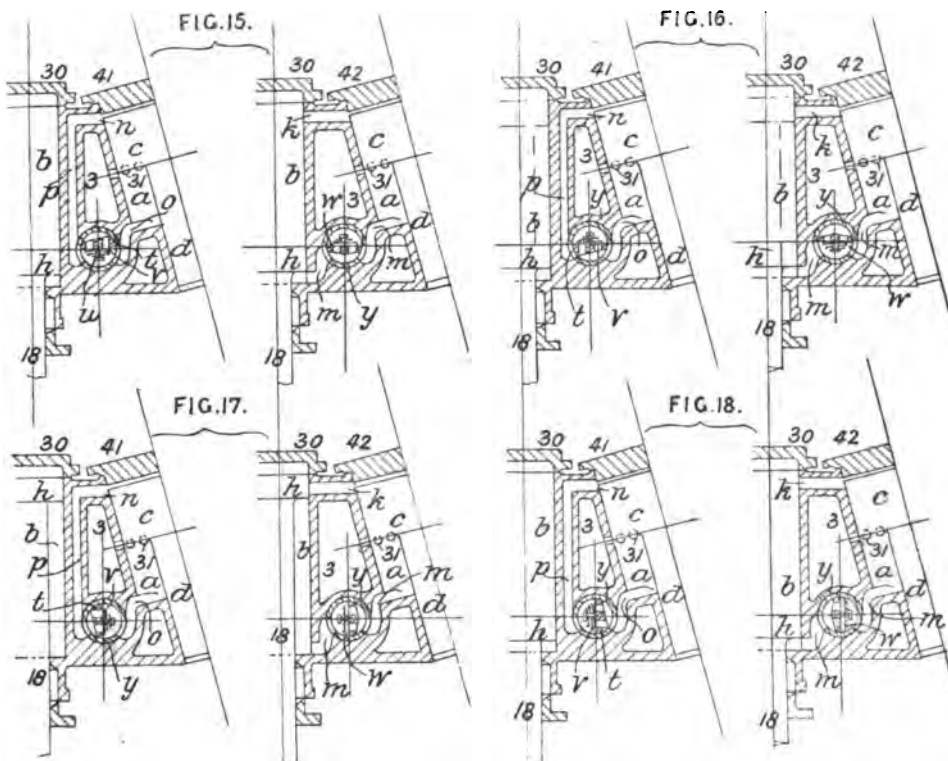


admissions relating to paragraph 5 of the Particulars of Objections. On the 20th of October 1903, the Defendants made an affidavit on an application by 10 the Plaintiffs for inspection, stating that the construction of the hammer complained of in the action was to the best of their knowledge and belief in exact accordance with the lines upon which the hammer or parts of a hammer illustrated by Figures 7 to 18 of *H. F. Massey's* Specification 14,022 of 1900 (Improvements in Pneumatic Power-Hammers) were designed. 15

Figs. 10 and 15 to 18 of the last-mentioned Specification are shown on this and the following page. The parts of the Specification referring to them and

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- material for the purpose of this report are as follows :—" This invention consists
 " in improvements in pneumatic power-hammers and its principal object is the
 " provision of power-hammers, which shall be more efficient and convenient
 " in use than those hitherto constructed and may be arranged to permit any
 5 " desirable length of stroke to the tups or hammer-heads or other corresponding
 " parts used therein and be capable of striking blows of any desirable force and
 " be readily controlled in action so that the tups or hammer-heads or other
 " corresponding parts of such hammers may be made to strike single blows,
 " be made to make strokes of the full length permitted by the construction
 10 " of such hammers or of any less length, be made to strike blow after
 " blow for any desirable period, be held away from the anvils or other



- " objects with which they are used or be used to hold articles or materials
 " fast upon the said anvils or other objects. Power-hammers may also be
 " constructed according to this invention to accomplish the said object in
 15 " part only."

The Specification subsequently described (*inter alia*) a form of the invention in which, in addition to the passage *p* being controlled by a valve *t*, the passage *k* was open and the passage *m* was controlled by a back-pressure-valve *w*, and another form in which both the passages *k* and *m* were controlled by valves,
 20 and continued :—

" It is possible to provide a back-pressure-valve or back-pressure-valves to be
 " inserted at times in either one or both of the passages *k m* for the same
 " purpose as in the arrangement described with reference to Figs. 5 and 6 without

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"providing a back-pressure-valve or back-pressure-valves to be inserted at times in the passage *p* or without employing the passage *p*. Thus for instance a back-pressure-valve may be provided to be inserted at times in either or each of the passages *k m* employed in the arrangement herein described with reference to Fig. 3 and Fig. 4. In cases in which two or more valves are used they may be either completely separated and be worked by separate devices of any suitable kind, or they may be connected so as to be controlled together as is illustrated for example in Fig. 4, or they may be arranged so as to be carried by one piece which being moved moves them both or all as illustrated by way of example in Figs. 7 to 18 of the accompanying drawings. In the power-hammer illustrated by Figs. 7 to 18 the passage *k* from the top of the pump-cylinder *a* to the top of the hammer-cylinder *b* is arranged to be always open while the passage *m* from the bottom of the pump-cylinder *a* to the bottom of the hammer-cylinder *b* is arranged so that it may be left open or have a back-pressure valve *w* inserted into it so that it may be closed against the passage of air in either direction while remaining open to the passage of air in the opposite direction. The back-pressure-valve *w* is carried by a plug *x* which itself forms a valve *t* and is arranged so as to be capable of being made to partly or entirely close the passage *p* connecting the top and bottom of the pump-cylinder *a*. The plug *x* is also made to carry a back-pressure-valve *v* which may be inserted in the passage *p* so as to close it against the passage of air in either direction while allowing air to pass in the opposite direction.

"Each of the back-pressure-valves *v w* illustrated in the accompanying drawings is formed of a plate with a central hole embracing a stud secured in the plug *x* and is arranged to be pressed against a face on the plug *x* so as to cover holes therein by means of a spiral spring which may conveniently be formed out of wire or steel plate and is made to bear against the plate and against the head of the stud.

"Fig. 13 shows separated from each other the parts forming one of the back-pressure-valves *v w*. The plug *x* is arranged to be turned within a tube *y* and provided with collars *z 1 2* to fit therein. The tube *y* is inserted tightly in the casting 3 in which the cylinders *a b* are formed and is provided with ports communicating with the parts into which the passage *p* is divided and with ports communicating with the parts into which the passage *m* is divided. The plug *x* which is shown detached with the back-pressure-valves *v w* carried by it in Fig. 14 is secured against longitudinal movement in the casting 3 by being provided at one end with a flange 4 and at the other end with a nut 5 which by means of a washer 6 presses a collar 7 against the said casting 3.

"The collar 7 also serves as a guide for the upper end of a rod 8 which is provided with teeth so as to engage with a pinion 9 formed upon the plug *x* so that the rod 8 forms a means of turning the plug *x*. The rod 8 is connected to a hand-lever 10 capable of being turned upon a suitable pivot 11 secured in the hammer-framework. The hand-lever 10 is provided with a catch or detent 12 capable of being placed in engagement with or disengaged from notches in a sector 13 capable of being turned about the pivot 11 and connected by means of a rod 14 with a treadle 15 raised after depression by means of a spring 16 and secured at its ends to a rod 17 capable of being oscillated in bearings provided upon the bed-plate of the power-hammer. When the catch or detent 12 is disengaged from the sector 13 the hand-lever 10 may be moved independently of the treadle 15 and spring 16. The back-pressure-valves *v w* and the channel *u* in the portion of the plug *x* forming the valve *t* employed to partially or entirely close the passage *p* when the top or hammer-head *j* connected to the piston *h* by the rod 18 is required to work are disposed in relation to one another in the manner indicated by Figs. 10, 12, 14, 15, 16, 17, and 18.

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- "When the plug *x* is in the position in which it is indicated in Figs. 10 and 15 the passage *p* is fully open, the tup or hammer-head *j* or other corresponding part then remaining unmoved by the movement of the piston *c*. When the valve *t* is in position to completely close the passage *p* as is indicated in Fig. 16
- 5 "the passage *m* is fully open and the tup or hammer-head *j* or other corresponding part is moved to the fullest extent possible by the movement of the piston *c*. When the plug *x* is in the position in which it is indicated in Fig. 17
- 10 "the back-pressure-valve *w* allows air to pass from the lower part of the pump-cylinder *a* to the lower part of the hammer-cylinder *b* but prevents air from passing from the lower part of the hammer-cylinder *b* to the lower part of the pump-cylinder *a* while the back-pressure-valve *v* allows air to pass from the upper part of the pump-cylinder *a* or the upper part of the hammer-cylinder *b* to the lower part of the pump-cylinder *a* but prevents air from passing to the upper part of the pump-cylinder *a* or the upper part of the hammer-cylinder *b*
- 15 "and consequently the downward movements of the piston *c* force air into the lower part of the hammer-cylinder *b* while the upward movements of the piston *c* will chiefly force air from the upper part of the pump-cylinder *a* into the lower part thereof, so that the tup or hammer-head *j* or other corresponding part will be raised and held away from the anvil 19. When the plug *x* is in
- 20 "the position in which it is indicated in Fig. 18 the back-pressure valve *w* allows air to pass from the lower part of the hammer-cylinder *b* to the lower part of the pump-cylinder *a* but prevents air from being forced from the lower part of the pump-cylinder *a* into the lower part of the hammer-cylinder *b* while the back-pressure-valve *v* allows air to pass from the lower part of the
- 25 "pump-cylinder *a* to the upper part thereof but prevents air from passing from the upper part of the pump-cylinder *a* to the lower part thereof, and consequently the air below the piston *h* in the hammer-cylinder *b* is rarefied so that there is always an excess of pressure on the upper side of the piston *h* holding the tup or hammer-head *j* or other corresponding part down upon
- 30 "the anvil 19 or any object which may be placed thereon. . . .
- "If at any time it is requisite to cause the tup or hammer-head or other corresponding part which may be used in the hammer illustrated in Figs. 7 to 18 to strike a single blow and then remain at rest this may be done by removing the plug *x* quickly from the position in which it is indicated in Fig. 17 more
- 35 "or less towards or into the position in which it is indicated in Fig. 16 according to the force of the blow intended to be struck and allowing it to remain in such position during one complete to and fro movement of the piston *c* and then quickly returning it to the position in which it is indicated in Fig. 17. It is obvious that these movements of the plug *x* must be accomplished with
- 40 "some precision in relation to the movements of the piston *c*."

The action was tried before *Kekewich, J.*, who on the 19th of April 1904, gave judgment for the Plaintiffs, holding that the Patent was valid, that the claims were not limited to hammers in which atmospheric pressure was used, that Claim 1 included the parts for holding up and holding down, and was for a

45 specific hammer; that the Defendants' by-pass was a convenient way of making the invention workable when both ends of the cylinders were closed; and that the Defendants had infringed.* The Defendants appealed.

Moulton, K.C., Cripps, K.C., and J. W. Gordon (instructed by *Rowcliffes, Rawle & Co.*, agents for *E. Robinson Walker & Son*, of Manchester) appeared

50 for the Appellants; *T. Terrell, K.C., P. O. Lawrence, K.C., and A. J. Walter* (instructed by *Pritchard, Englefield & Co.*, agents for *D. L. Sprake*, of Accrington) appeared for the Respondents.

Moulton, K.C., and Cripps, K.C., for the Appellants.—This is an action on a Patent relating to atmospheric hammers. [The general action of such a hammer

55 was explained by a model.] Stating the action broadly, the hammer head is

* *Ante*, p. 421.

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lifted by a vacuum, and when the vacuum is destroyed the hammer head falls. The pressure of the atmosphere is really the force acting. As far as lifting is concerned it is entirely the atmospheric pressure that acts. The patented improvement is for holding the hammer up or down. Roughly this is due to slipping in either an air-pump valve or a compression valve. The Patent is for a hammer with these arrangements. It is really a paper Patent, and the patented hammer has never been made except as a model. It is so crudely designed that it is not practicable, and further invention was necessary to make it work. The Patent is bad if a wide construction is put on the claims, but the main defence is non-infringement. The Defendants' hammer is of a different type and is the result of independent invention. [The Specification was read.] Fig. 5 is the important one. The valve 14 is the exhaust valve, the valve 15 is the compression valve. In Fig. 5 the position is for holding up. As to the flap-valve 39, it secures a cushion of air which prevents the hammer head striking the top. The valve 31 allows air to be driven out of the air cylinder, when the pressure there is higher than atmospheric pressure. The Specification well describes the hammer shown and the method of holding up and holding down. Besides the valves 14 and 15 the valve 39 is essential. In Claim 1 "closed ends" mean those ends at which the atmospheric pressure does not act. That claim is for the hammer, but with some only of its features, not with all. Claim 2 is for the hammer claimed in Claim 1 with the exhaust valve; Claim 3 is for the hammer claimed in Claims 1 and 2 with the addition of the compression valve. The first claim is for working in "unison" without the exhaust and compression valves; "controlled by one or more valves" refers to 39 especially. Claim 4 brings in the valve 31. The claims are for a special type only of atmospheric hammer. [ROMER, L.J.—What does "controlled by one or more valves" in Claim 1 mean?] Claim 1 refers to movement in unison, and is apart from the valves 14 and 15. If so, it is a very wide claim and bad. [Terrell, K.C., in reply to the Court.—Claim 1 is for a hammer which is controlled so that one may have a heavy or light blow. It is the passages of small capacity that are described as controlled by the valves. The valve 14 is essential to the control.] As to infringement, the Defendants' hammer has no open ends, and there is nothing in the Specification to enable the public to make anything but an open-ended hammer. Directly one deals with cylinders with both ends closed there are fresh problems. [The Defendants' model was explained.] There is at one time suction on one side of the hammer and pressure on the other side. There is push and pull at one time. But this must be regulated. For this purpose there is a by-pass; if this is open no suction or pressure is produced. But when it is closed there is the full push and pull. There is also a means of throttling the by-pass. This was old and had been done by *Manson*. The Defendants added a movable valve-piece to *Manson*. It is a development of a different kind of hammer, one with which the Patentee did not deal. The Defendants have an arrangement in which one valve controls the by-pass and another controls the bottom passage between the two chambers. [Terrell, K.C.—The infringement complained of is in accordance with Figs. 7 to 18 of *Massey's* Specification.] This is the actual thing made. [The working of the model of the Defendants' hammer was explained.] When the by-pass is partly open the effect is as if there was a bad leak, thus controlling the action. This is as in *Manson*. The holding down is by suction, the holding up by compression. [Terrell, K.C., asked by the Court, said that he did not agree; the holding down and up are both by suction and compression; both sides of the hammer are operative.] There may be some slight increase of pressure in holding down, but the effective thing is the suction. The holding up is by compression only. But this is not the test; these things were not new; and even if they were, anyone could use them for a different hammer. The Patent is only for a special type of open-ended hammer. Moreover, the Patentee has no cumulative action as in the Defendants'. The Defendants' case is that the Patentee has claimed

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a specific hammer, and that the Defendants' hammer is quite of a different kind. The argument presented to the Court below was by putting a series of steps gradually approaching what the Defendants do. The essence of the patented invention is the independence of the working of the valves 14 and 15. Two things manipulated in a particular way to produce the effect was the invention.

5 [VAUGHAN WILLIAMS, *L.J.*—What is the advantage of cumulative action?] It may be desirable to have it. The compression which the Patentee gets may not be sufficient; moreover, there is always some leak. [VAUGHAN WILLIAMS, *L.J.*—Is Claim 1 wide enough to cover obstructing the passages by any means by a

10 valve?] Yes. [Terrell, *K.C.*—By a valve only opening one way.] Valves may mean any means of controlling the air passage. If the Patent covered any means of controlling the passages, that would be bad. Means of throttling were well known. In the Defendants' hammer the closed ends are not connected by passages controlled by valves. The Specification of *Hesse's* German Patent

15 (No. 37,461 of 1881) shows that it was known how to hold up a hammer by a non-return valve. *Manson* was a double-ended hammer—that is, of the same class as the Defendants. *Jameson* did not deal with the problem as regards such hammers. [The judgment of *Kekewich J.* was read.] The *Yeakley* hammer contained improvements which made it useful; it does not follow

20 that the patented invention was useful. The Court will not put a forced construction on the claim for the purpose of upholding the Patent (*Welsbach Incandescent Gas Light Company, Ltd. v. Daylight Incandescent Mantle Company, Ltd.*, 17 R.P.C. 141). The real question is—What is the invention made and claimed? On the true construction the claims are of a limited

25 nature. The two different forms of hammer—namely, atmospheric hammers and compressed air hammers—were well known, and *Jameson* is of the former kind. On the evidence the exact directions in the Drawings will not give a working hammer; but it is admitted that it could be made, from the letterpress; but in fact one has never been made. [ROMER, *L.J.*—Having regard to the words

30 “substantially as described,” may not the “one or more valves” refer to 14 and 15?] [Terrell, *K.C.*—Yes, and the “short passages” are 11 and 12.] But even taking it so, the point is whether the Defendants' hammer is such as is described. [ROMER, *L.J.*—Is the meaning of the Specification this—that Claim 1 is for the general arrangement with one or more of 14 or 15, Claim 2 is for it with 14, and Claim 3 for it with 14 and 15?] Whatever the contrivances covered by any claim, they are only claimed in the atmospheric hammer claimed in Claim 1. Assuming that the Defendants are using them, are they using

35 them in that hammer? [ROMER, *L.J.*—Where have the Defendants the passage connecting the closed ends controlled by a valve?] [Terrell, *K.C.*—The passage is at the bottom between the closed ends, and there is a valve in it. The Defendants have two closed ends at the top and two at the bottom.] In the Defendants' machine for a modified stroke the valve principle is not used at all, but the passages are partly blocked. For holding up or down, the two valves must be working together, they cannot work independently; if one is

40 open the other must be shut. [ROMER, *L.J.*—Will not *Jameson's* work upside down? But then gravity will work against the atmospheric pressure.] It would not work so well at all events; it would not be practicable. But the main argument is that the Defendants' hammer is of an essentially different kind; it has entirely closed chambers, and much greater pressures can be

50 obtained. In the Defendants' case the hammer goes up and down mainly by pressure. In full work the Defendants' is a pressure hammer—that was admitted; but it said that they infringed when they had a modified stroke. If the Specification was intended to cover a closed hammer such as that of the Defendants, then it does not state how to construct or work it, and the

55 Patent is bad.

Terrell, K.C., and *Walter* for the Respondents.—The word “atmospheric” has a wide meaning in this connection, and does not refer only to the pressure

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of the atmosphere, but to communicating motion by means of air, and whether by vacuum or pressure. *Jameson's* problem was this: Given a continuous movement, to obtain an intermittent, changeable, and variable movement. There is a pulley going at a constant speed, and out of that speed one has to strike a blow, sometimes light and sometimes heavy, sometimes to hold the hammer off the work and sometimes to hold it down on the work. The piston, worked by air, goes up and down regularly, but the movement of the hammer, although operated by the piston, is not to be in unison with it. *Jameson's* Patent is not for a one-ended cylinder. He used such a cylinder, and the Defendants use both ends of the cylinder in precisely the same way. It is the use of the valves that is the essence of *Jameson's* invention. [ROMER, L.J.—The Patentee knew that there were two classes of hammers in existence, the simple form, closed at the top, and the double form, like *Manson's*. It is said that he selected one form, and that in the Specification there is nothing to show that it was applicable to the other.] Two forms were not known, and *Manson* was quite different. What *Jameson* did had never been done before; nor was there any hammer that would do it. The Defendants do the same thing by means obviously the same. The capability for holding up and holding down, and of regulating the blow, was new. *Manson* showed a way of moderating the blow, but at the same time the length of stroke was moderated, and he could not hold the hammer up or down. *Jameson* moderated the blow without affecting the stroke, and he found that it could be done by a non-return valve. The Defendants also do it by a non-return valve of the same kind. Coming to the claims in *Jameson's* Specification, "atmospheric" must not be construed narrowly. By an atmospheric hammer the Patentee meant one in which the atmosphere was used as a mode of conveying motion. The blow of the hammer is due to pressure of the air and to the weight of the hammer, and its rise is due to exhaustion of the air. The Patentee meant a hammer worked by air as distinguished from steam. In Claim 1 the capacity of the short passages is to be controlled by one or more valves; it is a claim for introducing a valve into a passage to control the size of the passage, so that a regulated blow can be given with a full stroke. Claim 2 is for holding up, and the valve 14 is the valve that operates to do that, whilst the valve 15 is used to keep the hammer down, which is claimed in Claim 3. The valve 14 is that referred to in Claim 1; when partially closed it regulates the blows, when wholly closed it keeps the hammer up. [VAUGHAN WILLIAMS, L.J.—Claim 1 says "one or more valves." [Moulton, K.C.—The valve 39 is referred to.] The valve 39 is not so referred to; but there may be more valves than one. Claims 2 and 3 are for functions. [VAUGHAN WILLIAMS, L.J.—Is there any case in which a claim for a function has been supported?] We should have said, claiming the thing performing the function. [VAUGHAN WILLIAMS, L.J.—One may claim a thing, but not the result of user of the thing.] This is a combination, and one may claim the valve in one position doing one thing, and also in a different position doing another thing. Then there is the question of infringement. The action was tried on an admission that the Defendants had manufactured in accordance with the Drawings in *Massey's* Specification; but we will take either the Specification or the actual thing. [VAUGHAN WILLIAMS, L.J.—You had better take the actual thing.] [This was then explained to the Court.] The Defendants' hammer has a free passage between the tops of the cylinders, a passage between the bottoms with a non-return valve in it, and a passage from the bottom to the top of the pump cylinder, called the by-pass passage. The Defendants regulate the blow by allowing some of the air to get away instead of going into the hammer cylinder, and this is controlled by a valve. The Patentee regulates by narrowing the entrance to the hammer cylinder. Substantially the same means is used by both parties; there is an obstruction in each case. In lifting the hammer the Patentee has a free passage above through which the air is sucked; whilst the Defendants have a free passage below through which the air is

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driven. In striking there is pressure on the hammer in each case. The Defendants get the full stroke with the moderating effect. The Defendants operate with two passages besides the by-pass; the Patentee operates with one, but makes it equivalent to two, because it can be obstructed either way. The
 5 Patentee contemplates a cylinder working on one side only; the Defendants duplicate it and work on both sides.

VAUGHAN WILLIAMS, *L.J.*—This case has been a very interesting one, and extremely well argued on both sides. It seems to me that it comes down to a very narrow point indeed, but it is a point as to which I feel very clear. My
 10 only hesitation is that which constantly, I am sorry to say, comes to me in giving judgment in patent cases. It is not that I feel any doubt that I understand the arguments that have been addressed to us, and the problem which has to be solved. My difficulty is a want of familiarity with the accurate expressions of the propositions which are more or less scientific, but I hope that
 15 in this particular case I shall not be impeded much by that difficulty.

I start with the proposition of Lord Justice—or as he then was, Mr. Justice—*Romer* in *Nobel's Explosives Company, Ltd. v. Anderson*, which is reported and in the 11th volume of Patent Cases. The case begins at page 115, and the particular passage I am going to cite appears on page 128. This is what Lord
 20 Justice *Romer* then said:—"In order to make out infringement, it must be established, to the satisfaction of the Court, that the alleged infringer, dealing with what he is doing as a matter of substance, is taking the invention claimed by the Patent; not the invention which the Patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance
 25 "claimed on a fair construction of the Specification."

Now, before dealing with the question of what it is that *Jameson* has claimed in his Specification, I begin by stating one fact which I think is of the utmost importance in this case. I think in this case it is proved that there were known and in use both atmospheric hammers, with closed ends of the hammer and
 30 air-pump cylinders, and also atmospheric hammers with one end closed and one end open. The reason why I think that that is of great importance is this, that we have to ask ourselves what the Patentee meant by his claim. It is common ground here, that not only in Claim 1, but in all the Claims, 2, 3, 4 and 5, the Patentee was dealing with atmospheric hammers with ends some of
 35 which were closed, and some of which were not, and the Patentee does that at a time when he must be taken to have known that there were other sorts of atmospheric hammers than those with which he chose to deal. There were those which had some ends closed, and there were the other sort of atmospheric hammers which had all the ends closed. Bearing that in mind I read this first
 40 claim which runs thus:—"In an atmospheric hammer, arranging the closed ends of the hammer and air-pump cylinders"—I cannot doubt myself but that when the Patentee speaks of arranging the closed ends he means that in his air-hammer of which he is speaking there are some ends that are not closed; he would not speak of the closed ends unless antithetically there were
 45 some ends that were not closed—"in proximity to each other and directly connecting them through short passages of small capacity controlled by one or more valves, the arrangement being such that air can be drawn direct from the hammer head into the air-pump cylinder at each suction stroke of the
 50 "pump to cause the hammer head to rise, and air can be forced direct from said pump cylinder into the hammer cylinder at each compression stroke of the pump to cause the hammer head to descend, so that the hammer head will work in unison with and will promptly respond to the movements of the pump piston substantially as herein described." Here again the words "at each suction stroke," show plainly that the Patentee was speaking
 55 of an atmospheric hammer in which you could aptly describe one stroke as a suction stroke, and the other stroke as a compression stroke. In the case of the Defendants' hammer, which is a hammer with both ends closed, you cannot

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possibly make such a contrast between a suction stroke and a compression stroke because each stroke is both a suction stroke and a compression stroke. I arrive so far at the conclusion that there really can be no doubt but that the Patentee intended to refer, and to refer exclusively, to what have been called open end atmospheric hammers, and if one turns to the Drawings at the end of the Specification one finds, especially in sheet 2, that it is obvious that that was the sort of atmospheric hammer to which the Patentee was referring. 5

It will not be denied that, under these circumstances, the Patentee ought generally to be limited to the field of operation which he has chosen to determine for himself by the very words of his claim. I am far from saying that if the problem to be solved in the case of a double cylinder atmospheric hammer—one of the closed atmospheric hammers—when you were seeking by means of non-return valves to regulate the force of the blow, and also to hold up and hold down the hammer as the case may be, were exactly the same as it would be in the case of the open end atmospheric hammer, which I will call for convenience in future a single-action hammer, and I will call the closed ones the double-action hammer—I do not for a moment suggest that if the problem to be solved in the application of such a mode of regulating and holding up and holding down by the use of non-return valves had been the same whether you had a single or a double action hammer, that the Defendants would not have infringed by what they have done. But, to my mind, it is perfectly plain that the problem which had to be solved in the case of the double-action hammer was a very different problem indeed from the problem which had to be solved in the case of the single-action hammer, and the moment that fact is established, if it is established, in my view that which is done by the Defendants is therefore outside the ambit covered by the Letters Patent of the Plaintiffs. When Mr. Moulton was arguing this case he put the difficulties in the problem to be solved in the one case and the difficulties in the other case in a very forcible manner. He said that in the case of a single-action atmospheric hammer you had only to deal with one pressure produced by the action of the air; whereas, in the other case, that is the case of the double-action hammer—that is the hammer with the closed ends—you had really not only to deal with one pressure, but you had to deal with two pressures, and you had to deal with the balance of those two pressures, and, as he put it, you had to take upon yourself the responsibility for the effect of the back stroke, and he said, in a much more clear and forcible way than I can express it, though I entirely apprehend the meaning, I hope, of what he said, that that showed the problem in the two cases was a very different problem. 10 15 20 25 30 35

I really do not think that under those circumstances it is of any great importance to go through the steps in the Plaintiffs' combination and to show that the steps are different, and so different that although it is perfectly true to say that both in the Plaintiffs' combination, and in the Defendants' combination, the control and the holding up and the holding down are all effected by the action of non-return valves, yet the system adopted when you come to details is very different. This, to my mind, illustrates very much that the position, the problem, and the difficulties were not the same in the two cases. It had to be admitted by Mr. Walter, notwithstanding his cross-examination of Mr. Boys, which he so much relied upon, that the by-pass was a matter of the very greatest importance in the efficient working of the Defendants' air engine. Admittedly in the case of the Plaintiffs' air engine the by-pass is not only not essential, but it is not really part and parcel of the invention at all. Again, in Jameson's Specification the valves were really to act independently, whereas in the Defendants' Specification the valves were dependent really on each other; they were both moved by a common rotation which at the moment it set one open closed the other. 40 45 50 55

In my judgment, the result of all this (I should do no good by going through it in greater detail) is that the Patentee has chosen to limit his claims to the

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single-action air hammer, and he has done that at a time when the other sort of air hammers was perfectly well known and in use; and whatever it may have been which really operated on the mind of the Patentee thus to limit his claims, the fact is that there were ample reasons which might have affected his mind
5 so as to make him deliberately do so. In fact the problem in the case of the closed cylinder was a problem different from and more difficult than that which had to be solved in the case of the air hammer with one end open, and it may well have been that the Patentee limited his claims to the open-end air hammer because he either could not see his way to solve the question in the
10 case of the double-end air hammer or because he felt that danger would arise if he made his claim in that way.

I have only to say again that if I had felt that this was simply a case of two open-ended cylinders put together in the way Mr. *Walter* did in his clever illustration, I should have held that that was not substantially different from
15 that which was claimed by the Patentee, because having two of the cylinders put together instead of one of them might have left the problem and the difficulties which were solved in the one case absolutely solved in the other. I am of opinion beyond doubt on the evidence that the problem was not the same, and that the difficulties were enormously enhanced the moment you had the
20 double cylinder with the closed ends. Under these circumstances I think this appeal ought to be allowed.

ROMER, *L.J.*—I have felt, speaking for myself, that this is a very difficult case to decide, and I have had great hesitation in arriving at the conclusion, but the conclusion I have arrived at is that the appeal ought to be allowed. I can
25 state my reasons very shortly. To my mind the Plaintiffs' Specification, and the claims in that Specification, are framed with reference solely to an atmospheric hammer having an open end to the hammer, and I cannot find throughout the Specification any suggestion that the invention was applicable to any other kind of hammer. In particular I cannot find any reference to an atmospheric
30 hammer where both ends of the cylinder are closed and force is applied by what I may call double action; that is to say, by pressure alternating on the top and the bottom of the hammer. I will for brevity hereafter refer to that kind of machine as a double-action hammer. Now, it is the more significant that no reference whatever is made throughout the Specification to the double-action
35 hammer, seeing that it was perfectly well known at the date of the Patentee's invention, and, indeed, had been known for a considerable time back; for instance, in *Manson's* Specification, which gives one example of a double-action hammer. I cannot help thinking that if the Patentee had intended to apply his invention to, or to have a claim covering the double-action hammer, he ought to
40 have made it clear, or have made some reference to it, and shown, or attempted to show how his invention could be applied to such a hammer. Not only, as I have said, is there no reference whatever in the Specification to any such thing as the double-action hammer, but, to my mind, the Specification and claims are so framed as, on their face at any rate, to negative the idea that the Patentee
45 intended to claim his invention for anything except what I will call the single-action hammer. But, notwithstanding the view which I take of the Patentee's Specification, if, for the purposes of the Patentee's invention, and the claims in his Specification, I could have regarded the double-action hammer as merely a double of the single, or as a single-action hammer with a mere addition to it,
50 to which the Patentee's invention might have been applied without difficulty and without any further invention, I might have seen my way to say that the Defendants' machine was not outside the scope of the Plaintiffs' Patent. But, on consideration of the facts of this case, and of the evidence taken as a whole, I cannot arrive at that conclusion. I do not think that the double-action
55 hammer, for the purposes of the Patentee's invention, and for the purposes of his claim, can be regarded as merely taking the single-action hammer and duplicating it, or taking it and adding something to it which still left it open for the invention

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to be applied without difficulty, and without further invention; nor do I think it is a case where, if the inventor did find a method of obtaining the same results as were obtained by the Patentee's invention as applied to single-action hammers, from double-action hammers, that it could be said the inventor was merely taking the Plaintiffs' invention and improving upon it; at any rate I cannot so say with regard to the machine that the Defendants have produced and to the invention of the Defendants as shown in that machine. It is, to my mind, not obvious at all, starting as from the date of the Plaintiffs' Specification, that this arrangement could be applied, satisfactorily or practically, to the double-action hammer, at any rate to such a double-action hammer as the Plaintiffs have produced. To my mind the problem of obtaining the Plaintiffs' results in the double-action machine was one substantially different from that which the Patentee had to solve, and did solve, as applied to the single-action machine, and I may say a very difficult problem too. For example, it was not at all clear, in my opinion, that without special contrivances and special invention the Patentee's arrangement could be applied practically so as to keep up the hammer in an efficient, or practically efficient way. I can see, and perhaps it may be said, that it could be applied without much invention so as to hold the hammer up a little, probably with a little oscillation, but I do not think that without invention you could have applied to the double-action machine the Patentee's arrangement for holding up efficiently so as to make a practical working machine. At any rate that is the conclusion to which I have come notwithstanding the evidence of Professor *Boys* which I have carefully considered, and I think that his cross-examination on this particular point really when rightly understood means practically what I have said; that is, that, although you could hold up to a certain extent, you could not hold up efficiently or practically. The conclusion I have come to is that for the purposes of the Plaintiffs' Patent, the double-action machine such as the Defendants have put on the market cannot be regarded as identical, or identical in substance, with the single-action machine of the Plaintiffs; or as an addition of two such machines, or as an addition to one such machine, but is for the purposes of this invention to be regarded as substantially different, and I think that the Defendants' machine on the whole is to be taken as not a mere adaptation, without invention, of the Plaintiffs' Patent to anything that can possibly be treated as substantially the same machine as that referred to in the Plaintiffs' Specification, and intended to be covered by the Patent. On those grounds I think that the appeal ought to be allowed.

COZENS-HARDY, *L.J.*—I agree, and have nothing to add.

Moulton, K.C.—I ask for a certificate that the Particulars of Objections that were referred to were reasonable and proper.

VAUGHAN WILLIAMS, *L.J.*—I do not think the Defendants ought to be allowed Objections which are based on the invalidity of the Patent, because they have not won on that. They have won on non-infringement, and they ought to be strictly limited to non-infringement.

ROMER, *L.J.*—The Defendants will get the general costs of the action and the costs of the issue of infringement.

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IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE BUCKLEY.

April 23rd, May 7th, and June 4th, 1904.

IN RE TAYLOR'S AGREEMENT TRUSTS.

- 5 *Patent.—Sale by Company.—Dissolution of Company without assignment.—Petition for Vesting Order dismissed.—Trustee Act, 1893, sections 25 and 35.—Patents, &c. Act, 1883, sections 87 and 90.*

- A Limited Company, the registered proprietor of a Patent, went into voluntary liquidation, and the liquidators contracted to sell the Patent. The final meeting*
 10 *of the Company was held and the requisite return was made by the liquidators to the Registrar of Joint Stock Companies, and by virtue of section 143 of the Companies Act, 1862, the Company was dissolved on the expiration of three months from the return. The purchase money under the contract was previously paid, but no assignment of the Patent was made to the purchaser.*
 15 *The purchaser presented a Petition under the Trustee Act, 1893, asking for a Vesting Order; the Petition was also entitled as being under the Patents, &c. Act, 1883. It was contended for the Petitioner that the Company had become a trustee for him, and that in view of its dissolution the trustee could not be*
 20 *found within the meaning of section 35 of the Trustee Act, 1893. By the direction of the Court the Petition was served on the Crown, and Counsel for the Crown was willing to consent to a Vesting Order.*

- Held, that the case did not fall within the provisions of the Trustee Act, 1893; that the legal estate had vested in the Crown, and that the Crown was not bound by a trust, and was not bound by the Trustee Act; that, even if there*
 25 *were consent on behalf of the Crown, there was no jurisdiction under the Act to make a vesting Order under the circumstances. The Petition was ordered to stand over to allow the Petitioner to apply at the Patent Office to have his name entered on the Register as proprietor of the Patent; this was done under the direction of the Board of Trade, and the Petition was dismissed.*

- 30 *Query, whether the Patent had merged.*

- 35 *In re Accident Assurance Corporation Ltd. (L.R. (1904) 1 Ch. 147) not followed.*

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The *Niger Patent Elastic Enamel Company Ltd.*, who were the registered proprietors of certain Letters Patent, on the 28th of August 1903 passed a resolution for winding up and appointing liquidators. On the 16th of September 1903 the liquidators entered into an Agreement to sell the Patent. After the requirements of section 142 of the Companies Act, 1862, had been complied with, the liquidators on the 24th of November 1903 made a return to the Registrar of Joint Stock Companies in compliance with section 143 of that Act, and by virtue of that section the Company was at the expiration of three months from the date of the registration of such return "deemed to be dissolved." The purchase money had been paid, but no assignment of the Patent had been made to the purchaser. The purchaser presented a Petition under sections 35 and 36 of the Trustee Act, 1893, and section 90 of the Patents, &c. Act, 1883, asking for an Order vesting the Patent in the Petitioner for all the estate of the Company therein and for rectification of the Register.

Walter (instructed by A. M. Longhurst, agent for Mackay, Taylor, and Goffey, of Liverpool) appeared for the Petitioner.

Walter for the Petitioner.—This is a case which is within section 35 of the Trustee Act, 1893, for the trustee cannot be found. Mr. Justice Farwell decided, in *Re General Accident Assurance Corporation Ltd.* (L.R. (1904) 1 Ch. 147), that a case such as this was covered by the section. [BUCKLEY, J.—There must be an existing person who cannot be found. Here there is no existing person. How can you say a person cannot be found when there is no such person?] There is the authority of Mr. Justice Farwell. That case was under the same section—section 35 of the Act—under precisely similar circumstances. [BUCKLEY, J.—I feel myself unable to follow that decision. You must proceed under the Act. You must restore the Company to the Register, and then you will have a trustee.] It cannot be done. There is no other way of getting the legal interest. In the case before Mr. Justice Farwell, the parties tried to see whether the Crown would transfer the legal estate, and the Crown declined. [BUCKLEY, J.—You cannot restore the Company. It has not been struck off the Register. It is not within the Companies Act, 1880. It is a dissolution case.] A dissolution case under the Act of 1862. It might come within the words "When it is uncertain whether a trustee entitled alone, or jointly . . . is alive, or is dead." The ground on which it was put in the case before Mr. Justice Farwell, was this: It was a question whether or not the property vested in the Crown. The purchasing Company in that case being desirous of getting in the legal estate, applied to the Crown, and inquired whether it would execute an assignment. If we cannot find where the legal estate is, is not that within the purview of the Act? The trustee cannot be found. In the case before Mr. Justice Farwell the Petitioners were informed that the Crown were not able to admit that the legal estate in question was in the Crown. [*Re Higginson & Dean* (L.R. (1899) 1 Q.B. 325), and *Pryce-Jones v. Williams* (L.R. (1902) 2 Ch. 517) were also referred to.]

BUCKLEY, J.—Those are cases as to *bona vacantia* simply. I do not see that I can do any better for you than let this Petition stand over, and let you serve the Crown. You will have to satisfy me that the Crown is a trustee. If you satisfied me of that, and the Crown were here, then I should see my way. I very much regret that I do not feel myself able to follow the decision of Mr. Justice Farwell in the case of the *General Accident Assurance Corporation Ltd.* It seems to me that in order to be able to say that a trustee cannot be found you must be able to predicate that there is a trustee, but you do not know where he is, and cannot find him. The facts here are that the trustee is a Corporation which has been dissolved and does not exist. It is not a question of finding a trustee. There is no trustee unless it be the trustee in whom the legal estate is vested by reason of the dissolution of the Corporation. It may be that that is the Crown. I will let the Petition stand over, and, if the Petitioners can bring here a person who they satisfy me is trustee, I shall then see my way to get on.

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On the 7th of May 1904 the Petition came on again, when *R. J. Parker* (instructed by the *Solicitor to the Treasury*) appeared for the Crown.

Walter for the Petitioner.—It has been suggested whether there is not power to have my title entered on the Register at the Patent Office as it stands; but we have inquired, and the Office declines—and I think rightly so—because all they could put on the Register would be an equitable interest, and under one of the sections of the Patent Act no trusts or anything of that kind are to be registered, and it would appear on the Register that I have not the legal estate.

BUCKLEY, J.—What do you say for the Crown, Mr. *Parker*? I suppose the legal estate is in the Crown? But I cannot make a Vesting Order against the Crown.

Parker.—Your Lordship cannot make a Vesting Order against the Crown, if the Crown is entitled. The Crown always gives effect to trusts, but, technically speaking, trusts cannot be enforced against it. That being the case, I should have thought there was no jurisdiction to do anything on this Petition as against the Crown.

BUCKLEY, J.—I have been looking at the Act again and the words are “cannot be found.” I remain of the same opinion as before. I can appoint a new trustee where there is an existing trustee, but the legal estate is in the Crown.

Walter.—Would your Lordship look at the 25th section of the Trustee Act, 1893? “The High Court may, whenever it is expedient to appoint a new trustee or new trustees, and it is found inexpedient, difficult, or impracticable to do so without the assistance of the Court, make an Order for the appointment of a new trustee or new trustees, either in substitution for or in addition to any existing trustee or trustees, or although there is no existing trustee.”

BUCKLEY, J.—You cannot say there is an existing trustee here. The trustee has vanished, but the legal estate is I suppose vested in the Crown? You cannot say that the Crown is trustee in one sense, but you must say it in another because, if the legal estate is in the Crown, the Crown is, although it declines to be, your trustee.

Parker.—My friend says he has made an application to the Patent Office to have the Petitioner put on the Register, and I should have thought that was the way. I have had a similar question in the case of a Trade Mark where a Corporation had sold all their Trade Marks and goodwill, and no assignment had actually taken place.

BUCKLEY, J.—It has also occurred to me—I do not know whether it is right or not—that directly the legal estate in a Patent vests in the Crown as *bona vacantia* the Crown cannot be a Patentee under its own grant, and therefore there is no Patent at all, but it has merged.

Parker.—I did not like to suggest that.

BUCKLEY, J.—I was about to suggest whether it would not be possible to make a re-grant.

Walter.—The Petition is entitled not only in the Trustee Act, but in the Patent Act. I do not know whether my friend is instructed to appear on behalf of the Comptroller. Under section 90 of the Patents, &c. Act, 1883, I am a person aggrieved.

BUCKLEY, J.—I doubt whether section 90 has taken effect yet, because it is not a case where you have applied to the Comptroller to register a devolution of interest in a Patent and he has refused. He has done nothing of the sort, because there is no devolution of interest which he can register. The Petitioner is not a person who becomes entitled by assignment, transmission, or operation of law to a Patent.

Parker.—That difficulty has been got over in the case of Trade Marks by entering the equitable owner as the proprietor of the Trade Mark.

BUCKLEY, J.—Is the Comptroller prepared to do that?

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Parker.—I cannot say. I am not acting for the Comptroller. I am instructed by a different Department.

BUCKLEY, *J.*—If the Comptroller will do it, of course that will get over the difficulty.

Parker.—If it cannot be done in that way, I confess I do not see what can be done. If your Lordship saw your way to express on the Order, "the Attorney-General not objecting to the making of a Vesting Order," I think I might suggest that on behalf of the Crown.

BUCKLEY, *J.*—Can I with the consent of the Crown make a Vesting Order against the Crown? Surely the Act, not mentioning the Crown, does not apply to the Crown at all. I cannot have a jurisdiction by consent without an Act of Parliament. I must take it that the Crown is excepted from the Act, and the Crown cannot consent to be within the Act so as to give me jurisdiction here.

Parker.—If your Lordship saw your way to declare the Petitioner's equitable title, so that he would have something to show at the Patent Office, that would help him.

Walter.—Your Lordship does not think under the 25th section you can make a Vesting Order?

BUCKLEY, *J.*—It seems to me that there are many fatal difficulties. In the first place I agree that the dissolution of the Corporation called into action these words, "that there is no existing trustee", but for this fact that the dissolution of the Corporation caused the Patent to vest in the Crown. Then the Crown would be the trustee but for the fact that the Crown cannot be a trustee for anybody. Then there is the further difficulty that directly it vested in the Crown, as far as I can see at present, it ceased to be a Patent, because the Crown could not hold under itself.

Walter.—Your Lordship does not think that even with the assent your Lordship can make a Vesting Order?

BUCKLEY, *J.*—I do not see how it is possible. I cannot enlarge the Act of Parliament because the Crown is minded not to rely upon the fact that the Act does not bind it.

Parker.—My Lord, supposing the Petition stands over, and my friend renews his application to the Patent Office and sees what can be done?

BUCKLEY, *J.*—In this case a Limited Company agreed to sell a Patent to the Petitioner, and the purchase money was paid. The result was that the Petitioner has a good equitable title to the Patent. No assignment was executed by the Corporation, and the Corporation went into liquidation, and the necessary proceedings took place and the Corporation was dissolved. In that state of facts a Petition is presented to the Court, not asking for the appointment of a new trustee, but simply asking for a vesting Order. The jurisdiction to make a vesting Order arises under section 35 of the Act, and the words relied upon are those in section 35 (c), that a trustee "cannot be found." The context in which those words occur is this: "Where a trustee (a) is an infant, or (b) is out of the "jurisdiction of the Court, or (c) cannot be found." To my mind the words "cannot be found" in that context mean that the trustee is somewhere, but you do not know where he is. If you knew where to look you would be able to find him. He is an existing person, but you do not know where he is. I regret very much that I find myself unable to concur in the decision on that point at which I understand my Brother *Farwell* arrived in *Re The General Accident Assurance Corporation Ltd.* (L.R. (1904) 1 Chancery 147). He is there reported to have said that a case exactly like the present fell within the purview of the sections. I agree with that if it means this; that if the Legislature, when they were passing the Trustee Act, had thought of this case no doubt they would have provided for it; but I do not agree with it in the sense that the case is provided for by the Act of Parliament. It seems to me perfectly plain, reading the Act of Parliament, that the case is not provided for. The fact, therefore, that this limited Company which was

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trustee has disappeared altogether does not, in my opinion, satisfy the words that it "cannot be found." Further, when the Company became dissolved, the legal estate in the Patent, I think, unquestionably vested in the Crown. In other words, it is not a fact that I cannot find the trustee. I know
5 exactly where he is, and if I can speak of him as a trustee it is the Crown. That is where the legal estate is.

But there is this further difficulty, that although the legal estate is so vested in the Crown that it would be a trustee if it could be, the Crown cannot be a trustee. Although it does in general give effect to trusts, the Crown is not
10 bound by a trust, and in that sense is not a trustee.

Then this occurred to me: If the matter could be cured by any amendment of this Petition I would gladly give leave to amend. I thought it might be possible to amend the petition by asking for the appointment of a new trustee, and thereupon making a vesting Order. That turns on section 25 of the Act of
15 Parliament which enables me to appoint a new trustee, although there is no existing trustee. Now, in a sense, those words are satisfied; that is to say, the Corporation has disappeared—is not existing—and the Crown, in whom the legal estate is, is not in a strict legal sense a trustee at all. The Crown is existing but is not a Trustee, so that I may say, in a sense, that here is no
20 existing trustee. I do not say it is so, because, of course, the Crown might be a trustee if it was minded to become one—it might consent; but supposing that was satisfied could I then appoint a new trustee, and make a Vesting Order as against the Crown? Plainly not. The Crown is not bound by the Act of Parliament.

Then Mr. *Parker* suggests, to get over the difficulty which everybody desires to get over if they can, that it is possible the Attorney-General might consent to my making a Vesting Order, and waive the right of the Crown. Could I do it then? It seems to me I could not. It would only be that the Crown could
25 say, although the Crown is not bound by this Act of Parliament, it will not raise the point that it is not bound. Does that give me jurisdiction? Certainly not. I cannot enlarge the Act of Parliament. My powers remain where they were. If the Crown were minded to deal with the matter by assignment or in some other way, well and good, but I cannot make a Vesting Order.

There is this further difficulty, which seems to me formidable. The
35 legal estate vested in the Crown; but the Crown cannot be a grantee from itself. Then where is the Patent? That goes to the existence of the subject-matter upon which I am asked to make a Vesting Order.

On all these grounds it seems to me it is impossible on this Petition to assist the Petitioner, although I should wish to do so if I could in any way, to arrive
40 at that which he wants, unless this course be possible—and it is said that it is possible. It is perfectly obvious what the Applicant's rights are. He is entitled to a Patent unless the Crown is going to set up some claim of merger on the principles I have stated. If the Crown does not set up that it may be possible for the Comptroller to exercise his jurisdiction over the Register by
45 entering the Applicant's name as the owner of this Patent. If he will do so, if any technical impediments in the way are removed, that will solve the difficulty; but that is for the Comptroller and not for me. In that view I will not dismiss the Petition now, although I confess I do not see my way to make any Order on it; but if it is asked I will let it stand over to see if anything can be
50 done to get over the difficulty.

On the 4th of June 1904 the Petition was dismissed, it being stated that the Board of Trade had directed the Comptroller to register the Petitioner as proprietor of the Patent.

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IN THE HIGH COURT OF JUSTICE.—KING'S BENCH DIVISION.

Before THE LORD CHIEF JUSTICE and MR. JUSTICE KENNEDY.

July 7th, 1904.

BOW v. HART.

Trade Mark.—Action for infringement in County Court.—Validity of Trade Mark put in issue by Defendant.—Jurisdiction of County Court.—“Franchise.”—No Order made.—Appeal by Plaintiff.—County Court held to have jurisdiction.—Appeal allowed.—County Courts Act 1888, sections 56 and 126.—Patents &c. Act 1888, section 18.

The registered proprietor of a Trade Mark, having brought an action for 10 infringement in a County Court, the Defendant gave notice that he disputed the validity of the Trade Mark and intended to apply to the High Court to have the Trade Mark expunged from the Register. At the hearing it was contended for the Defendant that the County Court had no jurisdiction on the grounds, first, that the Trade Mark was a “franchise” within the meaning of section 56 of 15 the County Courts Act 1888; and, secondly, that the machinery of Trade Mark litigation was inconsistent with the existence of jurisdiction in the County Court. The Judge, having regard to there being no jurisdiction in the County Court to try the issue of validity, made no Order. The Plaintiff appealed.

Held, that a Trade Mark is not a “franchise,” and that the County Court 20 had jurisdiction to try the action, but that, if an application were made by the Defendant under section 126 of the County Courts Act 1888 to remove the action to the High Court, effect ought to be given to it. The Appeal was allowed, the costs to abide the result of the action. Leave to appeal was given.

This was an Appeal from a decision of the Judge of the Rochester County 25 Court. The action was brought for infringement of a registered Trade Mark of which the Plaintiff was proprietor, and claimed an injunction restraining infringement, and an account of profits or damages. The Defendant gave notice that he would object to the jurisdiction of the Court to try the action, and that he intended to dispute the validity of the Trade Mark and to apply to 30 the High Court to have it expunged from the Register. When the action came on, the Defendant objected to the jurisdiction on the grounds that the Trade Mark was a “franchise” within the meaning of section 56 of the County Courts Act 1888, and that the provisions of the Patents &c. Acts as to Trade Mark actions showed that it was not intended that County Courts should have 35

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jurisdiction to try them. The County Court Judge was of opinion that a Trade Mark was not a "franchise," but, in view of the Defence, which raised an issue which the Court had no jurisdiction to try, he made no Order in the action. The Plaintiff appealed.

- 5 A. H. Spokes (instructed by *Carter and Bell*) appeared for the Appellant; A. Beddall (instructed by *Churchman and Winsor*) appeared for the Respondent.

Spokes for the Appellant.—Under section 56 of the County Courts Act, 1888, the County Court Judge had jurisdiction, for a Trade Mark is not a "franchise" within the proviso to that section. *R. v. County Court Judge of Halifax*, 8 R.P.C. 338; L.R. (1891) 2 Q.B. 263 does not apply. There it was decided that a Patent is a "franchise," but the right conferred by registration of a Trade Mark is a right of property and is statutory. Section 18 of the Patents, Designs, and Trade Marks Act, 1888, is limited to the High Court, and "the Court" in section 90 of the Patents, Designs, and Trade Marks Act, 1883, means that Court (*see* section 117); but the Plaintiff has the option under section 18 of applying for the certificate or not, and section 90 only applies to proceedings for rectification.

Beddall for the Respondent.—A Trade Mark is a "franchise" within the meaning of section 56 of the County Courts Act 1888, and therefore the County Court Judge had no jurisdiction to entertain the action (*R. v. County Court Judge of Halifax*). "The Court" in the Patents, Designs, and Trade Marks Acts means the High Court (*see* section 117 of the Patents &c. Act 1883). Section 26 of the Patents &c. Act 1888 shows that, but for that section, the Legislature thought there would be no jurisdiction in the Court of Chancery of the County Palatine of Lancaster with regard to a Trade Mark. A Trade Mark is a monopoly (*see* sections 75 and 76 of the Patents &c. Act 1883). It was a "franchise" before the statutory provisions relating to Trade Marks; a Trade Mark was property in the sense that the owner of it could stop another person passing off goods marked with it as his own. When the registration of Trade Marks was introduced the registered owner became entitled to the exclusive use of it, whether it had been used before registration or not. In principle there is no difference between a Trade Mark and Letters Patent, except that the former is granted by the Legislature and the latter by the Crown. As in the case of a Patent, the procedure in Trade Mark actions enjoined by the Acts is inconsistent with the existence of any jurisdiction in the County Courts.

Spokes in reply.—A Trade Mark is not a "franchise." The County Courts Act 1888 was passed upon the 13th of August, and the Patents, Designs, and Trade Marks Act 1888 upon the 24th of December of that year. It could not have been intended to take away by the latter Statute a jurisdiction which had existed under the former Statute for only five months. [Section 126 of the County Courts Act, 1888, was also referred to.]

Lord ALVERSTONE, *L.C.J.*—The point raised in this case is one of very considerable importance, and, to my mind, of very considerable difficulty; and I should be extremely glad if the opinion, that I intend to express that the County Court has jurisdiction, should be reviewed in the Court of Appeal. I think that, in strictness, the learned County Court Judge has not put the case in a way in which we can really ascertain whether he meant to say he had no jurisdiction or not. He says in terms that the *Queen v. County Court Judge of Halifax* does not apply, in which view I think he is right, but he points out that section 18 of the Patent Act of 1888 is very analogous to section 31 of the Patent Act of 1883, in which respect he is also right. Then he simply says that he makes no Order, because of the defence raised by the Defendants impugning the Trade Mark.

It is now well recognised that if a Statute with regard to an inferior Court apparently gives jurisdiction, wide effect is to be given to that. It will be remembered that the question arose in the Admiralty Court cases,

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in which it was pointed out that the maxim, *Boni judicis est ampliare jurisdictionem*, certainly applies at the present time. Section 56 of the County Courts Act 1888 says:—"All personal actions where the debt, demand, or damage claimed is not more than 50*l.*, whether on balance of account or otherwise, may be commenced in the Court, and all such actions shall be heard and determined in a summary way according to the provisions of this Act; provided always that, except as in this Act provided, the Court shall not have cognizance of any action of ejectment, or in which the title to any corporeal or incorporeal hereditaments, or to any toll, fair, market, or franchise shall be in question."

This claim was brought in respect of an alleged infringement of a registered Trade Mark, and in the Defence the Defendant said he was going to contest the validity of the Plaintiff's Trade Mark, and apply to the High Court to have the same expunged. The first question which arises is—Has the County Court jurisdiction? I asked for any assistance that could be given by the learned Counsel as to whether the right to a Trade Mark is within the word "franchise." I have never heard it contended that a Trade Mark is a "franchise"; and looking at the grounds of the decision in the *Halifax* case, so far as it rested on "franchise," I should have thought that the reasons given by Baron Pollock, and concurred in by Sir Arthur Charles, would not have included Trade Marks in "franchise." Really the recognised view now, in my opinion, is that Trade Mark was originally based upon property—on the right of persons to have their trade name or mark protected and regulated by Statute, and that it is not based upon any question of grant from the Crown, or anything analogous to "franchise." Therefore it seems to me that, under the word "franchise," the jurisdiction of the County Court is not excluded.

A point which has given me very considerable anxiety, and in respect of which I am not satisfied that I am right, is the second ground upon which it was held that an action for infringement of a Patent could not be brought in a County Court. There was a very clear case with regard to Patents upon that second ground. There is the machinery for Particulars of Breaches being given with the Statement of Claim; there is the procedure for Particulars of Objections being given with the Statement of Defence; and, as Lord Justice Lopes pointed out, the whole machinery of Patent litigation is inconsistent with the view that such an action could be brought in the County Court. That is independent entirely of the question also on which some of the Judges took the view that a Patent was a "franchise," and therefore was within the prohibition of the County Court section. The section that has given me difficulty is one which my Brother KENNEDY has more than once referred to in the course of these proceedings, namely, section 18 of the Patents &c. Act of 1888, which is to be read with the Act of 1883: "In an action for infringement of a registered Trade Mark, the Court or a Judge may certify that the right to the exclusive use of the Trade Mark came in question, and, if the Court or Judge so certifies, then in any subsequent action for infringement the Plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs." That section is in terms the same as section 31 of the Act of 1883, which relates to actions for infringement of Patents, and that, no doubt, was one of the sections referred to by Lord Justice Lopes when he referred to the special machinery with regard to legal proceedings. I have had some doubt as to whether or not that is not almost enough to show that the special machinery for dealing with questions of infringement of Trade Mark might, to a certain extent, bring in the second ground on which it was thought that the County Court had no jurisdiction; but, on the whole, I do not think it is strong enough.

I do not give much weight to the point that Mr. Spokes urged, that the Plaintiff could waive the right under that section, or not ask for it, because that would be a way of giving jurisdiction by consent.

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But there is this serious question—that there might be a decision in the County Court with reference to a Trade Mark, and a different decision in some proceeding taken to expunge in the High Court; and there is, of course, the difficulty that section 90, which is the expunging section, clearly only
 5 applies to the High Court, and Mr. *Spokes* does not contend that the County Court has any jurisdiction under that section to expunge, nor does he contend that the County Court can give the Certificate to which I have referred under section 18 of the Patents &c. Act 1888. But thinking, as I do, that section 56 of the County Courts Act 1888 does not exclude an action for infringement of Trade
 10 Mark, and that the arguments in the *Queen v. Halifax* do not apply in the case of a Trade Mark except to the limited extent to which I have referred, and that there is power in the High Court to remove out of the County Court a case in which such a defence is raised—and I may say that I am clearly of opinion that, if a Defendant really meant to raise that kind of defence, and went to
 15 the High Court under section 126, the Judge ought most certainly to order the action to be removed on the ground that effect can only be given to the defence raised by the Judge who has the power of expunging—on the whole, I come to the conclusion that the County Court Judge had jurisdiction and ought to have entertained this case; but if any application is made by the
 20 Defendant to remove it into the High Court on the ground that the defence he wishes to raise cannot be raised in the County Court, I think certainly effect ought to be given to that.

It is a case of great importance, and of course, if the Defendant wishes to carry it further, he is certainly entitled to have leave to appeal. For the
 25 reasons I have given, I think that in this case the County Court Judge had jurisdiction.

KENNEDY, J.—I am of the same opinion. This, in my judgment, is not a case of a “franchise” at all. Not being a case of a “franchise,” it is *prima facie* a case in which the County Court Judge had jurisdiction, and the Plaintiff had
 30 a right to require the County Court Judge to hear and determine the action; but the Defendant said, “I mean to raise the question as to the validity of this “Trade Mark. I cannot get what I want under any Order the Court may make, “and therefore I suggest to the Court that there is no jurisdiction; that it must be “intended that the jurisdiction with regard to Trade Marks was jurisdiction
 35 “which, so far as it is litigious, must be exercised in the High Court of Justice.” I think we must leave it to another tribunal to say that it is, because there is *prima facie*, under the legislation which regulates the jurisdiction of the County Courts, jurisdiction to hear all but certain excepted cases, and this is not in its nature one of those excepted cases. I see the difficulty, which is
 40 obvious of working out a defence, such as is suggested here, under the County Court procedure. I agree entirely with what my Lord has better expressed as regards the duty, which lies upon us where there is express statutory jurisdiction as to the class of case, not, except upon compulsion of common sense or of reason, to take away that jurisdiction in a given case, because one may
 45 think that, if it had been brought to the notice of the Legislature, there might have been provision in the later Act to confine the jurisdiction in terms, in all cases, to the High Court of Justice. I see the difficulty of a conflict of jurisdiction which might arise if a County Court Judge gave judgment in a case in favour of the Trade Mark, and then subsequently the procedure, which
 50 must be taken in the High Court, is taken by the other party to expunge the registration. I can quite see that a difficulty might arise in that particular case; but it is always in the power of the Defendant to apply under section 126 of the 51st and 52nd Victoria, chapter 43, to remove the case by certiorari to the High Court; and most assuredly, looking at the fact that the Defendant can
 55 only get that relief which the law has given him under the Patent Act in the High Court, and that it would be a sufficient defence and perfectly relevant to the Plaintiff’s claim on the face of it, I do not think any Court or Judge, or on

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appeal any Divisional Court, could refuse a certiorari under those circumstances, in the absence of some very special grounds. I think that that is sufficient to reconcile the existence of a County Court jurisdiction with the special provisions of the legislation with regard to the registration of Trade Marks. 5

The costs were ordered to abide the result of the action, and leave to appeal was given to the Defendant.

IN THE HIGH COURT OF JUSTICE.—KING'S BENCH DIVISION.

WARWICKSHIRE ASSIZES (BIRMINGHAM DIVISION).

Before LORD ALVERSTONE, L.C.J.

10

August 9th, 1904.

COUNTY CHEMICAL COMPANY LD. *v.* H. FRANKENBURG.

Action for passing off.—“Get-up.”—Cycle repair outfits in tin boxes.—Intention to deceive.—Injunction granted.—Order for delivery up refused on account of Plaintiffs’ delay in taking action. 15

The Plaintiffs in January 1902 commenced to make and sell materials for the repair of pneumatic tyres packed in tin boxes of a certain colour, shape, and design. They claimed that, until the wrongful acts of the Defendant, such boxes were used exclusively by them. In 1903 the Defendant sold inferior materials for the same purpose in boxes closely resembling those of the Plaintiffs. 20

Held—(1) that there was an intention to imitate; (2) that intention to deceive might be inferred from the circumstances of the case although no case of actual deception was proved; (3) that the Defendant’s boxes were calculated to deceive. An injunction was granted; but no Order was made for the delivery up of boxes which offended against the injunction because the Plaintiffs had neglected to take action for six months after they became aware of the imitation.

The Plaintiffs in this action, the County Chemical Company Ltd. were manufacturing chemists and makers of cycle accessories. In January 1902 30

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they commenced to offer for sale materials, of their own manufacture, for the repair of pneumatic tyres. These materials were put up in oblong tin boxes coloured green. Printed or impressed upon the lids of these boxes were labels which had been specially designed for the Plaintiffs. The boxes thus labelled
 5 were manufactured for the Plaintiffs in Germany by Messrs. *Saupe and Busch*, of Radebent, Dresden. The label occupied nearly the whole of the lid of the box, and consisted of a background of gold slightly ornamented with green lines and dots, and bearing in white letters the words, "The 'Chemico' Repair Outfit. Complete with the best materials for the repair of Pneumatic Tyres."



- 10 The words "Repair Outfit" were printed on a narrow band of green extending across the label. Below this inscription appeared, in green letters on a white ground at the bottom of the label, the name of the makers, "*The County Chemical Company, Ltd., Excelsior Works, Birmingham.*" The boxes, when sold wholesale, were made up into packets secured by a wrapper bearing a
 15 label similar to the labels on the boxes.

The Defendant, *H. Frankenburg*, was a dealer in cycles and cycle accessories. In October 1902 he was managing director of *Frankenburg Ltd.* and on behalf of that Company wrote to *Saupe and Busch* for samples of tin boxes to contain cycle repair outfits. He received in consequence several boxes, and among
 20 them was one of the Plaintiffs'. The Defendant then ordered a large quantity of boxes, stating that they were to be "exactly like" the Plaintiffs' "in colour and "style of printing," but instead of "Chemico" the word "Triumph" was to be



used, and in place of "*The County Chemical Company, Ltd., Excelsior Works, Birmingham.*" *Saupe and Busch* were to print "price 6d. or 1s." (according
 25 to the size of the box), "manufactured in Birmingham." The Defendant also

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required the manufacturers to send him a proof before completing the order. These boxes, when supplied, were filled for the Defendant by a Birmingham firm with the necessary materials, the quality of which was admitted to be inferior to that of the Plaintiffs.

In July 1903, there being a decrease in the business done by them in these repair outfits, the Plaintiffs made inquiries and ascertained that *Frankenburg Ltd.* were selling similarly "got up" outfits at a less price per dozen than the Plaintiffs. As *Frankenburg Ltd.* were then in liquidation no steps were taken to restrain the sale of these rival outfits. The Plaintiffs, however, pending the expected cessation of business by *Frankenburg Ltd.* placed their materials in a box of a new design and of a bluish colour—known as the Wedgwood box. In November 1903 the Defendant purchased the business of *Frankenburg Ltd.* and continued the sale of the green boxes. Thereupon the Plaintiffs complained, and on January the 19th 1904 commenced an action for an injunction to restrain the Defendant "from selling, offering for sale, or disposing of any materials for the repair of rubber tyres, not being manufactured for or by the Plaintiffs in wrappers or boxes coloured, shaped or labelled in any way so as to be calculated or intended to pass off, or to enable others to pass off, such materials for the repair of rubber tyres as and for the goods of, or as and for the goods manufactured by or for the Plaintiffs." They also claimed an Order "for the delivery up upon oath, or destruction of all documents, labels, boxes, wrappers or things in the possession or power of the Defendant or under his control, which offend against the said injunction," and consequential relief.

The action was tried before Lord ALVERSTONE, *L.C.J.* at the Birmingham Assizes on the 9th of August 1904.

Hugo Young, K.C., and *E. W. Cave* (instructed by *Jaques & Sons*, of Birmingham) appeared for the Plaintiffs; *C. F. Vachell* and *Maddocks* (instructed by *Cochrane*, of Birmingham) appeared for the Defendant.

Hugo Young, K.C., opened the Plaintiffs' case, and relied on the strong resemblance between the boxes as showing an intention to deceive. He handed up to the learned Judge a tray containing numbers of boxes of both kinds, and the learned Judge expressed himself unable to distinguish between them save upon a close examination.

The evidence was then taken. For the Plaintiffs the following witnesses were examined:—*Wilfrid Hill*, managing director of the Plaintiff Company; *G. W. S. Leeson*, senior traveller for the Plaintiff Company, and *C. A. Cave*, a general traveller in the same employment; and *Fred W. Pedley*, managing director of *Pedley & Son, Ltd.*, india-rubber merchants. No evidence was given of any case where the Defendant's outfit had been bought in mistake for the Plaintiffs'.

For the Defence the Defendant only was called. In cross-examination by *Young*, K.C., he at first denied having ordered a box "exactly like" the Plaintiffs', but on being shown his letter to *Saupe and Busch* he admitted that he had done so, but added that in his view, owing to the alterations in words that he had ordered, the distinction between the two boxes was sufficiently marked, and would prevent any purchaser from being misled.

Maddocks for the Defendant contended that the Plaintiffs had not shown that they had acquired by long user or reputation some title to the name "Chemico" or to the design the imitation of which was complained of (*Licensed Victuallers' Newspaper Company v. Bingham*, L.R. 38 Ch. D. 139). The evidence failed to show any intention to deceive the general public, for the sales effected by both parties were to retail dealers (*Singer Manufacturing Company v. Loog*, L.R. 8 App. Cas. 15; *Wotherspoon v. Currie*, L.R. 5 H.L. 508). Moreover the Plaintiffs had acquiesced in the user of the "Triumph" box for six months, and had thereby lost any right to maintain this action (*Isaacson v. Thompson*, 41 L.J. Ch. 101).

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Lord ALVERSTONE, *L.C.J.*—I should like to hear you, Mr. *Young*, on the question of laches.

Hugo Young, K.C., submitted that the Plaintiffs' conduct had been reasonable having regard to the fact that *Frankenburg Ltd.* was in liquidation when the Plaintiffs discovered the user of their box. When the Plaintiffs ascertained that the Defendant had acquired the business of *Frankenburg Ltd.* they took action within a reasonable time, and therefore they were entitled to all the relief claimed.

Lord ALVERSTONE, *L.C.J.*—These cases always depend upon the particular facts of each case. There are cases where the intention to imitate, if I may use that expression, is proved by an inference drawn or by proof that persons have bought the one article in mistake for the other, but if the Court has evidence before it from which it can come to the conclusion that that intention is supplied by other means I do not think it is necessary for a Plaintiff to prove deception in fact; the more so when we are dealing with wholesale dealers, because, as was pointed out in the case of *Singer v. Loog*, you have to consider what may happen to the goods when they get into the hands of retail dealers. That is the reason why I pointed out to Mr. *Maddocks*, when he was arguing the case, that the putting on of these labels would not be sufficient to entitle the Plaintiffs to relief, because the label may disappear when it gets into the hands of the retail dealers and different boxes might pass in the trade without any band on them at all. I have come to the conclusion that Mr. *Frankenburg* did intend to imitate, as nearly as he safely could, the label of the Plaintiffs. I told Mr. *Young* that I had no doubt about it; in fact I was only doubtful whether there was sufficient evidence of intention to pass off his goods as the goods of the Plaintiffs. It is admitted that when Mr. *Frankenburg* ordered these boxes in 1902 he knew the "Chemico" goods perfectly. They had been out for a year and had had a substantial success, 400 gross being sold in the first year. When Mr. *Frankenburg* wrote to Messrs. *Saupe and Busch*, who were making his boxes, there were a large number of alternatives open to him. He might have had gilt boxes; he might have had green boxes; he might have had green and gold boxes; and, as I have already indicated, provided he does not pass off his goods as the goods of others, there are many common things that he might use. I do not agree with Mr. *Maddocks* that the "Chemico" people could have complained of the "T. B. Repair Outfit" or the "Palmer Repair Outfit." On the view they are essentially different. The real question is—Is this selection of such similarity, as there is, a mere accident, or an innocent act done without any intention of passing off, or is it done in order to imitate the Plaintiffs' goods? Now, the Defendant had before him the "Chemico Repair Outfit" box; he knew of it in the trade, and he wrote back that the only alterations were to be that "Chemico" was to be changed to "Triumph" and the "County Chemico Ltd., Excelsior Works, Birmingham," taken off and "Manufactured in Birmingham" put on instead. I asked the Defendant why he did not send back fuller information as to the label, and the reason he gave was, in my opinion, a ridiculous one, and one which rather marks the transaction. He said he could not draw a label himself. It is perfectly plain, if he had gone round the next corner and paid an ordinary writer a few shillings for drawing him a label, he might have sent a complete pattern, and I come to the conclusion that he left those words on in the same type, in the same position, in order to get as nearly as he could to the Plaintiffs' goods. I wish distinctly to be understood that I quite recognise that "Repair Outfit" are common words; but I have to deal with "Repair Outfit" and the words underneath—"Complete with the best materials for the repair of "pneumatic tyres." The type is the same, the words are the same, the position is the same, and I have no doubt that in the hands of retail dealers these boxes would be readily mistaken for the Plaintiffs'. I therefore come to the conclusion that the Plaintiffs are entitled to an injunction.

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The only remaining question is—What is the measure of their relief? They are not, in my opinion, entitled to have an Order for the delivery up of the boxes and to have them destroyed. From July to December 1903 they slept on their rights. The first communication made was on the 26th of November and the first complaint made formally was on the 4th of December, when a letter was written by the solicitors. Immediately after that Mr. Frankenburg said he would not sell any more boxes pending the matter being settled, and he says he has not sold any. I do not think there is any case in which an Order to deliver up boxes, which can be used in other ways of course, has ever been made, where a Plaintiff has so acted with reference to his rights. With regard to damages, although I come to the conclusion that this would injure the Plaintiffs' trade, I think there is no proof before me of anything beyond nominal damages. I doubt very much indeed whether there is any substantial proof of damage at all. I do not rely at all on the Wedgwood coloured boxes beyond saying that the Plaintiffs obviously thought their trade could be partially protected by another box; they designed it at once and had a very large number of them ordered in order that they might, so to speak, protect themselves in the event of their not being able to protect the green box. While I think that it is extremely likely that the trade may have been affected, I have no evidence before me on which I can come to the conclusion that a substantial number of people bought this particular box in mistake for the Plaintiffs'. I therefore think there must be judgment for an injunction and 40s. damages, and costs.

Hugo Young, K.C.—The injunction will be to restrain the Defendant from selling the box in question or any colourable imitation of the Plaintiffs' box?

Lord ALVERSTONE, *L.C.J.*—Yes, the green box.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE JOYCE.

August 10th, 1904.

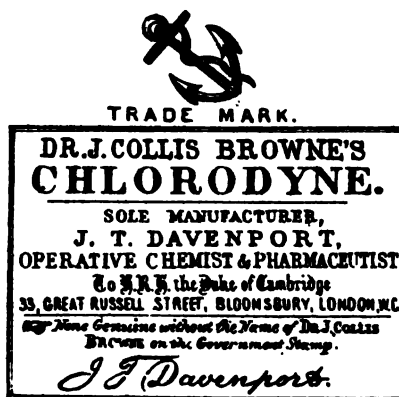
IN THE MATTER OF THE TRADE MARK OF J. T. DAVENPORT LD.

Trade Mark.—Motion for leave to alter Registered Trade Mark.—Name of proprietor.—Address.—Leave given.—Form of Order.—Practice.—Patents, &c. Act, 1883, section 92.

On the 4th of March 1876 the following Trade Mark was registered under No. 3411 for "Chlorodyne" in Class 3 by John Collis Browne and John

In the Matter of the Trade Mark of J. T. Davenport Ltd.

Thistlewood Davenport, trading as *J. T. Davenport* at 33, Great Russell Street, Bloomsbury. This Trade Mark ultimately became the property of *A. W. C. Browne* and *H. Davenport*, who in 1902 transferred it together with the business to *J. T. Davenport Ltd.* which Company was entered on the Register



- 5 of Trade Marks as proprietors thereof. The business having been transferred from 33 Great Russell Street, Bloomsbury, to 117 Union Street, Borough, S.E., the Limited Company gave notice of a Motion to rectify the Register of Trade Marks by altering the said Trade Mark No. 3411, and filed an affidavit by *Horace Davenport* in support, which set out the alterations desired to be made
- 10 as follows :—“1. By adding the word ‘Limited’ after the name ‘*J. T. Davenport*’ where the same first appears on the said Trade Mark, so that the name of the present proprietors may be correctly stated. (2) By substituting the words ‘Manufacturers,’ ‘Chemists,’ and ‘Pharmacutists’ for the words ‘Manu-’
- 15 “facturer,’ ‘Chemist,’ and ‘Pharmacist’ respectively. (3) By substituting the address 117 Union Street, Borough, London, S.E., which is the present address of the Applicants, for the address which now appears on the said Trade Mark, the same having ceased to be the address of the proprietors of the said Trade Mark. (4) By inserting the word ‘Late’ before the words ‘Duke of Cambridge’ so as to make the statement accurate. 5. By omitting
- 20 “the word ‘Government’ from the said Trade Mark. The reason for this last-mentioned alteration is that the Applicants’ preparation is now sold in various countries and colonies having Governments of their own, and the statement at present appearing on the said Trade Mark is capable of being understood to refer to the Government of such countries or colonies contrary
- 25 “to the fact.”

On the notice of the application being given to the Comptroller the Solicitor of the Board of Trade wrote and sent to the Solicitors of the Applicants a letter which was as follows :—“Referring to the pending application by Motion that the Register of Trade Marks may be rectified by altering the above-mentioned

30 “mark, I beg to inform you that, having had an opportunity of considering the draft of an affidavit in support of the Motion, I do not propose to put your clients to the expense of briefing Counsel to appear on behalf of the Comptroller if you will undertake to ask the Court to make an Order in the terms of the Order asked for by Mr. *Parker* in the case of *James Cockle &*

35 “*Co.*’s Trade Mark No. 61,743, reported in Vol. 20 of the Reports of Patent Cases page 353, a print of which is sent herewith. This undertaking will also bind you to supply me with draft Minutes of the Order and to give me

In the Matter of the Trade Mark of J. T. Davenport Ltd.

"due notice of all appointments before the Registrar to settle the same. In the event of your agreeing to this course, I shall be glad to receive the undertaking at your early convenience."

The Motion came on for hearing before Mr. Justice JOYCE on the 10th of August 1904.

Sebastian (instructed by *Dixon, Weld, and Dixons*) appeared for the Applicants, and stated the alterations which were desired to be made in the mark, and that they were the same as those above referred to except that in lieu of 117 Union Street, Borough, London, S.E., it was desired to have 117 Union Street, London, S.E., England, to which the Board of Trade agreed. He also stated that, as the matter had been arranged with the Board of Trade, the Comptroller did not appear by Counsel.

JOYCE, J., made the Order asked for, which when drawn up was, omitting formal parts, as follows:—"The Applicants by their Counsel undertaking to supply the Comptroller-General of Patents, Designs, and Trade Marks with a Block of the mark as altered, this Court doth Order that the Register of Trade Marks be rectified by altering the registration of the above-mentioned Trade Mark No. 3411 in the following respects—that is to say, by adding the word 'Limited' after the name '*J. T. Davenport*' where the same first appears on the said Trade Mark, and by substituting the words 'Manufacturers,' 'Chemists,' and 'Pharmaceutists' for the words 'Manufacturer,' 'Chemist,' and 'Pharmaceutist' respectively, and by substituting the address 117 Union Street, London, S.E., England, for the address which now appears on the said Trade Mark, and by inserting the word 'Late' before the words 'Duke of Cambridge' and omitting the word 'Government' therefrom, so that the said Trade Mark as altered may be as shown by the exhibit marked A 3 referred to in the said affidavit of *Horace Davenport*. And it is ordered, that due notice of this Order be given to the said Comptroller by serving a copy of this Order upon the said Comptroller or by leaving the same with a clerk at the office of the said Comptroller, and at the same time producing a duplicate of this Order duly passed and entered."

The Trade Mark as altered will be found on page 1223 of the Trade Marks Journal No. 1384.

African Gold Recovery Company, Ltd. v. Hay.

IN THE PRIVY COUNCIL.

Present: LORDS MACNAGHTEN, DAVEY, ROBERTSON, and LINDLEY.

June 2nd, 3rd, and 22nd, 1904.

AFRICAN GOLD RECOVERY COMPANY, LTD. v. HAY.

5 *Patent.*—*Action in High Court of the late South African Republic before annexation.*—*Order for cancellation of Patent.*—*Appeal to Supreme Court of Transvaal.*—*Jurisdiction to hear Appeal.*—*Appeal dismissed.*—*Appeal to Privy Council dismissed.*—*Transvaal Patent Act, No. 6 of 1887, sections 29, 30, and 31.*

10 *In 1896 judgment was given by the High Court of the late South African Republic in an action brought to obtain a declaration that a Patent granted by the Republic was null and void. The Order of the Court declared that the Patent was void, and that the Patent was therefore cancelled. In 1902 the owners of the Patent presented a Petition to the Supreme Court of the Transvaal asking that*
 15 *the judgment might be set aside, or that the record might be amended by striking out the Order for cancellation, and for liberty to apply for leave to amend the Specification, the owners of the Patent having applied for such leave prior to the said judgment. The Supreme Court decided that it had no jurisdiction to rehear the matter; that the Order for cancellation was right under sections 29*
 20 *to 31 of the Transvaal Patent Act, No. 6 of 1887; and that the application for leave to apply to amend the Specification could not now be considered. The owners of the Patent appealed.*

Held, by the Judicial Committee of the Privy Council, that the Supreme Court of the Transvaal had no jurisdiction to entertain an appeal from the
 25 *High Court of the South African Republic, and that the High Court had power to order the Patent to be cancelled. The appeal was dismissed with costs.*

In this Appeal the main question raised was whether an Appeal lies to the Supreme Court of the Transvaal from an Order made by the High Court of
 30 *the late South African Republic in 1896. A further question was also argued as to the effect of sections 29 to 31 of the Transvaal Patent Act, No. 6 of 1887, and the case is here reported on that point.*

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The following is a translation of the above-mentioned sections taken from the Appendix to the Appellants' case :—

Section 29. "The invalidation of Letters Patent may be made the subject of an application to the High Court on one or more of the following grounds :—
 "(a) That the Letters Patent have been fraudulently obtained to the prejudice 5
 "of another's rights; (b) that the person who was represented to be the first
 "and true inventor was not such; (c) that the invention was not new—that is
 "to say, that it was already published or used in this state before the granting
 "of the Letters Patent; (d) that the invention is not capable of being patented
 "in terms of Article 1; (e) that the Specification has reference to theoretical 10
 "principles, hypotheses, methods, systems, discoveries, or conceptions, the
 "manner of applying which is not given; (f) that the Complete Specification
 "is not sufficient—that is to say, that mention of a part of the secret has been
 "omitted or that it has been explained in an insufficient manner; (g) that the
 "invention or its application is contrary to law, public order, or morality; 15
 "(h) that the title of the invention fraudulently sets out another matter than
 "the true invention; (i) that the prescribed payments have not been made in
 "time; (k) that the Letters Patent have lapsed by virtue of Article 15 of
 "this law."

Section 30. "The invalidation of Letters Patent may be demanded only by 20
 "the following persons :—(a) The State Attorney; (b) every person expressly
 "authorised thereto by the State Attorney; (c) anyone who contends that the
 "Letters Patent have been obtained to the prejudice of his rights or the rights
 "of another person from whom he derives his rights; (d) anyone who contends
 "that he himself or another person from whom he derives his rights was the 25
 "true inventor of the invention in question; (e) anyone who contends that he
 "himself, his partner, or a person from whom he derives his rights, did
 "already, before the date of the Letters Patent, manufacture, use or sell
 "something that the Patentee claims as his invention."

Section 31. "With regard to a lawsuit respecting the invalidation of Letters 30
 "Patent the following provisions shall prevail :—1. The Plaintiff must set out
 "in his application the facts upon which he wishes to base his action. No
 "proof shall be allowed of facts not set out in this manner, except by permis-
 "sion of the Court. 2. The statement of facts may be subsequently amended
 "by permission of the Court. 3. The Defendant has the right to begin with 35
 "the proofs in support of his Letters Patent, and if the Plaintiff produces
 "proofs against the validity of the Letters Patent, the Defendant is allowed to
 "produce counter-proofs."

The facts and the contentions of the Appellants on the Patent question are sufficiently shown by the following quotations from the Appellants' case :— 40

"1. This is an Appeal from the Divisional Court consisting of His Honour
 "the Chief Justice, the Hon. Mr. Justice *Solomon*, and the Hon. Sir *W. J.*
Smith, of the Supreme Court of the Transvaal, upon certain points of law
 "arising upon the consideration of certain applications, more particularly
 "hereinafter referred to, made by the above-named Appellant and Respondent 45
 "respectively in a certain action originally brought by the Respondent against
 "the Appellant in the High Court of the late South African Republic, and now
 "depending in the Supreme Court of the Transvaal."

"2. The Appellant Company is an English Company, formed and incorpo-
 "rated under the Companies Acts 1862 to 1890, having its registered office at 50
 "31 Walbrook, in the City of London. The Respondent is a British subject
 "resident in Johannesburg, in the Transvaal Colony."

"3. The Appellant Company was . . . the owner by assignment of
 "two certain Patents granted by the Government of the late South African
 "Republic, which said Patents were numbered 47 and 74 respectively. The 55
 "said Patent No. 47 was issued in the month of September 1888 to *John*
Stewart MacArthur, *Robert Wardrop Forrest*, and *William Forrest*, in

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- "respect of certain improvements in obtaining gold and silver from ores and other compounds, for a term of 14 years from the 28th of November 1888. . . . Both the said Patents were granted subject to a condition for periodical renewal upon the payment of certain renewal fees, which fees were
- 5 "duly paid in advance to the late Government of the South African Republic for the complete periods for which the said Patents were granted, and subject to such matters as are hereinafter stated the said Patents were good and effectual at law and remained in full force and effect for the full periods for which they had so been granted. . . .
- 10 "4. On the 21st of August 1894 the above-named Respondent commenced an Action in the High Court of the late South African Republic for a declaration that the said Patent No. 47 had been obtained illegally and unlawfully, and that the said Patent was void, null, and of no value, and for the costs of the Action. . . . The precise terms of the prayer (or as it is called by
- 15 "writers on the Roman Dutch Law the 'conclusion'), to which it will become necessary hereinafter to refer, were these :—
- "Wherefore the Plaintiff prays that this Honourable Court shall declare
- "that the said Letters Patent No. 47 were obtained illegally and unlawfully
- "and that this Honourable Court shall declare that they are void and null
- 20 "and of no value and shall condemn the Defendant in the costs of this 'Action.'
- "By the provisions of the local Statute then in force it was necessary for the Plaintiff in such an Action to obtain authority from the Attorney-General (Staats Procureur) to proceed therein, and such authority the said Respondent
- 25 "duly obtained before commencing the Action. The section of the local Statute under which this authority was given is set out in the Appendix A to this case, and had in fact been borrowed from the Patents, Designs, and Trade Marks Act, 1883 (46 & 47 Vict., c. 57, section 26, subsection (4)). The section
- 30 "was introduced in the local Statute as in the Act of Parliament for the protection of Patentees against frivolous and vexatious attacks by mere volunteers having no substantial interest in the cancellation of their Patents, and the authority when given did not make the Attorney-General or the Government of the Republic in any sense a party to the authorised proceedings. In point
- 35 "of fact the Government of the Republic was never cited in the Action or made a party thereto, nor was it at any time represented at any of the proceedings therein had."
- After referring to the result of an appeal in an action brought in this country by the *Cassel Gold Extracting Company, Ltd.*, against the *Cyanide Gold Recovery Syndicate, Ltd.*, on the British Patent for the same invention (reported in 12 R.P.C. 232), and to an amendment of the claims of the Specification of the British Patent consequent on the decision of the Court of Appeal, the Appellants' case continued :—
- 40 "6. The Patent No. 47 being thus in substance identical with the said British Patent No. 14,174 of 1887, the Respondent as Plaintiff in this Action alleged by way of objection to the said Patent No. 47 the same anticipations which had been put forward by the Defendants in the above-mentioned action of the *Cassel Gold Extracting Company, Ltd.*, against the *Cyanide Gold Recovery Syndicate, Ltd.*, as objections to the mother Patent in this country, and there was no material difference between the issues raised in the
- 50 "last-mentioned and in the present Actions.
- "On the 24th of June 1895, and subsequently by application dated the 5th of July 1895, the Appellant having been advised as to the form above stated in which the Specification of the said British Patent had been settled for amendment, sought permission in this Action from the late High Court to
- 55 "apply at the Patent Office of the late South African Republic for leave to amend the Specification of the said Patent No. 47 by a disclaimer in the same form. Such permission was at the time refused, but leave was given to the

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" Appellant to renew the application for such permission at the trial of the
" Action.

" This Action came on for trial at Pretoria on the 17th of February 1896,
" before a full Bench of the High Court of the late Republic, consisting of
" Mr. Kotzé, the Chief Judge, and Messrs. Jorissen and Morice, Puisne Judges of 5
" the said High Court. At the commencement of the hearing, Counsel on
" behalf of the Appellant renewed the said application for permission to apply
" at the Patent Office for leave to amend the said Specification, but the Court
" postponed the consideration of such renewed application until after trial
" of the issues raised upon the unamended Specification. . . . Eventually 10
" on the 4th of November 1896 Judgment in the said Action was given in favour
" of the Plaintiff, but no decision was pronounced upon the Appellant's applica-
" tion for permission to apply for leave to amend, and that application has not
" been in any way disposed of down to the present time. . . .

" 8. The Judgment so delivered left matters in a position in which the Appel- 15
" lant was entirely powerless, for although the Action was only a proceeding *inter*
" *partes* its pendency made any amendment of the Specification impossible, save
" with the permission of the Court. Moreover, it was evident and had been
" fully admitted by the Appellant that without such amendment the Patent
" could not be sustained at all. There was no local tribunal to which an 20
" Appeal would lie from the said Judgment, and there was at that time no
" machinery for bringing an Appeal from the High Court of the Republic to
" the notice of His Majesty.

" 9. No proceedings of any sort were taken by the Respondent to obtain
" execution or otherwise to give effect to the said Judgment. An understanding 25
" was come to between the parties concerning the payment of costs, and the
" costs have been duly paid in accordance therewith. No other steps have been
" taken in consequence of the said Judgment. It has never been suggested that
" the said Patent ought to be, or could be, cancelled or destroyed, and the
" Appellant has not at any time been in any way molested in the quiet possession 30
" of the said Patent. The said Patent, duly sealed with the Great Seal of the
" late Republic, and executed by the President, has continued, and still is in
" the Appellant's possession.

" 10. On the 27th of March 1902 the Appellant presented a Petition to His
" Majesty the King, praying that His Majesty would be graciously pleased to 35
" prolong for a period of six years the term for which the said Patent No. 47
" was granted. The said term for which the said Patent had so been granted
" had at that time a period of eight months unexpired. The said Petition was
" transmitted by His Majesty's Secretary of State to His Excellency the High
" Commissioner and Administrator of the Transvaal, and ought, as the Appellant 40
" submits, under the provisions of the Proclamation No. 22 of 1902, section 31,
" subsection (2), to have been by His Excellency referred to the High Court of
" the Transvaal for consideration and report. But the said Petition has not
" been so referred, and His Excellency, upon the advice of the legal adviser of
" the Transvaal Administration, has refused, and still refuses, so to refer the same. 45
" The grounds of this refusal are set out in a letter written to Mr. F. C. Dumat
" by Sir Richard Solomon, the said legal adviser. Mr. Dumat is the solicitor
" acting for the Appellant in the Transvaal Colony.

" The said letter is in the words and figures following :—

" ' Pretoria, . . . 50

" ' 30th May, 1902—2nd June.

" ' In reply to your letter of the 20th May, I beg to point out to you that it is
" ' quite clear to me that section 31 of the Patents Proclamation, 1902, refers to
" ' a Patent which, at the date of the application to the Governor asking for an
" ' extension of its term, is still in force. 55

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- “ ‘ The Acting Commissioner of Patents informs me that the records in his
 “ ‘ office show that the Patent in connection with which your application was
 “ ‘ made was cancelled in accordance with an order of the High Court of the
 “ ‘ 4th November, 1896.
- 5 “ ‘ In the Petition of the *African Gold Recovery Company Ltd.* to the King’s
 “ ‘ Most Excellent Majesty, it is alleged that the above record in the Patents
 “ ‘ Office is “ ‘ wholly without warrant and erroneous,” and that “ ‘ there was in
 “ ‘ fact no jurisdiction in the Court to cancel and annul the said grant.” The
 “ ‘ Petition goes on to say that the Order of the late High Court of the Transvaal
 10 “ ‘ in the *Hay* action was merely a declaration “ ‘ that the said Patent No. 47
 “ ‘ was obtained unlawfully and wrongfully, and that it was void and of no
 “ ‘ value.”
 “ ‘ I have obtained from the Registrar of the High Court a copy of the Order
 “ ‘ of the late High Court in the aforesaid Action. It is as follows :—
- 15 “ ‘ In English :—
 “ ‘ In the matter of *James Hay*, Plaintiff, *versus The African Gold Recovery*
 “ ‘ *Company Ltd.* Defendant.
- “ ‘ Pretoria, this 4th day of November, 1896.
- 20 “ ‘ After having heard Messrs. *Wessels, Dickson, Sauer, and Duxbury* of Counsel
 “ ‘ for the Plaintiff, Messrs. *Esselen, Curlewis, and Muller* of Counsel for the
 “ ‘ Defendant, and the evidence, and having read the documents : Be it hereby
 “ ‘ ordered, that Judgment be and is hereby given in favour of the Plaintiff
 “ ‘ with condemnation of the Defendant Company in the costs of this Action.
 “ ‘ It is declared that the Patents numbered 47 and 74 obtained by *J. S.*
 25 “ ‘ *MacArthur, R. W. Forrest, and W. Forrest*, and ceded to the Defendant
 “ ‘ Company, are void and of no value, and the said Patents are therefore
 “ ‘ cancelled.
- “ ‘ On behalf of the Court,
 “ ‘ (Signed) CALLA JUTA, Registrar.
- 30 “ ‘ In my opinion as long as the Judgment of the late High Court stands I
 “ ‘ cannot advise His Excellency to forward the Petition of the *African Gold*
 “ ‘ *Recovery Company* to the High Court for consideration.
 “ ‘ (Signed) RICHARD SOLOMON.”
- 35 “ ‘ 11. The above stated copy Order of the late High Court is, as the Appellant
 “ ‘ contends, erroneous, and has been entered in the Registrar’s book without
 “ ‘ authority. The Appellant submits as grounds for this contention that :—
 “ ‘ (a) The Government of the Republic being a party to the Patent deed was a
 “ ‘ necessary party to any proceedings had for the cancellation of that deed, but
 “ ‘ the said Government was in no way a party to the said Action and was not
 40 “ ‘ represented at any of the proceedings in the said Action. Wherefore no
 “ ‘ Order for the cancellation of the said deed could be made in the said Action
 “ ‘ as constituted. (b) The relief asked for by the Plaintiff in the Action was
 “ ‘ not cancellation of the said Patent or any such relief in the nature of a
 “ ‘ Judgment *in rem*, but was a declaration of invalidity being in the nature of a
 45 “ ‘ Judgment *inter partes*, which could not affect the existence of the Patent or
 “ ‘ the question of its validity as between other parties. By the law of the South
 “ ‘ African Republic the jurisdiction of the said High Court was limited to the
 “ ‘ giving of such relief as was defined by the prayer of the Summons by which
 “ ‘ the Action was commenced. . . . In the present Action the conclusion
 50 “ ‘ of the Plaintiff’s claim, by which the jurisdiction exerciseable by the Court
 “ ‘ in this proceeding was defined, was expressed in the terms above quoted in
 “ ‘ paragraph 4 hereof from the prayer (conclusion) of the Plaintiff’s Summons.
 “ ‘ They make no reference to the cancellation of the Patent, for which, indeed,

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"the Plaintiff, acting in his private capacity and being in no way representative of the Government of the Republic, had no title to ask. But they do ask for a declaration which, as between himself and the Appellant would be of binding force, that the Patent was invalid. The recorded Judgment therefore, in so far as it goes beyond such a declaration and deals with the further and separate question of the cancellation of the Patent, is manifestly null and void and ought never to have been so recorded." [Other grounds were also alleged.]

"13. The Appellant on the 18th of September 1902 presented to the Supreme Court of the Transvaal a Petition, which is duly set out in the Record annexed hereto, in which the hereinbefore stated facts are stated, and of which the prayer, stated shortly, is:—(a) That the above-mentioned Judgment may be set aside and a new trial of the Action may be had. (b) Alternatively that the Record of the trial may be amended and rectified by striking out therefrom the words 'and the said Patents are therefore cancelled' (in Dutch, 'en de gemelde Octrooien worden dus gecancelleerd.') (c) That leave may be given to the Appellant to apply to the Patent Office of the Colony for leave to amend the Specification of the said Patent No. 47." [Two other paragraphs of relief followed.]

"14. On the 20th of October 1902 the Respondent gave Notice of Motion in the Action to strike the said Petition off the Roll of the Court and for an Order dismissing the said Petition upon the grounds following, that is to say:—(a) That the notice of filing of the said Petition and of the setting down for hearing thereof is irregular and insufficient. (b) That the Court had no jurisdiction to consider, hear, or adjudicate upon the said Petition. (c) That the said Petition contained no allegation of fact and was not founded upon any contention of law which would justify the Court in making any Order prayed for therein.

"15. The said Motion was made before a Divisional Court sitting at Pretoria on the 30th of October 1902, and consisting of His Honour the Chief Justice, His Honour Mr. Justice Solomon, and His Honour Sir W. J. Smith. The first of the above-mentioned grounds—that is to say: (a) that the notice of filing and setting down was irregular and insufficient, was abandoned, and argument was heard under the two remaining heads, the Motion being treated as a demurrer and the statements in the Petition contained being assumed for the purpose of the argument and decision to be established as matters of fact.

"16. After hearing arguments the Court made an Order in accordance with the Respondent's application dismissing the Petition with costs. The Judgments delivered by the above-named Justices are set out in the Record hereto annexed. From these Judgments it appears that the learned Judges who concurred in the Order dismissing the Petition were of opinion that (1) the Supreme Court has no jurisdiction to rehear a matter upon which the late High Court of the Republic has adjudicated; that (2) the Order for cancellation was rightly appended to the recorded Judgment; that (3) the Appellant's application for leave to apply to amend the Specification could not be now considered; and (4) that this Action was not, at the date of the Proclamation (No. 14 of 1902), an Action or matter depending in the High Court of the late South African Republic.

"22. The Appellant humbly submits that the said Order dismissing the Appellant's Petition is wrong, and ought to be reversed, and that the Supreme Court of the Transvaal has jurisdiction to rehear the action of *Hay* against the *African Gold Recovery Company Ltd.* and to give such Judgment or make such Order therein as ought in the first instance to have been given and made, and that the said Court has power to correct the Record of the Judgment in the said Action delivered by the High Court of the late South African Republic on the 4th of November 1896, and that the said Record ought to be amended as prayed in the Appellant's Petition of the 18th of September 1902, and that

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"the said Supreme Court has jurisdiction to consider and dispose of the Appellant's application for leave to apply at the Patent Office of the Transvaal for leave to amend the Specification of the said Patent No. 47, and that such leave ought now to be granted in accordance with the prayer of the Appellant's said Petition." [The Reasons then followed.]

The Respondent, at the conclusion of his case, submitted that the Judgment of the Supreme Court of the Transvaal was right, and that this Appeal should be dismissed for the following, amongst other, reasons:—"1. Because the said Action of *Hay v. the African Gold Recovery Company Ltd.* was finally decided, and the said two Patents Nos. 47 and 74 were both cancelled by the Order of the full Court of the said late High Court of the South African Republic of the 4th of November 1896, from which Order no Appeal lay. 2. Because at the trial before the late High Court of the late South African Republic of the said Action of *Hay v. the African Gold Recovery Company, Ltd.*, an application to the Court for leave to amend was made by the then Defendants and was refused by a majority of the Court. 3. Because the said Action was not an Action pending at the date of the annexation of the said South African Republic, and the Supreme Court of the Transvaal has no jurisdiction under the said Proclamation No. 14 of 1902, or otherwise, to reopen or otherwise interfere with the said Judgment Order of the 4th of November 1896. 4. Because the said Patent No. 47 was duly cancelled and has ceased to exist, and there is therefore nothing which can be amended. 5. For the reasons stated by the learned Judges of the Supreme Court of the Transvaal in their Judgments."

Asquith, K.C., and *J. W. Gordon* (instructed by *Davidson and Morriss*) appeared for the Appellants; *Neville, K.C.*, *Haldane, K.C.*, and *B. C. Molloy* (instructed by *Burchells*) appeared for the Respondents.

Asquith, K.C., and *Gordon*, for the Appellants, after submitting that an Appeal lay to the Supreme Court, continued:—"The Judgment of the Court of the Republic cancelling the Patent ought to be rectified, for that relief was not asked for, and under the Transvaal Act the Court had not power to cancel the Patent in a proceeding which was merely *inter partes*. The application for leave to apply to amend the Specification has never been disposed of. [Lord DAVEY.—The Court would not have declared the Patent invalid if it had thought an amendment was open.] The Appellants are entitled to have the matter considered on its merits, whereas it has been disposed of on a preliminary objection. The Court went beyond the relief which it had jurisdiction to give. [Lord DAVEY.—Do you contend that the Patent might be prolonged, although in 1896 it had been declared to be valid?] Yes, the declaration was merely *inter partes*, and the Petition for prolongation was stopped because of the previous judgment, so it is desired to rectify that. The Court had only power to give a judgment *in personam*, but it has given a judgment *in rem* by the Order for cancellation. The grant of a Patent could not be set aside in the absence of one party to the grant, namely, the State, represented by its Attorney-General. Here the Judgment was purely *inter partes*, and a declaration of invalidity, and not cancellation, was the relief sought. The Order for cancellation could not be properly made in the proceedings, and the error in the Judgment should be corrected (*Lawrie v. Lees*, L.R. 7 App. Cas. 19; *In re Swire*, L.R. 30 Ch. D. 239). A Patent may be prolonged although its validity is doubtful, and even if decisions adverse to it have been given (*Frost* on Patents, page 368). Here, in view of the decision of the Court of Appeal in England, there is sufficient doubt for the question to be left open on a Petition for Prolongation. [Lord DAVEY.—Here the jurisdiction is for the purpose of invalidating the Patent, and that does not mean for the purpose of a particular action. I cannot see the importance of the words cancelling the Patent being in the Order or not.] [Lord MACNAGHTEN.—Nor can I.] We submit that the proceedings were not in the nature of a Petition for Revocation, and that, the

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Attorney-General not being a party, the Court could only make a declaration binding between the parties.

Counsel for the Respondent were not called on.

The Judgment of the Judicial Committee was delivered by

Lord LINDLEY.—The Supreme Court of the Transvaal has decided that it has 5
no jurisdiction to entertain an appeal from the decision of the High Court of
the Transvaal Republic pronounced in November 1896. The Appellants
maintain that the Supreme Court has such jurisdiction and ought to exercise
it and decide their appeal on the merits. This is the question which their
Lordships have to determine. 10

It is common ground that by the law of the Transvaal before the war the
decision of the High Court of the Republic was final. There was no appeal
from its decision to any higher Court in South Africa nor to Her Majesty in
Council. The Appellants, therefore, have to show some Statute or Ordinance
passed since the annexation of the Transvaal and conferring a right of appeal 15
from the decision of such Court to some Court of the new colony. The only
authoritative document which bears upon the question is the Proclamation
(Transvaal) No. 14 of 1902, under which the existing Supreme Court is consti-
tuted. The important section is section 16, which says : "The said Court shall
" have cognizance of all pleas and jurisdiction in all civil causes and proceedings 20
" arising or which shall have arisen within the said Colony or which shall have
" arisen in the Transvaal prior to the annexation thereof."

There is another section (section 43) relating to pending proceedings, but it
has no application to this case. It appears to their Lordships, as it did to the
Supreme Court of the Transvaal, that the language of section 16 creates no right 25
of appeal ; it gives no right of appeal where none existed before, consequently
the Appellants' contention cannot be sustained.

It is unnecessary to consider whether the Roman-Dutch law on *Restitutio in*
integrum makes any exception, as it has no application to the facts of this case
if they are gone into. 30

The Judgment of the High Court from which the Appellants desired to appeal
was a Judgment vacating a certain Patent. Their Lordships have expressed
no opinion on the view taken by the High Court of the validity of the Patent ;
but in the course of the argument their Lordships stated that they could not
accept the view pressed upon them by Mr. Gordon that, even if the High Court 35
had power to declare the Patent invalid, it had no power to go on and order it
to be cancelled in an action not brought by the Attorney-General and to which
he was not a party. The Transvaal Patent Act, No. 6 of 1887, (sections 29-31)
expressly authorised judgments which were really judgments *in rem* in
proceedings specially brought for the invalidation of Letters Patent. As this 40
point was fully argued by the Appellants, their Lordships think it may be
useful to repeat what they said and remove all doubt upon the subject.

Their Lordships will therefore humbly advise His Majesty to dismiss this
Appeal, and the Appellants must pay the costs.

Ackroyd and Best Ltd. v. Thomas and Williams.

IN THE SUPREME COURT OF JUDICATURE.

COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, and COZENS-HARDY.

October 26th and 27th, 1904.

5

ACKROYD AND BEST LD. v. THOMAS AND WILLIAMS.

Patent.—Action for infringement.—Construction of Specification.—General principle.—Special construction to obtain special objects.—Infringement not found.—Judgment for Defendants at trial.—Appeal dismissed.

- 10 The owners of a Patent for improvements in miners' safety lamps, having brought an action for infringement, the Defendants denied infringement, and alleged the invalidity of the Patent, but at the trial relied principally on the contention that the Patent was for a particular combination, which they had not taken. The first claim of the Specification was as follows:—"In a miner's
- 15 "safety lamp, the employment of a spring catch for locking the bonnet, the said "spring catch being brought into an acting position on the closing of the lamp, "substantially as set forth." The Plaintiffs alleged that the feature of the invention was an arrangement by which, when the bonnet was screwed on, it
- 20 was undone, and that the Defendants had in substance taken the combination. At the trial it was held, that the Patent did not involve any new principle, but was for the particular combination, and that the Defendants had not taken the patented spring catch or the substance of the invention. The action was dismissed with costs. The Plaintiffs appealed.
- 25 Held, that the Patent did not involve any new principle, but was for a particular combination, and that the Defendants had not infringed that combination. The appeal was dismissed with costs.

Per COZENS-HARDY, L.J.—If a Patentee intends to claim a general principle, is it his duty to make that intention reasonably clear by his Specification.

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On the 12th of March 1898, Letters Patent (No. 6128 of 1898) was granted to William Ackroyd and William Best for an invention of "Improvements in or connected with Miners' Safety Lamps."

The Complete Specification was as follows:—"It is the custom for all miners' lamps to be delivered into the lamp room for cleaning purposes after they 5
"have been employed in the mine, but when the lamp is again returned to the miner ready lighted and locked, he has no guarantee that the lamp has been properly attended to. If the lamp cleaner is negligent in his duty, he may simply remove the lamp bottom and clean the interior of the lamp without taking out the gauze, or the lamp may be closed after cleaning without having 10
"a gauze in at all. Faults of this description cannot be detected by the miner, and this negligence has often been the cause of disastrous explosions.

"Now the object of this invention is to prevent explosions being caused in mines through the negligence of the lamp cleaner or other person cleaning the lamps, or through any attempt on the part of the miner to loosen the 15
"glass, and with this object we construct our lamp as shown in the accompanying drawing, where Figure 1 is a sectional elevation of the same, and Figures 2, 3, 4 and 5 are detail views.

"The general structure of the lower part of the lamp is as follows:—A is the lamp frame, and B is the lamp bottom or oil container which is provided 20
"with a spring bolt C only capable of being withdrawn by means of a powerful magnet. The lamp bottom B screws into the lamp frame A by means of a right-hand screw thread D. E is a ring for receiving the base of the glass J. This ring E screws into the lamp frame by means of a left-hand thread F, and 25
"the base of the ring E is provided with a flange on the under side of which are situated rack teeth H (see inverted plan view Figure 5) for engaging with the locking bolt C.

"The particular arrangement of the upper part of the lamp, characterizing the invention, and whereby the screw off outer cover or 'bonnet' R may be 30
"fastened after the base of the lamp is locked and whereby the 'bonnet' R cannot be unfastened until the base of the lamp is unlocked, is as follows:—The upper edge of the lamp glass J bears against a shoulder L formed upon the lower edge of the gauze cover K. M is a spring which is attached to the lamp frame A, and N is a stud which is attached to the end of the spring M and passes through a hole in the lamp frame A. P is a spring which is 35
"fastened to the under side of the bonnet R, which latter is connected to the lamp frame A by means of the screw thread S.

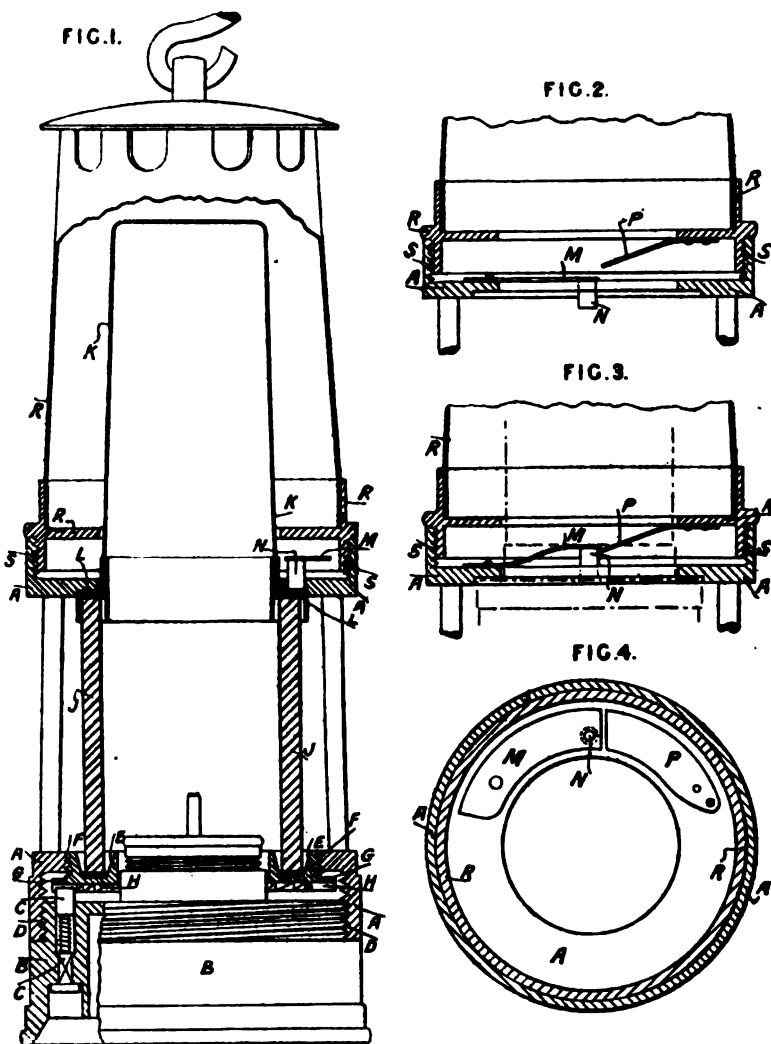
"When the ring E is screwed tightly home, the glass J holds the shoulder L of the gauze K firmly up against its seat in the lamp frame A, the said 40
"shoulder in its turn holding up the stud N as shown at Figure 3 and plan view Figure 4 and so keeping the spring M in a position to engage with the spring P, as seen at Figure 3. The lamp bottom B can now be screwed into position, the bolt C running round over the rack teeth H, until the said lamp bottom B is screwed securely home. Any attempt to unscrew the lamp 45
"bottom B without first withdrawing the bolt only tends to tighten the parts more firmly into position owing to the reverse direction of the screw threads F and D.

"When the lamp is handed to the miner in this condition, viz., with the lamp base locked but with the bonnet R removed, the miner or inspector can 50
"only examine the gauze and they cannot tamper with the lamp. When the examination of the gauze K has been made, the bonnet R is secured firmly home, until the spring P takes behind the spring M, and the bonnet is thus firmly locked until the spring M resumes the position shown at Figure 2, which cannot take place until the lamp is taken to pieces in the lamp room.

"Thus according to our invention the lamp bonnet R may be screwed on and 55
"off from the lamp frame, to which it can be locked by the spring catch M the said spring catch M only being brought into action when the glass J and the

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“gauze K are pressed firmly in position by means of the ring E. This enables
 “the lamp to be handed to the miner with the gauze, glass, and glass holding
 “ring fastened into position, and with the lamp base already locked whilst the
 “bonnet can be handed separately to the miner, or it can be screwed loosely on
 5 “the frame but not far enough for the spring catch M to engage and lock the
 “said bonnet R. The miner can thus take off the said bonnet R and see that



“the gauze K is in position and clean, and the inspector can repeat the
 “examination and then screw the bonnet up until the spring lock P engages
 “with the spring catch M in the lamp frame, thus firmly locking the bonnet R
 10 “which cannot be again opened until the lamp bottom B is unlocked in the
 “lamp room. The lamp cleaner is obliged to remove the gauze K and glass J
 “in order to remove the bonnet R, thus preventing the possibility of his simply

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"cleaning the interior of the gauze K with a brush so as to save himself the trouble of removing the glass holding ring E. If the gauze is not properly cleaned, or if it has been omitted, the neglect is at once detected by the miner or the inspector."

The Patentee claimed :—(1.) In a miner's safety lamp having a screw off bonnet, the employment of a spring catch for locking the bonnet, the said spring catch being brought into an acting position on the closing of the lamp, substantially as set forth. (2.) In a miner's safety lamp having a screw off bonnet, the spring top M brought into the acting position by the flange L of the gauze K on the raising of the glass J when locking the lamp, in combination with the spring catch P on the bonnet R, substantially as set forth. (3.) In a miner's safety lamp having a screw off bonnet, a spring catch P situated on the under side of the bonnet R, in combination with a spring top M having a stud N the latter being actuated by the raising of the glass J on the lamp being closed substantially as set forth."

On the 22nd November 1902 *Ackroyd and Best Ltd., Charles Topham Naylor, and John Proudfoot Humble* commenced an action against *Thomas and Williams* for infringement of the Patent, claiming the usual relief.

The Plaintiffs, by their Statement of Claim, alleged :—(1) That they were, and had been since the 12th March 1898, the owners of the Patent; (2) that the Patent was valid; and (3) that the Defendants had infringed the same.

By their Particulars of Breaches they alleged that the Defendants had infringed the Patent by manufacturing lamps according to the invention, as claimed in all the three claiming clauses of the Specification, and delivering them to the persons or companies named at or about the dates stated (four instances were given, all in the year 1902, prior to the date of the writ). A letter of January the 12th 1904 to the Plaintiffs' Solicitors by the Defendants' Solicitors stated that the Defendant was prepared to admit that he had manufactured and delivered lamps as alleged in the Particulars of Claim, and that such lamps were constructed according to the drawings of *L. N. Williams*' Specification (No. 25,334 of 1901).

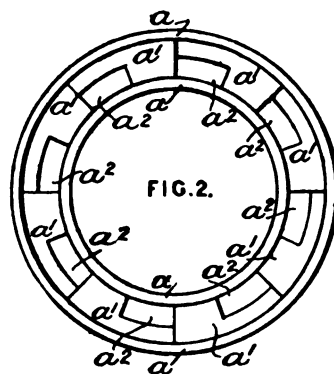
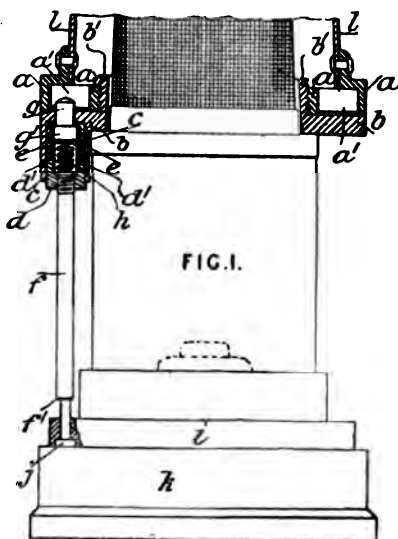
The Complete Specification of this Patent, so far as material for the purposes of this Report, was as follows :—“This invention, which relates to miners' safety lamps, consists in an improved method of and means for locking the bonnet to the lamp body and unlocking it therefrom. Within a chamber provided on the step-top ring, that is to say, the ring above the glass, is a cup adapted to slide upwards and downwards. In the cup is a spiral spring in compression, the lower end of which spring bears against the inner face of the cup bottom. The other end of the spring bears against the underside of a bolt. The said spring tends constantly to force the bolt up and cause it to project at top above the top of the cup. A piston of larger diameter than the aperture through which the bolt projects prevents the bolt from being forced out of the cup upwards by the thrust of the spring. The cup is flanged at bottom. Between the upper face of the flange of the cup and a shoulder provided in the chamber is a spiral spring tending constantly to depress the cup. To the underside of the cup is screwed or otherwise attached one end of a pillar which extends down and is passed through the lower ring of the lamp body. A shoulder on the pillar limits the downward travel of the pillar by contact with the upper face of the lower ring of the lamp body. As the oil-pot is screwed into the lamp, the cup is raised by the consequent pushing up of the pillar connected to it. The spiral spring encircling the cup is further compressed in the chamber. The bolt carried in the cup is elevated to project above the top of the chamber. In the bonnet ring is a circular row of ventilation apertures, a provision made in some forms of safety lamps. The ribs between the apertures are specially shaped under this invention, that is to say, each rib is knife-edged and has an inclined face at one side. The ring of ribs and apertures constitutes a circular rack.

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" In screwing the bonnet on to the lamp body, which is done subsequently to locking the oil-pot in place in the lamp, the bolt for locking the bonnet to the lamp is depressed against the resistance of the spring under it, and rebounds into a ventilating aperture in the bonnet ring, and thus the bonnet becomes
5 " locked on the lamp.

" Unlocking takes place as the oil-pot is being unscrewed. The spiral spring encircling the cup depresses the cup, and thus the bolt is drawn down clear of the bonnet and frees it.

" Referring to the accompanying drawings, Fig. 1 represents part of a miners' safety lamp fitted with my improvements for locking the bonnet to the lamp body and unlocking it therefrom. The view is partly in vertical section; the section being taken through the chamber in which the locking bolt is situated.
10 " Fig. 2 is a plan of the bonnet ring *a* as inverted. Fig. 3 is a vertical section



" through one of the wedge-like ribs *a*¹ intervening between the ventilation
15 " apertures *a*²—Fig. 2—of the bonnet ring *a*. Fig. 4 is a similar section at the opposite side of the lamp. Cast with the step-top ring *b* is a chamber *c* in which is a cup *d* which is adapted to slide vertically in the chamber *c*. Coiled about the cup *d* is a spiral spring *e*, the lower end of which bears on a shoulder *d*¹ provided on the cup. The upper end of the spring *e* bears against the inner
20 " face of the top of the chamber *c*. The spring *e* tends constantly to depress the cup *d* and with it the pillar *f* which is screwed or otherwise rigidly connected to the cup. A bolt *g* adapted to slide vertically in the cup *d* is acted upon from below by a spring *h*, the upper end of which bears against the under face
25 " of the piston *g*¹ of the bolt *g*. The lower end of the spring *h* bears against the inner face of the bottom of the cup *d*. The spring *h* tends constantly to force the bolt *g* upwards to the full extent of its upward travel, projecting out of the cup *d* as shown in the drawing. The piston *g*¹, by contact with the inner face
30 " of the top of the chamber *c*, limits the upward travel of the bolt *g*. The pillar *f* is reduced in diameter towards the lower end. The part thus reduced loosely fits a passage provided for it in the bottom ring *i* of the lamp body. The extent of downward movement of the pillar *f* is limited by contact of the

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"shoulder f^1 with the upper face of the bottom ring i . At foot the pillar f has
 "attached to it a disc j which prevents the pillar from entering the aperture
 "made in the oil-pot k for receiving the bolt by which, as ordinarily, the oil-pot
 "is locked to the lamp body.

"In the bonnet ring a is a circular row of ventilation apertures a^2 , as is the 5
 "practice to provide in some types of miners' safety lamps. The ribs a^1 between
 "the apertures are, under this invention, specially shaped. They are, as seen
 "at Figs. 3 and 4 of the drawings, wedge-shaped. They are knife-edged teeth,
 "and they are so made in the bonnet ring a that in screwing the ring on to the
 "lamp body, the knife-edge of each wedge leads in the direction of rotation, 10
 "and the deeper part of each wedge follows as a tail.

"The act of screwing on the oil-pot k to the bottom body ring i causes the pot
 "to come into contact with the bottom of the disc j fixed on the pillar f . The
 "latter is pushed up against the resistance of the spring e , which is further com- 15
 "pressed. The pillar f carries up the cup d and the bolt g , which latter is thus
 "made to project above the top of the step-top ring b into the bonnet ring a .
 "When the oil-pot has been screwed fully home, it locks to the body, as
 "ordinarily.

"The bonnet l is next screwed on to the extension b^1 of the step-top ring b .
 "As, in screwing on the bonnet l , the ribs a^1 bear on the bolt g , the latter is 20
 "depressed during the forward passage of each rib, but is, by the rebound of the
 "spring h , shot up again into the succeeding aperture a^2 behind the deep face
 "of the rib when the latter is passed, thus locking the bonnet to the lamp body
 "by preventing the bonnet from being unscrewed. The bonnet cannot be
 "unscrewed until the oil-pot k has been unlocked and unscrewed to allow the 25
 "cup d with the bolt g to be depressed by the spring e ."

The Defendants, by their Defence:—(1) Did not admit that the Plaintiffs were
 the owners of the Patent; (2) Denied infringement; and (3) Alleged that
 the Patent was invalid. By their Particulars of Objections they alleged:
 (1) That the said alleged invention, forming the subject-matter of the Patent, 30
 was not new, but had been published in the Realm prior to the date of the
 Patent in the Specifications of the following Patents:—*A. Yates* (No. 2677 of
 1871); *B. Patterson & Shype* (No. 2697 of 1887); *C. Thorne* (No. 2779 of 1889);
D. Thomas (No. 8136 of 1889); and *E. Hughes* (No. 27,150 of 1896). The
 Defendants relied upon the whole of each of these Specifications as anticipating 35
 all the claims in the Specification of the Plaintiffs' Patent; (2) That there was
 no subject-matter; the Defendants relied thereunder upon common knowledge
 concerning the construction of miners' safety lamps, and of the various
 methods of locking the different parts of same, and upon the matters set
 out in paragraph 1; (3) That the alleged invention was not useful; lamps 40
 constructed as described in the Complete Specification could have their bonnets
 removed without unlocking the lamp; (4) That the Complete Specification
 of the Patent did not sufficiently describe the nature of the invention and the
 manner in which the same was to be performed, and was misleading in that
 the spring catch was not brought into operation by the closing of the lamp as 45
 alleged, or at all; (5) That the alleged invention was not new; but as to all
 the claims in the Complete Specification of the Patent, had been anticipated by
 the prior user of each of the lamps marked "A" to "H," which were in the
 possession of the Defendants' Solicitors, and could be inspected by the
 Plaintiffs. 50

The Particulars specified eight lamps, marked "A" to "H," the lamp "D"
 being called "Improved Cambrian," and the earliest date of user being given as
 1887; the lamp "G" being called "*Thomas' Patent*, No. 8136 of 1889," the earliest
 date of user being given as 1889; and the lamp "H" being alleged to be manu-
 factured by *Fredk. Griffin*, in October 1897, at the Defendants' works, and 55
 used at the Defendants' works, and at the *Lewis Merthyr Colliery Company*, in
 October and the following months of the year 1897.

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The action came on for trial on the 11th of March 1904, before *Joyce, J.*, and the action was dismissed on the 10th of May 1904, *Joyce, J.*, holding that the Defendants had not infringed.* The Plaintiffs appealed.

The appeal came on for hearing on the 26th of October 1904.

- 5 *T. Terrell, K.C.*, and *J. C. Graham* (instructed by *Walker and Rowe*, agents for *Wooler, Burrows, and Burton*, of Leeds) appeared for the Appellants; *A. J. Walter* (instructed by *Purkis & Co.*, agents for *T. Phillips & Son*, of Aberdare) appeared for the Respondents.

- T. Terrell, K.C.*, and *Graham*.—The Plaintiffs appeal from the decision of
10 *Joyce, J.* He decided in favour of the Defendants on the issue of infringement. The question is one of construction. The construction put upon the Specification by the learned Judge can only be supported by straining the real meaning of the words of the Specification. The invention relates to improvements in miners' safety lamps. In miners' safety lamps the flame is protected by wire
15 gauze; bonnets are fixed on the bodies of the lamps to prevent the miners "sucking" the flame through the gauze. It is essential to conditions of safety that it should be made impossible for the miner to remove the bonnet in the mine. In the lamp constructed according to the Plaintiffs' invention there is a safety lock only operated in unlocking by a powerful magnet or other means,
20 and this is locked before the bonnet is put on; it locks the bottom of the lamp, and it puts into operation that which will lock the bonnet when the bonnet is screwed up, so that the miner cannot then open either the bottom or the top, and the bonnet cannot be removed until the bottom of the lamp is unlocked. [The patented lamp was produced and explained and the Specification was read.]
25 Owing to right-handed and left-handed screws any attempt to unscrew the bottom of the lamp tends only to tighten the parts, unless the spring-bolt C is withdrawn, in which case the whole of the parts of the lamp can be unscrewed. The bonnet remains locked until M can resume the position shown in Fig. 2—that is, until N can drop, which cannot happen until the bottom of the lamp is
30 unscrewed. Upon screwing home the bonnet, the security of the main lock of the lamp is obtained for the bonnet. The lamp is in practice handed to the miner with the bottom locked, and the bonnet is handed to him separately or loosely screwed on to the frame. That is done in order that he may see that the lamp cleaner has cleaned the gauze. It is the duty of the mine inspector to see
35 that the bonnet is screwed down before the miner enters the mine. He can do this with the Plaintiffs' lamp by inspection. Until the Plaintiffs' invention no arrangement was known by which the head of the lamp could be automatically fastened by the mere act of screwing it down. The general apparatus of the lamp was known; a bonnet fastened by screwing on was known, but it was
40 locked by a separately acting device. The invention substitutes for the old method an automatically working catch. The Plaintiffs' lamp affords security against any negligence of the lamp cleaner and any tampering by the miner, because it has the important features that it cannot be opened except by means of a powerful magnet; it can be examined by the miner to see that the gauze
45 is in and is clean when handed to him. [The Defendants' lamp constructed according to *L. N. Williams'* Specification, No. 25,334, *ante*, p. 740, was produced and explained. The alleged anticipations of the Plaintiffs' Patent were also produced and explained.] The Plaintiffs' invention has not been anticipated by any of the lamps relied upon by the Defendants. The lamp
50 has the capacity to perform three different functions, which are for the first time present—(1) it can be locked completely without the head; (2) the bonnet or head is fastened by the mere act of screwing up the head; (3) it is impossible to take off the head before opening the bottom lock. [The evidence was referred to and portions of the judgment given by *Joyce, J.*, were
55 read.] The learned Judge regarded too closely the words of the claim.

* *Ante*, p. 403

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In construing a Specification the Specification as a whole must be looked at (*Tubes, Ltd. v. Perfecta Seamless Steel Tube, Ltd.*, 20 R.P.C. 77). Reading the Specification fairly, the Plaintiffs' invention has not been anticipated. The Defendants have in substance taken the Plaintiffs' combination. They have infringed the combination according to the principles laid down in *Clark v. Adie* (L.R. 2 App. Cas. 320); *Dudgeon v. Thomson* (L.R. 3 App. Cas. 44); and *Nordenfeldt v. Gardner* (1 R.P.C. pp. 61, 65).

Walter for the Respondents.—The first claim is the only one now alleged to have been infringed. The claim is not for a lamp—it is for a sub-combination in a lamp. The Defendants have not infringed. One of the objects of the Plaintiffs' invention is that the lamp cleaner shall be obliged to remove the gauze and glass in order to remove the bonnet. In the Defendants' lamp it is not necessary to remove the gauze to remove the bonnet. Another object mentioned by the Patentees is that of preventing any attempt by the miner to unfasten the lamp. The latter object is attained by the Defendants, but by a different path. The invention is nothing more than a detailed method of lamp construction, and upon the true construction of the Specification, inasmuch as the Defendants travel by a different path, it is immaterial that they obtain one or more of the advantages obtained by the Patentees (*Dudgeon v. Thomson*, L.R. 3 App. Cas. 34). A detachable bonnet locked by means of a pillar, itself raised by screwing on the oil container, was well known before the Plaintiffs' Patent. A lamp so made that the base could be locked and the lamp not tampered with was old. A bonnet fitted so that the miner could examine the gauze before closing the lamp was also old. The automaticity claimed by the Plaintiffs was old—viz., screwing on the bonnet, and, without any further action, securing the bonnet in its place so that it could not be moved except by the aid of a key. *Thomas* automatically secured the bonnet. But it is suggested that that was not an effectual locking. That is no answer in law to the position taken up by the Defendants—namely, that the Patentees cannot say that they have invented anything novel in principle. The claim is in fact for automatically locking by means of the action of a ratchet and pawl. That is identical with *Thomas*. It is said that the "spring catch" in Claim 1 is M, N, and P. If it is so it is not "brought into an acting position on the closing of the lamp," nor even on screwing up the ring E. M, N, and P, therefore, do not make the spring catch. If the construction contended for by the Plaintiffs is right, then the Patent is bad, because there is no sufficient description of what is claimed. The true construction is that M and N form the "spring catch," and they are brought into an acting position on screwing up the ring E. The Patentees do not claim a "spring catch" in combination with and put into position by any means whatever. If they do then they are anticipated by *Thomas*. Neither of the objects claimed in the Specification is attained by their invention. At the date of the Patent there was nothing left to improve upon except specific details. Admittedly there is nothing described in the Specification except a device which, according to the Patentees' own words, intentionally operates to free the wire gauze by the act of opening the lamp. On the true construction, Claim 1 is for a sub-combination consisting of a combination of parts which enables the object of the Patent to be carried out—i.e., that the gauze should be removed before the bonnet is removed. This the Patentees could not do by adopting the old sliding pillar. They wanted an apparatus which would give them a "free" gauze. It cannot, therefore, receive a wider construction so as to cover something not giving a "free" gauze, and which does not in any way operate to render it compulsory that the gauze should be taken out for cleaning. The Defendants do not infringe; they do not remove the gauze when taking off the bonnet; they do not release the bonnet by unscrewing a ring; they do not make use of the glass; they do not put a ratchet into an operating position by screwing up any ring corresponding to E; they adopt an old method of raising a pillar by screwing up the oil container.

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Terrell, K.C., in reply.—The Patentees' invention is a combination which is new. There was before the date of the Patent no lamp the bonnet of which was closed by a "spring catch" brought into an acting position on the closing of the lamp. "On the closing of the lamp" means the assembling of the parts—
 5 that is, performing the several operations necessary to close the lamp. The lamp performs a combination of functions never before performed. The Court protects such an invention from variations that are only colourable. Three things are comprised in the substance of the invention—(1) the lamp can be locked; (2) it can be examined in a locked condition; (3) it cannot be opened
 10 by the miner after the bonnet is screwed down. The substance of the invention must be looked at (*Von Heyden v. Neustadt*, 50 L.J. N.S. 126).

VAUGHAN WILLIAMS, *L.J.*—I think this is a very difficult case. Mr. Justice *Joyce* has given judgment for the Defendants, and in doing so he comments upon the Specification, and he says that the Specification appears to him to be
 15 very loosely drawn. I agree that the Specification wants preciseness, and it is that which really causes the difficulty.

The Letters Patent had been granted in respect of improvements in or connected with miners' safety lamps, and the Defendants deny the infringement which is alleged. We have to dispose of this issue as to whether there has been
 20 an infringement or not, and the real truth of the matter is that you cannot dispose of that question unless you first make up your mind as to what invention it is which is protected by these Letters Patent. Unfortunately the invention is not so clearly defined by the text of the Specification, read in conjunction with the claims, as that it is easy to define what the invention is
 25 which is protected. I am always very sorry, when I find a good machine in respect of which it is said there has been invention, to be forced to decide against the Patentee on the ground that the Specification wants precision, or is difficult to construe.

There are three claims, and in the observations which I am going to make I shall chiefly deal, as Mr. Justice *Joyce* did, with Claim 1, which runs thus :—
 30 "In a miner's safety lamp having a screw off bonnet, the employment of a "spring catch for locking the bonnet, the said spring catch being brought into "an acting position on the closing of the lamp, substantially as set forth."

There is no contest that if you are to construe that Claim 1 as a claim for a
 35 particular combination, and nothing more, there has been no infringement, because it is obvious that the Defendants' lamp differs in its details from the Plaintiffs' lamp. The Plaintiffs, therefore, can only succeed in this action by showing that what is claimed in this claim, and covered by the Specification, and what, therefore, is protected by the Letters Patent is not a mere combination of
 40 steps to arrive at a desired end, but is an invention which is really based upon a principle, so that persons who may in detail differ in the lamps which they manufacture or use from those described in the Letters Patent might still be liable to be restrained in an action for infringement because they have violated a principle which, for the first time, has been embodied in a lamp manufactured
 45 by the Plaintiffs.

I am, of course, going to read this claim in conjunction with the text, but in the first instance I look at the claim itself, and ask myself—Is this a general claim of such a character that it claims something which has been infringed by the Defendants' lamp, even although that has large differences in the construction?
 50 The first comment which is made on this claim is that the spring catch, which is described in the claim as being brought into an acting position on the closing of the lamp, is really not a spring catch which is brought into an acting position at that point of time, but is really a spring catch which is brought into an acting position at an earlier stage. Mr. Justice *Joyce* in his Judgment at page 412
 55 of Vol. 21 of the Reports of Patent Cases said at line 12: "As a matter of "fact the Plaintiffs' spring catch is not brought into acting position by the "closing of the lamp, but at an earlier stage, by the insertion of the chimney in

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" its proper position, if not by the previous resistance of the flange of the gauze, but at latest by the screwing in of the ring E. The closing of the lamp is a separate and a subsequent operation."

I wish to say, with regard to this criticism on the claim, that, with all respect to the learned Judge, I do not agree with it. I think that his criticism is a criticism which requires that one should read the word "on" in that Claim 1 as if it was the word "by." I think that, so far as that criticism is concerned, the first claim accurately describes the operation of the Plaintiffs' lamp. It is quite true that the spring catch is brought into an acting position, not by the closing of the lamp, but by the screwing up of ring E, and the claim does not say that that is so: the claim only says that it is brought into an acting position on the closing of the lamp, and I think that is true.

Then I wish to deal, secondly, with another criticism which I do not feel quite sure is well founded. I quite recognise that the Patentees do put forward that part of the detail of the lamp described by them, which compels the lamp-cleaner to take out the gauze when he unlocks the bottom of the lamp after the lamp has been returned to the lamp room, as an important matter in his invention. What the Patentees say is to be found upon page 2 of the Specification: "It is the custom for all miners' lamps to be delivered into the lamp room for cleaning purposes after they have been employed in the mine, but, when the lamp is again returned to the miner ready lighted and locked, he has no guarantee that the lamp has been properly attended to. If the lamp-cleaner is negligent in his duty, he may simply remove the lamp bottom and clean the interior of the lamp without taking out the gauze, or the lamp may be closed after cleaning without having a gauze in at all. Faults of this description cannot be detected by the miner, and this negligence has often been the cause of disastrous explosions. Now the object of this invention is to prevent explosions being caused in mines through the negligence of the lamp-cleaner or other person cleaning the lamps, or"—I do not know that this is material to what I am going to say—"through any attempt on the part of the miner to loosen the glass, and with this object we construct our lamp as shown in the accompanying drawing," &c. Then they go on to point out, on page 3: "The lamp-cleaner is obliged to remove the gauze K and glass J in order to remove the bonnet R, thus preventing the possibility of his simply cleaning the interior of the gauze K with a brush so as to save himself the trouble of removing the glass holding ring E. If the gauze is not properly cleaned, or if it has been omitted, the neglect is at once detected by the miner or the inspector." It is impossible to deny, having regard to those passages which I have just read, that this obligation on the lamp-cleaner to remove the gauze, which is brought about by the form of this lamp, is a matter which the Patentees put forward as a matter of importance in their invention. It is equally clear that the Defendants' lamp does not throw upon the lamp-cleaner this obligation; and it is said that, because the Defendants' lamp does not throw upon the lamp-cleaner this obligation, their invention is not an infringement. It is said that this is sufficient to entirely differentiate the Defendants' lamp from the Plaintiffs'. If I had to determine this matter, I confess I should have considerable difficulty in saying—assuming that the Plaintiffs' lamp is one involving a general principle—that the omission of this additional advantage, which is secured by the form of the Plaintiffs' lamp, was sufficient to exonerate the Defendants' lamp from being held to be an infringement; but, for the reasons which I will give in a moment, it will be seen that I need not decide that point.

Having said that, I will now proceed, so far as I can, to answer the question as to what is the meaning of the claim. I am afraid that the Patentees have not made it clear that, by Claim 1, they intended to make such a claim that every miner's safety lamp having a screw bonnet, which employed any

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spring catch for locking the bonnet, which came into an acting position on the closing of the lamp, would fall within the ambit of their claim. I think that if the Patentees intended to make so wide and general a claim they ought to have made it more clearly; and it is not only that I do not think that Claim 1, read by itself, clearly makes a wide claim of this sort as distinguished from a claim for the particular combination embodied in this lamp, but also when I come to read the text of the Specification I cannot find that the words and phrases which are used are those which are adapted to so wide a claim. Let me take the passage on page 2: "Thus according to our invention the lamp bonnet R may be screwed on and off from the lamp frame, to which it can be locked by the spring catch M, the said spring catch M only being brought into action when the glass J and the gauze K are pressed firmly in position by means of the ring E. This enables the lamp to be handed to the miner with the gauze, glass, and glass holding ring fastened in position, and with the lamp base already locked whilst the bonnet can be handed separately to the miner." It seems to me that that passage which I have just read is more adapted for a claim of a particular combination than for a general claim of the nature contended for.

I should like, without going any further into detail in this matter now, to mention a difficulty which has been very much pressed against the Plaintiffs. Mr. Walter has called our attention to all the various lamps which have been produced before us, and he says that the Plaintiffs are in this dilemma: if Claim 1 is construed narrowly, as merely relating to the particular combination of the Patentees for accomplishing these objects, then he says, "There is no infringement, because the Defendants have not adopted that particular combination in its details," and he points out, of course, the various obvious differences in detail between the Defendants' lamp and the Plaintiffs' lamp. Then he says, "If, on the other hand, the Plaintiffs contend for the wider interpretation of Claim 1, which they must do if they are to succeed in proving an infringement, the first claim is a bad claim by reason of anticipation in previous lamps." With regard to those lamps I agree that there is not a single detail in the Plaintiffs' lamp which you cannot find in one or other of them. Some of these lamps come very near to the Plaintiffs' lamp. In particular there is *Thomas'* lamp; but with regard to *Thomas'* lamp it is quite plain that in that lamp there is no spring catch which is brought into position by screwing up the bottom of the lamp; and it is also quite clear that in *Thomas'* lamp the bottom lock, which, it is said in the Plaintiffs' lamp is opened by the application of a strong magnet, is not to be found, nor is any other lock at the bottom to be found which controls the whole mechanism. It seems to me that there are differences of this sort, and I cannot help thinking that if the Patentees had really made it clear that they did make a wide claim of the sort now put forward on their behalf by the Plaintiffs' Counsel, it would be difficult to say that the Plaintiffs' lamp, taken as a whole, had ever been seen before or used before. When one looks at the evidence of Mr. *Williams*, who is a manufacturer of lamps, and who is also one of the Defendants, one finds him practically admitting what I have just said, because he says, after these differences in the *Thomas* lamp had been called to his attention, "(Q.) The closing before putting on the hood, hood fastened on automatically by the mere act of screwing it up, and incapacity to open it without undoing the bottom—can you find those three qualities in any single lamp anywhere before the date of the Plaintiffs' Patent"—and he says, "Not exactly in that way." The truth is you cannot find it at all.

Therefore, speaking for myself, I hesitate to come to the conclusion that there is anything in the anticipations which makes it impossible for the Patentees to make the wide claim. I myself feel very strongly, after having heard the history of the art up to the date of these Letters Patent, and the difficulties that were experienced before, not only that the Patentees' lamp got over difficulties which had not been got over effectively up to the date of their

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invention, but also that, when one looks to see what principle is involved in their invention, that there is a plausible case for saying that you find the principle in the sequence of events. It is perfectly plain that everyone thought it desirable that the lamp should be handed to the miner locked and alight, and it was also very desirable that when that was done the lamp should be without its hood, the object of that being to enable the miner, on the one hand, for his own protection, and, on the other hand, the representative of the colliery proprietors, for the protection of the colliery proprietors, to see that the gauze was there and that the gauze was properly cleaned. It is plain that this was a desideratum, and to my mind it is plain that it had not been effectively achieved before. The mode in which the Patentees achieved it I think may shortly be characterised as by the sequence of events—you got, first, the locking of the bottom part of the lamp, so that when it was put into the miner's hands that could not be tampered with in any way whatsoever; you got, secondly, the opportunity for inspection by the miner and by the inspector; you got, thirdly, the screwing on of the hood, which, the moment it was screwed on, automatically locked; and you got, lastly, that when once the upper part of the lamp—the hood part of the lamp—had been thus automatically locked, that locking of the upper part could not be opened or undone unless you went to the bottom of the lamp and unlocked the bottom part.

I think that really these results, which everyone says were so desirable, were merely achieved by this sequence of the operations; and I do not find anything in the anticipations which prevented the Patentees from making this wider claim. My real difficulty is this: I cannot satisfy myself that the Patentees have really by their Specification, as worded, made this wider claim. When I take the claim as a whole, whether I read the claim by itself, or together with the text of the Specification, I am not prepared to say that Mr. Justice *Joyce* was wrong in holding that Claim 1 must receive the narrower construction, and must be treated merely as a claim for a particular combination, and not as a claim involving any invention of some general principle which is embodied in the Plaintiffs' lamp and which is claimed to be embodied in any other lamp, although, perhaps, the details might be different.

Under these circumstances I am not prepared to differ from Mr. Justice *Joyce*, and my judgment must therefore be that the Appeal must be dismissed, and, of course, dismissed with costs.

ROMER, *L.J.*—I also think that this is an extremely difficult case, but upon the whole I also have come to the conclusion that I am not prepared to differ from Mr. Justice *Joyce*.

When the state of knowledge at the date of this Patent with regard to these safety lamps is borne in mind, I must say that I think there was very good reason why the Patentees in the present case should be careful not to make too wide a claim, and I think the Patentees have not run the risk of so doing by their first claim, when the Specification as a whole is rightly construed. I limit my observations to Claim 1, because that is the only claim which the Defendants are alleged to have infringed.

On reading the Specification carefully, I come to the conclusion that the Patentees did not contemplate or intend by Claim 1 to make, and I think that they have not made thereby, a general claim for every safety-lamp having a screw-off bonnet, if there be employed any kind of spring catch for locking the bonnet of the lamp, when that catch is brought into acting position on the closing of the lamp by any means whatsoever. At any rate, if they had such intent, I think that they ought to have made that intent clear by their Specification, and that they have not done so. On such a Specification as we have to deal with here, I think it could not be said that it fairly brought to the attention of a reader that the Patentees were intending to make such a large claim by the first claim as is now contended for and is necessary to enable the Plaintiffs to say that the Defendants have infringed. I think that the public, to whom this

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Specification is addressed, that is to say, of course, the public interested—those who are accustomed to have to deal with such Specifications—would still have thought that it was open, notwithstanding this Patent, to an inventor to have done, if he could, that which the Defendants have done, and to have made such a lamp as the Defendants have made, and which is said to be an infringement of the Plaintiffs' Patent.

To my mind the Patentees' claim was concerned with and dealt with a special sub-combination in order to obtain the special objects which they pointed out in the body of their Specification. These objects are stated in the Specification, and I refer to the Patentees' own statement of their objects and to what Counsel now say were their objects in order to extend the scope of the Patent. Those main objects were two, and they are thus stated on page 2 of the Specification, commencing at line 11 :—"Now the object of this invention is to prevent explosions being caused in mines through the negligence of the lamp-cleaner or other person cleaning the lamps, or through any attempt on the part of the miner to loosen the glass"; and, with regard to the cleaning of the lamps, the Patentees have made it clear, to my mind, that they thought it of the essence of their method that the lamp-cleaner should be obliged to remove the gauze and the glass when the lamp was unlocked. They say so in so many words in the Specification at page 3: "The lamp-cleaner is obliged to remove the gauze K and glass J in order to remove the bonnet R, thus preventing the possibility of his simply cleaning the interior of the gauze K with a brush so as to save himself the trouble of removing the glass holding ring E"; and there are other parts of the Specification which, to my mind, also bear that out.

Now the special object, so far as concerns the lamp-cleaner, of compelling him to clean the gauze—because when the lamp was unlocked the gauze with its support came out—was obtained by the Patentees' special method of putting the spring catch into an acting position as shown in their Specification—that is to say, as stated on page 2 of the Specification, "The said spring catch M only being brought into action when the glass J and the gauze K are pressed firmly in position by means of the ring E"; and that special method of bringing the spring catch into an acting position was what is referred to in their first claim, where they say: "The said spring catch being brought into an acting position on the closing of the lamp substantially as set forth." Another object of the Patentees, namely, to prevent the miner being able to loosen the glass, was obtained by the Patentees by the reverse directions of the screw threads F and D in the Figures shown in the Specification—those at the bottom of the lamp when the lamp was screwed up.

I think myself, on the true construction of this Specification, that Claim 1 of the Patentees was limited to the special combination of parts necessary to obtain those special objects which I have pointed out, and there is great importance therefore to be attached to those words with which the claim closes and which governs the whole of the claim, "substantially as set forth."

It is clear when I come to consider what the Defendants have done that they have not infringed that claim so construed. Their lamp does not obtain, nor attempt to obtain, either of the objects of the Patentees. They have not the two opposing screws used by the Patentees for the purpose of preventing the glass being loosened; they have not the method of putting the spring catch into an acting position which was necessary, according to the Patentees' Specification, in order to obtain the advantage of the obligatory removal of the gauze when the lamp was unlocked. It appears to me that the Defendants were doing that which they were entitled to do, notwithstanding the Patent. They take neither the special objects of the Patentees nor their method. The Defendants' catch is not the same, and it is used, so far as the main objects of the Patentees are concerned, for a different purpose. Nor do they put their spring catch, treating it as a spring catch, into an acting position in the same

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way substantially considered as the Patentees do in their Specification. At any rate, I think that the Defendants had it open to them, notwithstanding Claim 1, to do what they did as a piece of mechanism, their objects not being those covered by the Patent, not being obtained by what the Defendants have done, not sought to be obtained, and what the Defendants have done, the instrument which they have used, being, to my mind, as far as concerns the nature of the spring catch and the way in which it is brought into operation, substantially different from those adopted by the Patentees. 5

Under these circumstances, I have come to the conclusion that there was no infringement, and therefore the Appeal fails. 10

COZENS-HARDY, *L.J.*—I agree, and for the same reasons. I only wish to add this—that, if a Patentee desires to claim a general principle, it is his duty to make that intention reasonably clear. The Court ought not to be called upon to spell out such an intention from the use of ambiguous language. On a careful consideration of this Specification I have been unable to find in the body of the Specification any assertion of any general principle. I find an illustration of a particular combination well calculated to produce certain definite objects; but we are now really asked by the Appellants in this case to omit or wholly disregard the words at the end of Claim 1, “substantially as set forth.” For my part I am unable to do that. I agree that the Appeal ought to be dismissed. 15 20

IN THE HIGH COURT OF JUSTICE.—KING’S BENCH DIVISION.

DURHAM SUMMER ASSIZES.

Before MR. JUSTICE CHANNELL.

July 18th, 1904.

25

APPLEBY v. SOUTH DURHAM STEEL AND IRON COMPANY LD.

Patent.—Action for infringement.—Anticipation.

On the 14th of May 1904, *Stephen Appleby* brought an action against the *South Durham Steel and Iron Company Ltd.* for infringement of two Patents, namely, No. 18,518 of 1896, granted to him and another for “Improvements in “or connected with Ingot Moulds,” and No. 13,446 of 1900, granted to him and two others for “Improvements in or connected with Ingot Moulds.” The later Patent related to improvements in or connected with the same class of ingot moulds as that to which the earlier Patent related. 30

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By his Particulars of Breaches the Plaintiff complained of the manufacture and use by the Defendants of ingot moulds similar to those shown in Fig. 1 of the Drawings attached to the Complete Specification of the Patent of 1896, and also of the manufacture and use by the Defendants of ingot moulds similar to those described in Figs. 1 and 3 of the Drawings attached to the Specification of 1900.

The Defendants by their Defence denied infringement, and put in issue the validity of the Patents.

By their Particulars of Objections the Defendants alleged that the Patent of 1896 was invalid for want of utility, novelty, and subject-matter, and as having been anticipated by a number of Specifications which were set out, including *Beardmore and Cherrie* (No. 8612 of 1884) and *Clough* (No. 13,005 of 1892). As to the Patent of 1900, the Defendants alleged similar objections to those alleged in respect of the 1896 Patent, including anticipation by *Clough*.

The action came on for trial before Mr. Justice CHANNELL without a jury.

Shortt (instructed by *Wooler and Wooler*, of Darlington) appeared for the Plaintiff; and *A. J. Walter* and *J. Crabb Watt* (instructed by *Faithfull and Owen*) appeared for the Defendants.

After the Plaintiff's case had been opened the Plaintiff and *H. W. Butler*, of the Institute of Mechanical Engineers, gave evidence in support of the Plaintiff's case. In the course of his cross-examination *Butler* admitted that the first claim in the Specification of 1896 was anticipated by *Clough's* Specification, and that Claim 5 of the Specification of 1900 was anticipated by *Beardmore*. *Shortt* thereupon said he was unable to contest the case further.

Judgment was given for the Defendants with costs.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE JOYCE.

October 27th, 28th, and 29th, 1904.

MOFFATS LD. v. J. AND W. B. SMITH.

30 *Patent.—Action for alleged infringement.—Judgment by consent for an injunction, the Plaintiffs agreeing to grant a license upon terms agreed between the parties.*

On the 14th of August 1900, Letters Patent (No. 14,553) were granted to *George Cecil Dymond* for "Improvements in Incandescent Gas Lamps," on a communication from abroad, and on the 19th of December 1900 Letters Patent

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(No. 23,222) were granted to *William Phillips Thompson* for "Improvements in Incandescent Gas Lamps," also on a communication from abroad. Both Patents were at the time of the commencement of the action vested in *Moffats Ltd.*, the Plaintiffs.

On the 15th of December 1903, *Moffats Ltd.* commenced an action against *J. and W. B. Smith* for infringement of the Patents. They claimed the usual relief. 5

In their Particulars of Breaches the Plaintiffs alleged that the Defendants had infringed by manufacturing, selling, offering for sale, supplying and using in this country gas lamps manufactured according to or in manner only colourably differing from the inventions described in the Specifications of the above-mentioned Patents and claimed in the claiming clauses 1, 4, and 5 of the Specification of the first Patent and in both the claiming clauses of the Specification of the second. In particular they alleged that the Defendants, on or about the 19th of November 1903, sold one of such lamps to a Mr. *E. G. Francis*. 10 15

The Defendants by their Defence denied infringement, and put in issue the validity of the Patents by reason of the matters appearing in their Particulars of Objections.

The action came on for trial on the 27th of October 1904. 20

Moulton, K.C., *Cripps*, K.C., and *Colefax* (instructed by *J. H. and J. Y. Johnson*) appeared for the Plaintiffs; *Walter* and *A. Hildesheimer* (instructed by *J. and M. Solomon*) appeared for the Defendants.

Moulton, K.C., having opened the Plaintiffs' case, the following witnesses were called in support thereof:—*Dugald Clerk*, *James Swinburne*, *W. W. Beaumont*, and *W. T. Hart*. 25

Cripps, K.C., summed up the Plaintiffs' case.

Walter then opened the case for the Defendants, but, before his opening had been concluded, the action was settled.

A perpetual injunction was awarded, the Plaintiffs agreeing to grant a license to the Defendants upon terms not mentioned in Court, but which were subsequently embodied in a Consent Order. 30

In the Matter of Altman's Application for a Trade Mark.

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before MR. JUSTICE KEEWICH.

November 8th, 1904.

IN THE MATTER OF ALTMAN'S APPLICATION FOR A TRADE MARK.

- 5 *Trade Mark.—Application for registration of word.—Previous use of word coupled with "Registered Trade Mark."—Comptroller's refusal to register.—Appeal.—Bonâ fide mistake proved on appeal.—Decision of Comptroller reversed and application ordered to be proceeded with.*

10 This was an appeal from the Comptroller, referred to the Court by the Board of Trade under section 69 (4) of the Patents &c. Act of 1883, the application having been for the registration of the word "Coninco" as a Trade Mark in respect of mantles for incandescent lighting.

15 The Applicant *John Altman* in 1904 had purchased the goodwill of a business previously carried on by *George Brown*, and then applied for registration of the mark. In doing so, he submitted various documents to the Comptroller, including one which bore the words

"CONINCO

(Mantle—Registered Trade Mark)."

20 The Registrar of Trade Marks, acting for the Comptroller, on seeing this, declined to register the mark. The Applicant appealed to the Board of Trade, who referred the matter to the High Court.

25 The Applicant then made an affidavit saying that he had simply purchased the business for cash and knew nothing of the document in question; other affidavits were filed on his behalf; and the Registrar made an affidavit showing that no application in respect of the word had ever been made at the Patent Office.

It transpired (and was proved by the Applicant's affidavit evidence on which there was no cross-examination) that in June 1902 *Julius Boehm*, the manager

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of the *Continental Incandescent Gas Light Company Ltd.* had instructed one *Major Sluce*, a traveller in the Company's employment, to register the label as above as a Trade Mark in the Trade Marks Registry, and gave him the requisite fee of five shillings. Unknown to *Boehm*, *Sluce* registered the label in the Copyright Registry at Stationers' Hall, and obtained a receipt which he gave 5
to *Boehm*, who did not notice the mistake.

The matter having been put into the non-witness list by the request of the Comptroller came before Mr. Justice KEKEWICH on the 8th of November 1904.

A. J. Walter (instructed by *Halse, Trustram & Co.*) appeared for the Applicant; *R. J. Parker* (instructed by the *Solicitor to the Treasury*) 10
appeared for the Comptroller.

Walter (after stating the facts).—I do not suggest for one moment that on the facts which were before him the learned Registrar arrived at a wrong conclusion, but I submit that, as it now appears that the statement was not made *malâ fide* but was caused by an inadvertence of a servant, the Court 15
should direct the registration to be proceeded with. It is a surprising but common thing for people to imagine that an entry at Stationers' Hall gives them a registered Trade Mark.

Parker for the Comptroller.—The reason why the Comptroller in circumstances of this kind always refuses to register the mark is because it is so 20
common a practice to misrepresent and pretend that a person has a registered Trade Mark when he has not. The Comptroller is always very particular about it because he finds it is really a common form of what one may almost say is fraud. [KEKEWICH, *J.*—Quite right. I know how far it goes, because I had a case a little time ago about a cricket bat.*] It may sometimes do the public a 25
good deal of harm, and it may enable a man to get a monopoly of a mark when he ought not to have monopoly. The Comptroller has a discretion in these matters (*In re Fuente*, L.R. (1891) 2 Ch. 166; 8 R.P.C. 214); but if your Lordship thinks that here there was really a *bonâ fide* mistake which is satisfactorily accounted for, then, no question of general principles being 30
involved, I leave the matter in your Lordship's hands.

KEKEWICH, *J.*—It is a very bad blunder, but still a blunder, and it seems to be honest. I think I ought not to confirm the present decision. I think that the Comptroller ought to hear the application on its merits apart from this objection; I know nothing about anything else. The Order will be:—"The 35
"Court being of opinion that the use of the words 'Registered Trade Mark' "was owing to an honest mistake, directs the Comptroller to proceed with the "application for registration."

The Applicant was ordered to pay the Comptroller's costs.

* *Warsop & Sons Ltd. v. Warsop*, 21 R.P.C. 481.

Christy & Co. v. Tipper & Son.

IN THE COURT OF APPEAL.

Before LORDS JUSTICES VAUGHAN WILLIAMS, ROMER, and COZENS-HARDY.

November 14th, 1904.

CHRISTY & CO. v. TIPPER & SON.

5 *Trade Mark.—Passing off.—Motion to rectify Register.—Invented word.—*
“Absorbine.”—Mark registered subject to a note on the Register.—Action dis-
missed.—Mark ordered to be removed from Register.—Appeal dismissed.—
Patents &c. Act, 1883, section 64; Patents &c. Act, 1888, section 10.

In 1901 Y., carrying on business in the United States, registered the word
 10 “Absorbine” as a Trade Mark in Classes 2 and 3, stating in his application
 that no claim was made to the exclusive use of the word “Absorb,” and this
 disclaimer appeared on the Register. He used the word, which he himself had
 invented some years before, as the name of a liquid veterinary preparation, of
 which there were large sales in the United States, and considerable advertise-
 15 ment from 1894 onwards in American papers circulating in this country;
 there had also been some sales in the United Kingdom from 1894. In 1901
 C & Co., carrying on business in the United Kingdom, became Y.’s agents.
 In 1901 T. & Son, who had for many years sold an absorbent ointment
 for veterinary purposes as “Absorbent Ointment,” changed the name to
 20 “Absorbine,” but had not sold under that name until shortly after Y.’s appli-
 cation to register, although catalogues and labels having the new name in them
 had been prepared before that date. T. & Son had acted bonâ fide, and they
 did not know of Y.’s use of the word “Absorbine” until December 1902, when
 they complained of it, and in 1903 Y. and C. & Co. commenced an action against
 25 T. & Son to restrain them from infringing the Trade Marks and from passing

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off. T. & Son moved to rectify the Register by removing the Trade Marks on the grounds that the word was not an invented word at the date of registration, and was descriptive, and had been used before registration by themselves and others. It appeared that another firm had used the word to some extent before the registration, but they decided not to oppose the registration. The Action and Motion to rectify were heard together, and at such trial and hearing it was held, that no case of passing off had been established, and that "Absorbine," whether it was a mi-spelling of "absorbing" or formed by adding the common termination "ine" to "absorb," was not an invented word. The Trade Mark was ordered to be expunged in both classes, and the Action was dismissed.

The Plaintiffs appealed, but on the hearing of the Appeal the question of the validity of the registration was alone argued.

The Appeal was dismissed with costs.

On the 21st of November 1901 Wilbur Fenelon Young, a manufacturing chemist carrying on business in the United States, applied to register the word "Absorbine" as a Trade Mark in Class 2 in respect of chemical substances used for agricultural, horticultural, veterinary and sanitary purposes, and the mark was registered under the number 242,163, the following disclaimer being entered on the Register, namely:—"No claim is made to the exclusive use of the word 'absorb.'" He also registered the word "Absorbine" in Class 3 in respect of chemical substances prepared for use in medicine and pharmacy under the number 242,164. The final notification of registration was on the 21st of June 1902, the registration having been delayed owing to the alleged user by Corbyn, Stacey & Co., hereinafter referred to; but, after the time for opposition by them had been extended by consent to the 9th of June 1902, they decided not to oppose registration.

On the 30th of March 1903 Thomas Christy & Co., a firm of wholesale druggists carrying on business in the City of London, and the sole agents of W. F. Young in the United Kingdom for the sale of "Absorbine," and W. F. Young commenced an action against B. C. Tipper & Son, who carried on business in Birmingham as manufacturers and vendors of medical preparations for veterinary purposes, claiming an injunction to restrain the Defendants, their servants and agents—(1) from selling or offering or exposing or advertising for sale or procuring to be sold any veterinary preparation not of the Plaintiffs' manufacture under the name of "Absorbine," or under any other name which by reason of colourable imitation thereof or otherwise was calculated to represent or lead to the belief that such preparation was a preparation of the Plaintiffs; (2) from in any manner infringing the Plaintiffs' registered Trade Mark No. 242,163; (3) and from in manner aforesaid or in any other manner passing off or enabling or assisting others to pass off any such veterinary preparation as aforesaid as or for a preparation of the Plaintiffs, and for other consequential relief.

Prior to the commencement of the action correspondence had passed between the parties. On the 6th of December 1902 the Defendants wrote to the Plaintiff Young, having seen an advertisement of his "Absorbine" in "Land and Water," complaining that the name was an infringement of a preparation which they made; and a correspondence ensued, in which the Plaintiffs referred to their

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registrations, and on the 20th of February the Plaintiffs' solicitor wrote asking the Defendants for an undertaking in certain terms, but in the end the action above stated was commenced.

The Plaintiffs by their Statement of Claim alleged—(2) that the "Absorbine" preparation manufactured by the Plaintiff *W. F. Young* had been publicly sold in the United Kingdom for a number of years past under the name and Trade Mark "Absorbine" and had had a good sale; that the same had also been well advertised in the United Kingdom in various ways at considerable expense, and it had for many years past been well known in America and in many parts of the world; (3) that the word "Absorbine" had been registered as set out in this report; (4) that by reason of the merits of the preparation and of the attractiveness of the name and of the expenditure of the Plaintiffs in advertising the same the said name and Trade Mark "Absorbine" had become and was well known as indicating exclusively that any veterinary preparation to which it was applied was a preparation made and sold by the Plaintiffs, and anyone who asked for or ordered a veterinary preparation under the name "Absorbine" intended and expected to receive the Plaintiffs' said preparation and no other; (5) that the Plaintiffs had recently discovered that the Defendants were offering for sale and selling a veterinary preparation intended as a remedy for the same ailments as their said "Absorbine" preparation under the same name "Absorbine," and they requested the Defendants to desist from so doing; that the Defendants, however, declined to do so; and (6) that the Defendants had caused damage to the Plaintiffs and had made profits.

The Defendants by their Defence admitted the registration of the Trade Mark, but alleged that the registration in each class was improper, and, after refusing to admit paragraphs 2 and 4 of the Statement of Claim, alleged—(4) that the Defendants and their predecessors in title had for upwards of 40 years past carried on a large and high class business as manufacturers and vendors of various medical preparations for veterinary purposes, which preparations had been and were extensively known and used in the United Kingdom and had a high reputation; that one of the Defendants' said preparations, which had been sold by them and their predecessors in business for many years past, consisted of ointment used as a remedy for bony and glandular enlargements; (5) that the Defendants' said ointment was (prior to August 1901) advertised and sold by the Defendants under the name of "Absorbent," but in or about August 1901 the Defendants, having exhausted their printed catalogues, caused a new catalogue to be prepared and copies therefrom to be printed; in such new catalogue the Defendants made alterations in the names of several of their preparations, including that of their said ointment, the name of which was altered from "Absorbent" to "Absorbine," and the Defendants at the time or shortly before, made a corresponding alteration in their labels; that the Defendants sent copies of their said new catalogues to numerous customers of their firm, and they had ever since their said catalogues and labels were printed sold the same ointment under the name of "Absorbine"; (6) that the Defendants never heard of the Plaintiff, *Wilbur Fenelon Young*, or of the Plaintiffs' preparation in the Statement of Claim mentioned, or of any medicinal preparation (other than that of the Defendants') being advertised or sold or offered for sale under the name of "Absorbine" or "absorbent" until December 1902, when the Defendants saw an advertisement of the Plaintiffs' said preparation, and the Defendants thereupon wrote to the Plaintiffs complaining of the Plaintiffs' user of the word "Absorbine"; (7) save as aforesaid and save that the Defendants had refused to abstain from using the word "Absorbine" the Defendants did not admit any of the allegations in paragraph 5 of the Statement of Claim; (8) the Defendants denied the allegations contained in paragraph 6 of the Statement of Claim.

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On the 22nd of April 1903 the Defendants gave notice of Motion for an Order to rectify the Register by the removal of the Trade Marks Nos. 242,163 and 242,164, and that the Respondents, the Plaintiffs in the action, might be ordered to pay the costs of that application.

In pursuance of an Order of *Kekewich, J.*, in Chambers, the Defendants gave the following Particulars of the grounds on which they intended to rely in support of their Motion, namely:—(1) That the Respondents' alleged Trade Marks were not at the date of the registration thereof and were not then registrable Trade Marks within the Patents, Designs, and Trade Marks Acts, 1883 to 1888; (2) that the word "Absorbine" was not an invented word, and was not distinctive of the Respondents' goods, but was merely descriptive of the character or quality of the articles to which it was applied, and the Respondents were not entitled to acquire an exclusive right to the use of the same by registration; (3) that the alleged Trade Marks were, prior to the registration thereof by the Respondents, used by the Applicants and other persons in connection with articles similar to the goods to which the same were applied by the Respondents, and in fact the word "Absorbine" was at the date of and prior to the registration by the Respondents, and had ever since, been common to the trade and to the public.

In pursuance of an Order for certain further Particulars the following were given by the Defendants, viz.:—(1) As to the names, addresses, and dates of user of the word "Absorbine" in connection with articles similar to the goods for which the said word had been used by persons other than the Applicants, the Applicants were informed and believed that Messrs. *Corbyn, Stacey & Co., Ltd.*, whose registered office was 300, High Holborn, London, first used the word "Absorbine" for a preparation of similar character to the Respondents' preparation in May 1899, and that they had continued to use the same ever since, excepting that during the pendency of these proceedings such user had been suspended; the Applicants were unable at present to give the names or addresses of any other firms or persons who may have used the said word "Absorbine" or the dates of any such user by any such persons. (2) As regards the date of the first user of the said word by the Applicants, in the autumn of 1901 the Applicants caused a reprint to be prepared of their catalogues or booklets called "*Tipper's Three Tips*" containing lists of the Applicants' preparations, and also caused to be prepared new labels, the Applicants' stock of catalogues being almost exhausted, and in preparing the said new catalogues and labels the Applicants caused several of the names therein to be altered or modified, including that of the preparation referred to in this action, the name of which they altered from "Absorbent" to "Absorbine." The printed copies of the said new catalogues were received by the Applicants on or about the 17th day of November 1901, and a large number of the same were forthwith distributed by the Applicants by their travellers and otherwise, the Birmingham and London Cattle Shows being then pending. Printed copies of the new labels were received by the Applicants on or about the 25th day of November 1901, and a number of the same were forthwith affixed to the pots containing Applicants' said preparation. The first sale made by the Applicants of their said preparation under the name "Absorbine" was made on or about the 10th of December 1901.

The Action came on for trial on the 19th of January 1904, the Motion for Rectification being set down for hearing with the Action.

It appeared that the Plaintiffs' preparation was a liquid one sold in bottles, whereas the Defendants' preparation was an ointment sold in pots. After the commencement of the action the following notice was put on the pots:—"*Tipper's* 'Absorbine' is an ointment put up in pots, and has no connection with a liquid preparation sold by a Yankee house under a similar title." The

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Defendants' pots had from the first borne the name of the Defendants. The Plaintiff *Young* had in 1892 registered a Trade Mark comprising the word "Absorbine" in the United States, and on that application stated that the arbitrarily chosen word "Absorbine" was the essential feature of the

5 Trade Mark.

It was held by *Joyce, J.*, that no case of passing off had been established, and that "Absorbine," whether it was a mis-spelling of "absorbing" or was formed by adding the common termination "ine" to "absorb," was not an invented word. The Trade Mark was ordered to be expunged in both classes, and the

10 action was dismissed (*ante*, page 97).

The Plaintiffs appealed, but on the hearing of the appeal relied only on Trade Mark.

Neville, K.C., and *L. B. Sebastian* (instructed by *L. E. Townroe*) appeared for the Appellants; *Younger, K.C.*, and *E. P. Hewitt* (instructed by *Belfrage & Co.*, agents for *T. W. Robinson*, of Birmingham) appeared for the Respondents; *R. J. Parker* (instructed by the *Solicitor to the Board of Trade*) appeared for the Comptroller-General.

Neville, K.C., after referring to the facts and to the report below (*ante*, page 97) continued:—In the *Eastman Photographic Materials Company's Application* (15 R.P.C. 476; L.R. (1898) App. Cas. 571) it was held that clause (e) of section 64 (1) of the Patents &c. Act 1883, as amended by section 10 of the Patents &c. Act 1888, does not restrict clause (d). [Parts of the judgments in that case were read.] [*ROMER, L.J.*—How do you distinguish "absorbine" from "absorbing"?] It is a different word; "absorbine" has no meaning unless you apply it. If

25 "Satinine" is a good invented word, "Absorbine" is *a fortiori* good. In *Burroughs and Wellcome's Trade Marks* (21 R.P.C. 222) "Tabloid" was held to be a "fancy word." Applying the true test here, no one can be interfered with by the registration. The use of the present participle could not be interfered with; anyone could use it. "Absorbine" is an arbitrary word. It

30 does not mean absorb or absorbing, but no doubt it has some reference to the absorbent character of the goods. The test is not the amount of invention, but whether persons would be prevented by the registration from using ordinary English words. [*ROMER, L.J.*—Must there not be some invention? I should not call this invention; if there were, I agree that the amount would not

35 matter.] [*VAUGHAN WILLIAMS, L.J.*—The obvious intention is to say that the preparation does absorb; with regard to "Satinine" it tells you that it is not satin.] [*Younger, K.C.*—It was used for starch.] It is a different matter from invention in the case of a Patent; there is no question of giving anything to the public, but the question is whether anything is taken from them. It is no objection

40 that other people have shown one the way by making other similar words. [*ROMER, L.J.*—Would not "absorbing" be an infringement?] It is submitted not. The question is whether the entire practice is to be altered. [*ROMER, L.J.*—I decline to treat it as a question of general principle; each word must be taken by itself.] [The report of Lord *Herschell's* Committee was referred to.] After

45 the "*Solio*" case a new practice arose in the Office pursuant to directions under section 95. The disclaimer would prevent the Plaintiffs from saying that "absorb" or "absorbing" is an infringement. "Absorbine" is a new word, and would be recognised as such by the public.

Neither Counsel for the Respondents nor for the Comptroller were called on

50 to argue.

VAUGHAN WILLIAMS, L.J.—I do not think we shall deprive the trade of any advantage on which they counted from legislation by holding that this word "Absorbine" is not an invented word. In each case you must look at the word itself and decide whether it is an invented

55 word or not.

Christy & Co. v. Tipper & Son.

In my opinion "Absorbine" is a mere variation of the word "absorb," and is used in precisely the same sense, and with the intention of indicating that this preparation which the Plaintiffs sell does absorb and effects a cure by absorbing. I do not say that, if it were an invented word and we could find our way to say that it was a word derived from some other word, that would be sufficient to prevent our saying that it was an invented word. We have not to decide that. In the present case I am of opinion that there is no invention whatsoever in this word "Absorbine." 5

I may mention that, so far as "Solio" is concerned, the case is obviously different. "Solio" may have been derived from "Sol"; but there is no word in the English language of which one could say that "Solio" was a mere variation. 10

Under the circumstances I think that the judgment of Mr. Justice *Joyce* is absolutely right.

ROMER, *L.J.*—I agree. 15

COZENS-HARDY, *L.J.*—I agree.

Younger, K.C.—The appeal will be dismissed with costs?

VAUGHAN WILLIAMS, *L.J.*—Yes.

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